

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

H. J. HEINZ CO.,

Appellant-Defendant,

vs.

MAX M. COHN,

Appellee-Complainant.

On Patents

No. 835,850

and

No. 824,908

“Envelops”

APPELLEE'S BRIEF

CHAS. E. TOWNSEND,

Solicitor for Appellee.

FILED



IN THE
District Court of the United States

IN AND FOR THE
NORTHERN DISTRICT OF CALIFORNIA,
SECOND DIVISION.

HON. WM. C. VAN FLEET, JUDGE.

MAX M. COHN,

Complainant,

vs.

H. J. HEINZ COMPANY (a Corporation),

Respondent.

In Equity
No. 15204
on
Patents
No. 835,850
and
No. 824,908
Envelopes

MONDAY, JUNE 24TH, 1912.

THE COURT (orally) :

This is a suit in equity to restrain the use by the defendant of a certain envelope alleged to infringe the patents of the complainant sued on, numbered respectively 835,850 and 824,908, both issued to the complainant and relating to an envelope commonly referred to in the art as a window envelope; that is, an unpunctured envelope made from generally opaque stock, having a transparent portion on its address side called a window, through which an address placed upon the enclosure may show through, and thus avoid the necessity of writing it upon the face of the envelope,—the window or transparent portion being produced by

the application of some oily substance suitable for the purpose of producing the transparency. This window portion is surrounded by a colored or tinted border of opaque ink to give the window definition and cover up an otherwise unsightly and irregular margin produced by the inevitable tendency of the oily application to bleed or creep into the surrounding opaque portion of the paper.

Patent 835,850, although later in issue, was first applied for and covers the primary form of the invention above outlined.

Patent No. 824,908, which, although later in application, is earlier in issue, is based upon the first as a divisional application, and relates to an envelope such as described in the primary application, but having the window or transparent portion produced in the form or outline characteristic of some symbol of trade, article of commerce or trade mark. There is also printed matter of a permanent character appearing upon the face near the window to indicate and attract attention to the brand of goods or article of merchandise designed to be advertised thereby.

The main defense of the defendant, who is a user of the article and not the manufacturer, is that the complainant here was not the first inventor or discoverer of the device or process covered by these patents, but that the discovery was made by and put in use by one Regenstein for the manufacturer, the Transo Paper Company, the party really making the defense here; and a large part of the record is devoted to evidence bearing upon the question as to who was in fact the original designer or inventor of the device. The rule is very well established in such cases that in order to overcome the presumption of validity of the patent and the prior rights thereby protected, the evidence must be such as to satisfy the mind of the court beyond a reasonable doubt that the patentee was not the original discoverer or designer of the device; and I am fully persuaded, after a very thorough examination of the evidence in this case that it does not come up to the requisite strength to overthrow the primary case of the complainant and the

presumption which runs in his favor through the issuance of the patent. It is not necessary, nor would it be of any material benefit to go into any detailed statement of that evidence. It is somewhat unsatisfactory in certain respects on both sides, but it is such as in my judgment fails to establish this claim of the defense.

The second defense is that there was a want of novelty, by reason of the prior art, in the primary invention—not perhaps a strict anticipation but a failure to disclose novelty by reason of the existing state of the art. A large amount of evidence is devoted to that subject as well; a considerable number of prior patents were put in evidence for the purpose of sustaining this plea of anticipation or want of novelty. I have examined those features of the evidence very carefully. What is apparently regarded by defendant as the best reference is a patent to one Brown in 1862. That does disclose a glimmering of one feature of the invention that is involved in this first Cohn patent. I should say perhaps, preliminarily, that these Cohn patents are what are known in the patent law as combination patents; that is, they disclose a combination device or process; I think perhaps “process” would be the better term because it is by a process that the articles of commerce are produced. This Brown patent of 1862 discloses in a way an idea approaching one element of the first Cohn patent; that is, it discloses an idea of a window envelope. This window, however, is unaccompanied by any ring or border, and the calls of the patent are indefinite as to the manner in which the window shall be produced. It says that the transparent portion may be produced in the same way that tracing paper may be produced, while the evidence tends very strongly to show that by the application of that method no successful result would be accomplished, as the means for making tracing paper are such that they cannot be applied for the purpose of producing transparency in simply a portion of a sheet; it must be applied to the entire sheet. Moreover, as I say, the Cohn patent being a combination, the Brown patent entirely fails to come up to an anticipation, because it involves, if it be admitted that that

element is disclosed in the Brown patent, nothing but the single feature of this transparent window unaccompanied by the other which I regard as an essentially characteristic feature of the first Cohn patent, a border or ring of opaque ink applied for the purpose of covering up the ragged edge that the evidence discloses inevitably results from the application of the oily substance applied for the purpose of producing the transparency.

There is also a British patent issued to one Busch which is pleaded as an anticipation, or, more properly, as an illustration of the state of the art, which it is claimed should preclude a finding of novelty. This patent is claimed to embrace the feature of a ring or border. I am satisfied from my examination of the record that this claim cannot be sustained. Moreover, the Busch patent involved a device which required for its production a paper entirely transparent; the entire envelope in its primary form was to be made of transparent material, and thereupon the window feature would be produced by covering the entire portion of the face of the envelope other than the window space with opaque ink, thereby resulting in the production of an envelope the back portion of which would remain transparent, and the transparent opening or window in front, while the balance of the face of the envelope would be entirely in either black or some other dark colored ink which, as the evidence tends to show, produced an unsightly or unattractive effect, and rendered that device very largely an unsalable product; that is, it never was a success, and so far as appears, it has gone entirely out of use, if it ever had any; so that I am unable to regard that as an anticipation of the device embraced in the Cohn patents or either of them.

There was another British patent issued to one Boldt. That is a device which is even broader in its distinctive features from the Cohn conception than the one just suggested. It was a patent secured by Boldt for a method or process of making not strictly an envelope, although the envelope is included within the definition of its terms, but a receptacle or casing or container for

goods of any particular character that for the purposes of commerce it should be desired to have done up in packages; and had this transparent window or opening so placed as to disclose the character of the contents of the package, so that picking up the package you could look through this transparency and see the character of the goods contained therein; and it was that feature which seemed to be the principal idea in the mind of the inventor of that device, that is, making a container which would enable the buyer of an article of commerce to readily see what he was getting without breaking the package. It is largely, if not wholly, to my mind, along a different line in its conception than the Cohn patents, and I do not think, either in a primary sense or in its details, can be looked to or regarded as an anticipation of the real feature which is embraced in the Cohn conception. Moreover, it is constructed in a distinctively different manner from the Cohn patent. It is not a one piece receptacle or envelope, but is an envelope or covering having a punctured face, and the puncture or opening is then covered or closed by a separate piece of transparent material of any appropriate character. In that respect it is entirely different from the conception of Cohn, which embodies, as indicated by the claim of the patent—I am speaking now of the first Cohn patent—a single piece, an unpunctured envelope rendered transparent through the application of the substance which is employed for that purpose. This Boldt patent, like the previous one, that of Busch, seems never to have had any successful life, so far as commerce is concerned, and so far as the evidence discloses is not now in use. This window, moreover, which Boldt provided for was likewise unaccompanied by any border or ring for the concealing of the edge. It is true, however, that that was a method of construction which did not require it, because of the different manner in which the window was produced; but I am entirely satisfied that no one of these so-called anticipations put in evidence subserve the purpose for which they were submitted, and that there is nothing in the prior art which can be regarded

as an anticipation of the first Cohn conception, that is, the device embraced in the so-called first patent.

It is unnecessary to state, perhaps, with reference to a doctrine so well established, that it is not sufficient, as against a combination patent, to show simply anticipation of some one or more of the different elements of the combination, but not all. The unitary result of the combination is the subject of the patent; and unless you disclose in the art an anticipation of that unitary thing you do not disclose anticipation; and so, whether or not the record does disclose that some one or two features of either one of these devices is anticipated, the evidence entirely fails to show any device which could be taken as an anticipation of the combination of either patent.

It is also urged as against the second Cohn patent, which is also claimed to be infringed by the envelope defendant uses, that it is wholly lacking in novelty and patentability. As indicated, that device is merely a step beyond the primary device covered by the first Cohn patent. It employs the same method for producing the envelope and the transparency, but adds the distinctive feature of changing the form of the window as may be desired to represent a symbol of trade, a trade mark, or article of manufacture, accompanied, as stated, by a permanent printed word or sentence such as may be desired which always remains upon the envelope however used, as purely an advertising feature. It is claimed that this change from the original was purely an advance in the nature of a mechanical difference; that it involved no use of the inventive faculty. I am unable to sustain this contention. I think that the device gives very decided evidence of inventive thought. Inventive thought is not confined of course to devices which relate to machinery or things of that kind, but to anything which produces a result in the art or science to which it relates which is of a novel and useful character and which is materially different from that which precedes it. I think that the evidence discloses very clearly that this conception was one which had been sought after for a long period,—something of the kind,—but the real idea

occurred to no one to put it into successful form until Cohn seized upon it. I am satisfied that the objection that the second patent does not cover a device which discloses patentability is entirely unsustained by the evidence.

The last defense is that there is a want of infringement in the use of the envelope which the defendant employed because of certain differences in its construction. There is no question made but what it infringes the first Cohn patent, but it is claimed that it fails as an infringement of the second Cohn patent because of certain structural differences. The primary form of the envelope is produced in precisely the same way, through the application to a portion of its opaque face of some transparency producing material; the ring or border is applied in precisely the same way and is of distinctive characteristic form; but although accompanied by permanent printed matter, this printed matter instead of being upon the face of the envelope adjacent to the window is printed upon the inside of the back flap of the envelope in such a position that it shows through the window when the enclosure is removed, and not being visible until the enclosure is removed; and the claim is that by reason of this difference, the second Cohn patent, being as claimed a very narrow one, there is not disclosed equivalency in the manner of constructing the defendant's envelope. I am of opinion that this defense is without merit. Equivalency is always to be found where the same or like result is produced and the function is performed in substantially the same way; and I am quite satisfied that under any just application of the rule bearing upon that question, equivalency would be found in this device which is used by the defendant. This being so, I am satisfied that the defenses must be held bad and the decree must go in favor of the complainant as prayed.

No. 2195.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

H. J. HEINZ CO.,

Appellant-Defendant,

vs.

MAX M. COHN,

Appellee-Complainant.

On Patents
No. 835,850

and

No. 824,908
“Envelops”

(The page numbers refer to printed record.)

APPELLEE'S BRIEF.

This cause comes before this Court on the appeal from a final decree of the District Court of the United States for the Northern District of California, sustaining the validity of two several letters patent, No. 835,850 and No. 824,908, for Envelops, respectively dated, November 13, 1906, and July 3rd, 1906, issued to the complainant-appellee, and from a permanent injunction issued against the defendant-appellant, restraining the further infringement of said letters patent, and each of them.

The witnesses have elected to speak of Patent No. 835,850 as the “First Cohn Patent,” and Patent

No. 824,908 as the "Second Cohn Patent." A specimen of the infringing envelop is attached at the back of the original copy of this brief.

The defendant-appellant was sued as a user of infringer envelops manufactured by the Transo Paper Company of Chicago, of which one Julius Regenstein is president and owner. The latter assumed the entire defense in this suit, so that the H. J. Heinz Company is the defendant and appellant in name only.

Judge Van Fleet's opinion appears at the beginning of this brief, and also R. 32-40.

The sole question before the Court on this appeal is:

Did the lower Court err in granting an Injunction?

The title of appellee-patentee is conceded, as well as is the due issuance of the patent and incorporation of the defendant (Appellant's Brief, p. 3).

Infringement of the First Cohn patents is admitted by the defendant. (X-Q. 109, R. 551.) Infringement of the Second Cohn Patent was also admitted by the defendant, although later this admission was withdrawn. Independent, however, of this admission proofs were later submitted by complainant to show infringement.

The only ground that appellant-defendant has urged for contesting the Order for the Injunction is that the inventions covered by the letters patent

were not novel at the date of the invention thereof by the appellee, Cohn. The Defense, therefore, is founded on Anticipation, with its corollary lack of Invention. This defense is alleged to be made out by certain prior patents which were carefully considered by Judge Van Fleet and referred to in his Opinion; and rests also on the claim that either Regenstein or an associate of his, one Reese, invented the subject-matter of the First Cohn Patent prior to the invention thereof by the patentee, Cohn. But as the proofs show Regenstein lays no claim to a possession of the invention earlier than January, 1904, whilst Cohn has amply established his conception of the invention, the making of models and a disclosure thereof to others prior to October 15, 1903, and has shown due diligence in reducing the invention to practice and applying for patents.

Concerning the effect to be given the decision of the lower Court, we would quote the words of the Circuit Court of Appeals for the Eighth Circuit recently, in *De Laval Separator Co. v. Iowa Co.*, 194 Fed. 423:

“When the chancellor has considered conflicting evidence, and made his finding and decree thereon, they must be taken to be presumptively right; and unless an obvious error has intervened in the application of the law, or some serious mistake has been made in the consideration of the evidence, they must be permitted to stand. *Tilghman v. Proctor*, 125 U. S. 136, 8 Sup. Ct. 894, 31 L. Ed. 664; *Kimberly v. Arms*, 129 U. S. 512. 9 Sup. Ct. 355, 32 L. Ed. 764;

Evans v. State Bank, 141 U. S. 107, 11 Sup. Ct. 885, 35 L. Ed. 654; *Furrer v. Ferris*, 145 U. S. 132, 134, 12 Sup. Ct. 821, 36 L. Ed. 649; *Warren v. Burt*, 58 Fed. 101, 106, 7 C. C. A. 105, 110; *Paxson v. Brown*, 61 Fed. 874, 883, 10 C. C. A. 135, 141; *Stuart v. Hayden*, 72 Fed. 402, 408, 18 C. C. A. 618, 624; *Coder v. Arts*, 152 Fed. 943, 946, 82 C. C. A. 91, 94, 15 L. R. A. (N. S.) 372."

The appellant's arguments now presented to your Honors' attention are identical with those used in the lower Court and its Brief on Appeal is almost word for word a copy of the Defendant's Brief on Final Hearing. No new theories, no new reasons are advanced now by appellant adverse to the patents that were not with equal earnestness and lucidity laid before the lower Court.

On pages 3 to 8 inclusive, of Appellant's Brief, the establishment of 18 facts supposedly favorable to defendant are claimed with respect to the patents in suit.

ON BEHALF OF COMPLAINANT THE FOLLOWING ALLEGATIONS OF APPELLANT ARE DENIED:

1—It is denied that Julius Regenstein ever made any one-piece transparent envelops with a border in January, 1904, or at any other time in fact prior to the date of Mr. Cohn's application for patent. This matter will be fully gone into under the head of "Defenses."

2—It is denied that the border in the "three-color" or lithographic art was ever used "to cover up and

conceal ragged, imperfect or unsightly edges *resulting from the running of the ink or colors;*" because it is undeniably the fact that the ink used for this kind of work does not *run* or *bleed*, and a border is only used where the job is left *intentionally* in an unfinished condition to receive a border later (like where a trimming strip of wood is nailed over the unfinished ends of boards), or where the color printer wanted to get a *higher price* for his work. The border of the old "three-color" work, as testified to by Regenstein and his witnesses, and shown by the samples of the Osborne Art Calendar, was a matter of individual fancy, and of extra price; and *even where used as seen in many of the pictures in the Osborne Art Calendar, the border did not even cover up the so-called deficiencies in the pictures!* See for example "A Florentine Girl" No. 4202 on page 43; and the picture of "A Soldier and a Girl," page 54; also page 59; also page 61; see testimony of Regenstein, R. 324.

A picture without a border is just as good as one with a border; see picture "Off to the Front," loose sheet 4564 and on page 54, also Regenstein X. Q. 285 and 286.

Furthermore a border never appears in the *body* of the picture where the different colors blend and where *running* of the colors would be most perceptible if they ever ran or bled, which they do not do. There are splendid examples of pictures and labels in this Osborne book which shows no borders and

By Mr.
Banning
Sec. Fe
p. 383

See Rec.
281.324
Ing's Note

where a border would be a positive detriment. See the cigar box labels at the back of the book. The uses of the border by Cohn and the lithographers were not analogous.

Cohn created a new art and a new industry and both he and Regenstein were driven to evolve the border in the combination through experience and necessity.

3—It is denied that the Brown patent shows or describes a one-piece transparent envelop made of opaque paper and with window spaces “rendered transparent by the application of an *oily* or *similar suitable preparation*.” We are surprised at Counsel even claiming that Brown shows or describes anything about the use of “oil” whatsoever. The assertion on behalf of appellant is wholly unwarranted, although it is only a repetition of his argument in the Court below.

4—The defendant uses the border for precisely the same purpose and in the same combination and in substantially the same way as taught by Cohn.

5—It is denied that the Busch British patent shows a “border.” It is true that defendant’s expert and his Counsel *thought* it did, but we will point out how they were mistaken and that Busch is simply for a transparent stock envelop made from transparent paper.

6—It is denied that any combination of Brown, Busch, and the “three-color” art, or the printing art

Mr. Bann-
ing's Note
See Rec.
293

Mr. Bann-
ing's Note
See Rec.
614, 617.

Mr. Bann-
ing's Note
See Rec.
609.

Mr. Bann-
ing's Note
See Rec.
580.

generally will, "produce the envelop described and claimed in the First Cohn Patent sued on." We will show why they do not do so, either singly or combined, and we will show that the law does not sanction such massing of patents in prior arts to destroy a meritorious invention.

Your Honors, in the recent case of *Kitchen v. Levison*, 188 Fed. 658, said in upholding the Levison 1902 Patent on a Triplicating Manifolding Book having a *bound* carbon, over the prior Barlow Triplicating Book with a *loose* carbon and the Bengough *Duplicating* Books with a *bound* carbon:

"It is urged that the improvement which the appellee made on the prior art was simple and obvious. It may be conceded that it was simple, but that fact alone does not deprive the invention of patentability. There may be the highest form of invention in some of the simplest improvements on the prior art."

In the Levison case the "Barlow" 1884 patent was a much closer reference to the Levison patent than is the Brown patent, to Cohn; because the "Barlow Book" was a *practical* book and is used extensively today. Judge Gilbert said:

"But the device which is principally relied upon by the appellants is shown in the patent of H. G. and J. B. Barlow of April 29, 1884. *This patent anticipates the appellee's patent in every feature except one.* Instead of having their carbon sheet *bound* in the book as in the appellee's patent, it was *loose*. * * * Eight (18?) years after the issuance of the Barlow patent the

appellee conceived the idea of binding the carbon sheets with the stubs of the record sheets of the book so that the carbon sheets would always be in their place. * * * The patent to James Bengough of January 28, 1896, shows a *bound* manifold sales book * * *.

“In addition to the presumption which arises from the issuance of the patent to the appellee, there are to be taken into consideration as sustaining his patent, the further facts that when his invention was made, there was a *want* in the art for such a device, that in the prior art there were well recognized and admitted defects, and that the appellee’s device eliminated those defects and went into general and successful use. In view of all these considerations, we find the evidence insufficient to overturn the finding of the Court below that the appellee did exercise inventive faculty in devising the book for which he obtained his patent.”

7—It is denied that the numerous patents for imitation stained glass windows, dress charts, etc., relied on by defendant, have any bearing on the issues.

8—It is denied that printing the border of three-color work or a border such as shown in any of the above patents, upon Brown, “produces the envelop described and claimed in the First Cohn Patent sued on.”

9—It is denied that printing the border of three-color work or a border such as shown in any of the previously mentioned patents, upon Brown, even if such combination is possible, was merely an exercise of mechanical skill.

10—It is denied that Cohn did not make any transparent window envelops from opaque paper, produced by an oily preparation, and with a border, until “subsequent to May 9, 1904;” because Mr. Cohn and the other witnesses have positively testified that they did make experimental envelops in crude form, embodying the invention of the First Cohn Patent in the latter part of 1903 and were working diligently on the invention from the very first conception. It has never been claimed by Mr. Cohn that the envelops introduced in evidence were the earliest he had made, because his early specimens were burned up in the fire of 1906. There is nothing inconsistent in the marking of the envelops in evidence, with the words “Patent Pending,” and the evidence of conception and reduction to practice of the invention by Mr. Cohn in 1903.

NOTE: Defendant has nowhere denied as far as we have observed, either in the testimony or in the brief, the *conception* by Mr. Cohn of the invention in issue and its *disclosure* to others *prior to the alleged invention by Regenstein in January, 1904*, (See Mr. Cohn’s summary, R. 56):

“SUMMING UP WHAT I DID UP TO THE TIME OF LEAVING THE GLASS COMPANY ON OCTOBER 15, 1903, IS AS FOLLOWS:

“I CONCEIVED THE IDEA OF MAKING AN UNPUNCTURED ENVELOP WITH A WINDOW ADDRESSING SPACE.

“I SUCCEEDED IN MAKING AN OPAQUE SHEET TRANSPARENT BY THE USE OF AN OILY PREPARATION.

“I DISCOVERED AND APPLIED A PRINTED BORDER AROUND THE WINDOW ADDRESSING SPACE.

“I DISCLOSED MY INVENTION TO A DISINTERESTED PARTY.”

11—It is denied that the claims of the Second Cohn Patent sued on, are limited to envelopes containing a transparent window space considered by itself alone, and irrespective of the border. This is fully considered under the head of “Infringement,” herein.

12—It is denied that the Boldt British Patent shows or describes transparent windows in the shape of a trade-mark, article of manufacture or symbol of trade, or that this Boldt British Patent embodies or suggests in any way the invention of the Second Cohn Patent.

13—It is denied: (1) that as a matter of fact any combination of the First Cohn Patent and Boldt would produce the envelop of the Second Cohn Patent; and (2) as a matter of law it is denied that the First Cohn Patent is any part of the prior art with respect to the Second Cohn Patent.

14—It is denied on the two grounds last-above stated, that it would only require mechanical skill to combine the First Cohn Patent with the Boldt British Patent with anything else in the so-called prior art, to produce the Second Cohn Patent.

15—It is denied that the defendant's transparent window is as a matter of law not in the shape or form of an article of manufacture, or that it is not in outline characteristic of some symbol of trade, but is simply a regular Transo stock envelop. The transparency and the border constitute the window; "and the mere change in form, proportion or degree" practiced by the defendant is immaterial to the question of infringement.

The Century Dictionary gives the following definition of the word "Window": "In modern building this opening is usually fitted with a *frame* in which are set movable *sashes* containing panes of glass or other transparent material, *the whole frame with the sashes, etc., also being known as the window.*"

16—It is denied that "the defendant's envelop contains no permanent advertising or printed matter on the border or face of the envelop as required by the claims of the Second Cohn Patent sued on." The defendant has merely changed the *location* of the word "Heinz" from the outside of the envelop to the inside. The word "Heinz" "appears" on the face of defendant's envelop and is "permanent printed matter" and is "related to and in juxtaposition with the outline of the window" and it certainly "co-operates with said outline" and "indicates a particular brand of goods." (The claim does not say *printed* on the face of the envelop but as "appearing" on the face.)

17—It is denied that the defendant's envelop does not infringe the claims of the Second Cohn Patent.

CROSS-EXAMINATION OF MR. COHN.

Beginning page 104 and following, Appellant's Brief, Mr. Cohn is taken to task for refusing on cross examination at the time of putting in his *prima facie* case, to go into details as to when he first invented the envelopes here in issue. This cross examination was contrary to all the rules of evidence; it was objected to as not proper cross examination and it was further objected to by Counsel for complainant on the grounds that the cross examination was only a fishing expedition, having as its object the finding out in advance just how far back Mr. Regenstein would have to swear in order to even hope to win. That this was not proper cross-examination even in patent cases, see:

Aeolian Co. v. Standard Music Roll Co., 176
Fed. 811;

Ferry-Halloch Co. v. Orange Hat Box Co., 95
Fed. 186.

Just as was said in the latter case:

“While several of these questions might perhaps be permitted without substantial invasion of the rights of the complainant, yet, *in view of the evident purpose of the examining counsel to encroach upon such rights and to construct his defense under the guise of cross-examination*, sound discretion requires that he should be held strictly within the rule.

“Under equity rule 67, the party calling the witness must, in the first instance, be at the ex-

pense of taking the depositions, and this furnishes one reason, and in some cases one of considerable moment, why the cross-examination should be kept within the proper limits; but the chief reason, and one which is founded in principle, the maintenance of which is vitally essential in preserving the rights of litigants, is the one stated by me in *Aeolian Co. v. Standard Music Roll Co.*, *supra*, viz.:

“ ‘A party offering a witness stands sponsor for his credibility, and, stated generally, is bound by what he may say both on direct and cross-examination. Being so bound, he has the right to call him for a particular purpose, and his adversary has no right to examine him generally, but is confined to the subjects testified to by him in chief. The cross-examiner will not be unduly restricted in the examination. Full scope and opportunity will be afforded, for cross-examination is the best-known method for the ascertainment of truth; but it must be confined to the subjects of the direct examination. If it is desired to examine the witness as to other matters, the proper practice is to make him his own witness. The only exception to this rule is to show bias or prejudice and to lay the foundation to admit evidence of prior contradictory statements.’ ”

On *direct* examination five questions only were asked of Mr. Cohn as follows:

“Q. 1. Will you please state your name, age, residence and occupation. A. Max M. Cohn; 12 Monte Ave., Piedmont; Paper Man; Paper Business; Age 42.

“Q. 2. Are you the complainant in this action? A. I am.

“Q. 3. Are you the patentee mentioned in the two patents? A. I am.

“Q. 4. Do you own those patents? A. I do.

“Q. 5. Have you ever made any transfer or assignment of either of them? A. I have not.”

There is certainly nothing inconsistent in Mr. Cohn's answering, that “*at that present moment*” he could not tell when he first conceived the invention in suit, X. Q. 15, especially when he knew, or had reason to suspect, the object of the inquiry made on behalf of his canny adversary. Neither had he had occasion to look up the matter of dates, etc., as he had no idea of his being interrogated along these lines.

In answer to X. Q. 22 (quoted at page 105, Appellant's Brief) Mr. Cohn explained that: “it would be necessary for me to go through a great amount of data which I have, and consult with some of my witnesses, before being able to answer as to the time of conception.” And in answer to R. X. Q. 9 (quoted at page 107, Appellant's Brief) Mr. Cohn said: “as stated before, it is impossible for me at this time to give anything *definite* in reference to the time of conception.” The consequences of answering such questions at random can readily be imagined.

In making a *prima facie* case, all that is required of a complainant is to introduce his patent, show title to it and show infringement. The question as to when the invention was conceived or made, is immaterial, and can only arise when the defense sets up a contra-claim to prior inventorship and introduces *evidence* to that effect.

THE PATENTS AND INVENTIONS
IN SUIT; THEIR PURPOSE
AND HISTORY

THE PATENTS AND INVENTIONS IN SUIT; THEIR PURPOSE AND HISTORY.

The *generic* invention covered by the First Cohn Patent relates to an envelop made from opaque stock, having a window portion, through which the address on an enclosure may show through, made transparent by the application of an oil, or the like, and a colored or tinted border of opaque ink surrounding the transparent portion for the purpose of obliterating or concealing the effects of the tendency of the transparency-forming preparation to creep into the surrounding opaque stock.

The Second Cohn Patent pertains more especially to such an envelop in which the window and border, either singly or together, are in general outline characteristic of a trade-mark, or symbol of trade, and with which characteristic outline some permanent printed matter appears in juxtaposition, and co-operates therewith to indicate a particular brand of goods, and thereby confronting anyone seeing the envelop with a striking advertisement of a particular brand of goods of a particular merchant or firm.

The two inventions covered by these several patents were described in the original application as filed November 8, 1904; the original application being prosecuted for the *genus* envelop as given to the world in the First Cohn Patent, and the divisional application and Second Cohn Patent being for the *species* advertising envelop and protected and covered as "an advertising device."

The drawings of the two patents are illustrated on the next two pages.

Patent No. 824,908, although earlier in date than the other patent, was applied for subsequent thereto, to wit:—January 17th, 1905, as a “divisional” application of the original application filed November 8th, 1904, which original application resulted in the afore-said patent No. 835,850.

FIRST COHN PATENT NO. 835,850.

After stating that the object of his invention is to provide an envelop having a generally opaque, unpunctured face, with a more or less limited transparent area for the addressee's name and address to show through, and which envelop “shall be simple and cheap to manufacture, practical in every way and which shall offer novel and unique possibilities for advertising,” the patentee proceeds to describe his invention in the following language:

“In carrying out my invention I take a blank sheet of paper or an envelop-blank of suitable strength and texture which is, say, semitransparent and apply to a portion of one side of the blank generally on the inside, a preparation which has the property of rendering transparent the portion to which it is applied. The remaining portion or a part of the remaining portion of the blank which forms the face of the finished envelop A is then imprinted with a suitable opaque coloring matter.”

FIRST COHN PATENT

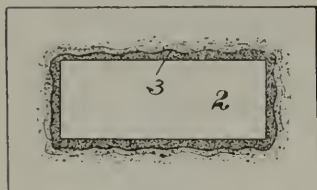
No. 835,850.

PATENTED NOV. 13, 1906.

M. M. COHN.
ENVELOP.

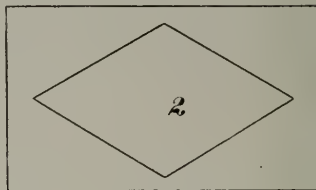
APPLICATION FILED NOV. 8, 1904.

Fig. 1.



A

Fig. 2.



A

Fig. 3.

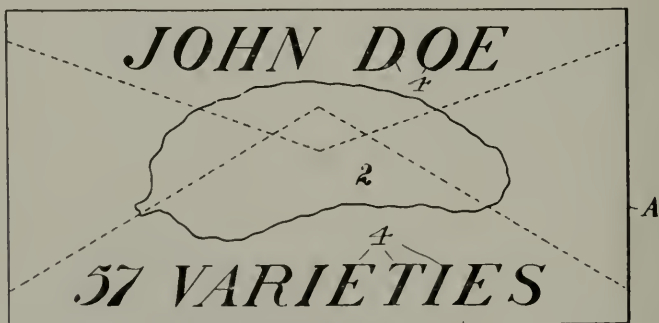
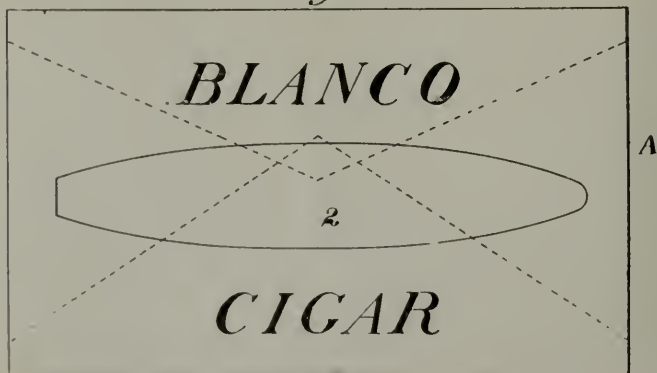


Fig. 4.



SECOND COHN PATENT

No. 824,908.

PATENTED JULY 3, 1908.

M. M. COHN.
ENVELOP.

APPLICATION FILED JAN 17, 1905.

FIG. 1.

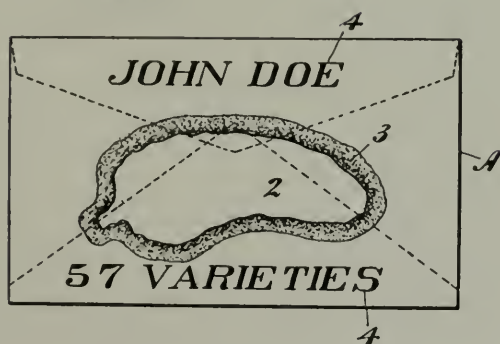
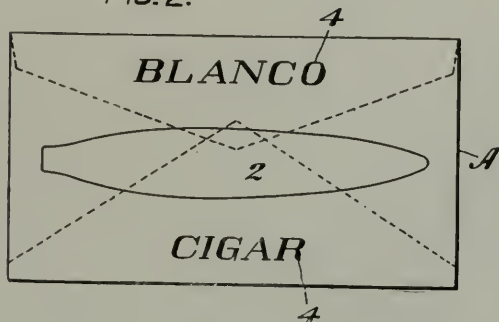


FIG. 2.



Continuing the patentee describes how he produces his transparent window in this opaque blank. He says:

“I employ a compound or preparation, such as parafin-oil and resin or a grease, which produces the desired result of rendering a semi-transparent paper transparent. This preparation is stamped or printed on or otherwise applied to the blank to provide the transparency or window of the desired design, and it is applied to such part of the blank where the transparency is desired to appear on the face of the envelop, and it may cover a larger or a lesser space, according to the desired size of the transparency or window.”

We would state here, that this was absolutely the first time in the art, that envelops were ever treated by means of an oily preparation to provide a transparent window portion. This use, however, of an oily preparation led to unforeseen difficulties which after various experiment, Mr. Cohn solved; some of these difficulties and the manner by which he overcame them being described in his patent, as follows:

“Since the oily preparation has a tendency to creep or ‘bleed’ beyond the borders of the space imprinted by the stamp or die by which it is applied, and so possibly stain or discolor the rest of the envelop or give a ragged appearance to the window-opening, it is preferred, even where the paper might ordinarily be deemed sufficiently opaque, to apply some sort of coloring-matter *at least* around the immediate borders of the transparency. This coloring-matter may be applied solid over the face of the envelop

around the window, as in Fig. 2, or it may take the form of graduated tints or of being shaded, or the representation of a surrounding cloud effect, as indicated at 3 in Fig. 1. In any event the effect and object of the colored border is to give definition to the window-opening and obliterate or cover up the otherwise rough unfinished outline of the window resulting from the encroachments of the oil or grease or other substance beyond its desired limits."

This use of oil with its attendant propensities to creep and the necessity of doing something to overcome this tendency, was wholly foreign to the printer's art is conclusively established by Mr. Regenstein when in answer to X. Q. 253 (R. 318) he says:

"I do not think that the making of paper transparent has anything to do with the printing art."

When we come to consider the infringing "Heinz Envelop," as appearing at the back of this brief, it will be seen how slavishly the manufacturer of the defendant's envelop has followed the instructions of Mr. Cohn as outlined by the quotations from his patent. *The defendant even applies his oil on one side and prints his border on the other, just as directed by Mr. Cohn in his patent, lines 85-88:*

"Usually and perhaps preferably, the preparation and coloring matter are applied to opposite sides of the blank, the preparations on the inside, and the coloring on the outside."

The reasons for applying the oil on one side and the border on the other side of the sheet was pointed out by Mr. Cohn in his appeal to the Commissioner of Patents, at the time his application was pending. (See file wrapper.) To quote:

“Now it is a fact that grease or oil applied to paper will spread more upon that surface of the sheet to which it is directly applied than upon the opposite surface. This probably is due to capillary attraction and to the oil following more quickly the direct path offered by the fibres which lie upon the side nearest to that to which the oil is applied; and if this side is an unprinted one or to which a coloring matter has not been applied to make the paper opaque, the ‘creeping’ effect of the oil will be more pronounced, as the printing ink itself would retard the same if on the same side as the grease, although it will not obliterate or almost entirely conceal the same, and the ragged line which would bound the transparent window would be unsightly and the window itself would not be sharply defined and have a neat finished appearance. When the colored preparation is used on one side of the sheet and the grease applied to the opposite side of the unprinted area, as we decide, we reduce the ‘creeping’ effects of the oil to a minimum, and obtain an envelop of commercial value, and the only envelop of this type which has proved commercially valuable.”

(Although Mr. Cohn describes the *advertising feature* in this First Patent, we will defer consideration of that until we take up the Second Patent, since this advertising feature is a separate invention and forms the subject matter of the Second Patent.)

The claim of the First Patent, is as follows:

As a new article of manufacture;

1—an envelop with an unpunctured face of relatively opaque stock—

2—said envelop face having a portion to which a preparation has been applied to render such portion transparent—

3—and a colored or tinted border surrounding said transparent portion for the purpose of obliterating or concealing the effects of the tendency of the said preparation to creep into the surrounding opaque stock.

This claim is therefore for an *envelop* as “an article of manufacture.” The reference character “2” represents the transparent portion of the unpunctured face to which a preparation has been applied and “3” represents the colored or tinted border surrounding the transparent portion “2” and obliterating and concealing the creeping tendencies of the oil.

The claim, we see, is a “combination” claim and is governed by the rules as to combination claims.

“ * * * It is no defense to claim of an infringement that one or more elements of a patented combination, or one or more parts of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that

all of them, or their mechanical equivalents, be found in the same description or machine, where they do the same work by substantially the same means. *Imhaeuser v. Buerk*, 101 U. S. 647, 660, 25 L. Ed. 945; *Bates v. Coe*, 98 U. S. 31, 48, 25 L. Ed. 68; * * *

J. L. Owens Co. v. Twin City Separator Co.,
168 Fed. 265.

To the same effect is the case of *Gormally & J. Mfg. Co. v. Stanley Cycle Mfg. Co. et al.*, 90 Fed. 280:

“Of course the claim can not be defeated by showing that each of its elements, separately considered, was old. The defendant must prove that the combination was old. If they fail in this, they fail irretrievably.”

The proofs show that the Cohn *combination*, including as it does *the ring or border*, was absolutely new in the art.

THE SECOND COHN PATENT.

No. 824,908.

Dated July 3, 1906;

Application filed January 17, 1905.

The patentee says that the present application is “a division of my original application ‘Envelop’ filed November 8, 1904, Serial No. 231,886.”

THESE TWO PATENTS, THEREFORE, ARE TO BE CONSIDERED AS APPLIED FOR ON THE SAME DAY AND NEITHER

PATENT CONSTITUTES AN ANTICIPATION OF OR LIMITS IN ANY WAY, THE OTHER.

“A divisional application takes the benefit of the date of filing of the original application from which it was divided.”

Smith v. Goodyear, 93 U. S. 486;

Brill v. North Jersey St. Ry. Co., 124 Fed. 778.

The date of invention and application and not the date of patent is the controlling date in determining as to the legal effect to be given to two patents issued at different dates to the same inventor in which are shown certain features common to both.

Suffolk County Mfg. Co. v. Hayden, 70 U. S. 3 Wall. 315 (18:76);

McMillan v. Rees, 1 Fed. Rep. 722.

Not only therefore, are both these patents to be considered as *applied for* November 8, 1904, but *neither patent is to be considered as part of the prior art with respect to the other.*

As was said in *Brill v. North Jersey St. Ry. Co.*, 124 Fed. 778:

“This patent (No. 627,900), being divisional relatively to patent No. 627,898, relates back to the date of the original application on which that patent was granted. The latter patent, therefore, does not, with respect to the divisional patent, belong to the prior art.”

NEITHER COHN PATENT LIMITS OR MODIFIES THE OTHER
AS EACH IS FOR A SEPARATE INVENTION.

At page 130 and following of his brief, appellant devotes several pages to try and show that in some way or another, the Second Cohn Patent is limited by the disclosures in the First Cohn Patent. We have already pointed out that such is not the law and that with two co-pending cases of the same applicant, each claiming different subject-matter, neither limits the other.

That this is not an open question, see the following cases:

Ide v. Trorlicht & Co., 115 Fed. 137-145, C. A.:

“Where each of several applications, which subsequently ripen into patents to the same inventor, describes an entire machine and the inventions claimed in all of the applications, but no one of the applications claims any invention claimed in any of the others, and they are all pending at the same time, the respective dates of the applications and of the patents and the dates when the applications were filed are immaterial, and the applications and the patents cannot be used to anticipate each other. *Walk. Pat. Sec. 180; Westinghouse Electric & Mfg. Co. v. Dayton Fan & Motor Co.* (C. C.) 106 Fed. 724, 726; *Suffolk Manufacturing Co. v. Hayden*, 3 Wall. 315, 318, 18 L. Ed. 76; *Graham v. McCormick* (C. C.) 11 Fed. 859.”

See also

Anderson v. Collins, 122 Fed. 451, 458;

Victor Talking Co. v. American Graph Co.,
140 Fed. 860; affirmed 145 Fed. 350;

Welsbach Light Co. v. Cohn, 181 Fed. 122,
126;

Cleveland Foundry Co. v. Detroit Co., 131
Fed. 853, 858, C. C. A.;

Kinnear Mfg. Co. v. Wilson, 142 Fed. 970,
C. C. A.

Consequently, the Second Cohn Patent is not limited or affected in any way by the First Cohn Patent. Conversely the First Cohn Patent is in no wise affected by the prior issuance of the Second Cohn Patent; for as said in *Cleveland Foundry Co. v. Detroit Vapor Stove Co.*, 131 Fed. 853, 858, C. C. A.:

“As was explained in the Dayton Fan & Motor Co. Case, when the patent first granted is distinctly and only for an improvement, on another invention which is already the subject of a prior application then pending, and on which a later patent is granted, the patent for the improvement in no wise interferes with the other application or the patent issued thereon, for the reason that the patents are for separate and distinct inventions. In just such a case as this we held that the later patent, being one for the generic invention, was not invalidated by

reason of the issue of a previous patent in which improvements upon the other only had been patented. We had already so held in *Thomson-Houston Electric Co. v. Ohio Brass Co.*, *supra*. It is true that in the applications for these patents for improvements there was no express disclaimer or renunciation of the matter of the former application. But that was unnecessary. That application was pending and being prosecuted in the Patent Office, and the fact that the application for the improvement patents did not intend to release his former invention to the public was as well understood as if he had in express terms said so. In order to explain the basis of the improvement patents, it was necessary to state what the improvement was upon, and how it fitted it. Having done this, he claimed what was new, and thereby distinguished what his patent was intended to include."

See also the opinion of Judge Taft in *Thomson-Houston Electric Co. v. Ohio Brass Co.*, 80 Fed. 712 C. C. A.

In his Second Patent Mr. Cohn says that the object of his invention, "is to so design the window opening and to *associate with said window such descriptive matter* as will offer novel and unique possibilities for advertising."

This is a succinct statement of purpose and of the relationship between the design of the window opening and the associated printed matter, and to which relationship and combination frequent reference will be made.

The specifications of the two patents are substantially the same. In the Second Patent the patentee after describing the method of forming this transparency and the use of the border, as quoted above in connection with the First Patent, goes on to say:

“Developing out of this idea of making an unpunctured envelop with a window or transparency for the addressee’s name to appear through is the idea of changing the form or outline of this transparency to correspond with the trade-mark, design, or advertised object of a merchant, manufacturer, advertiser, or other person, company, or firm.

“Fig. 1 shows a transparency in the shape of a cucumber, the trade-mark of a well-known manufacturer of a great many varieties of goods.

“Fig. 2 shows a cigar in transparency and the words ‘Blanco cigar’ in non-transparency on colored opaque field. The number of shapes this transparency may take is almost limitless. Different people might use an envelop with a window in the shape of an oyster, a fish, a cake of soap, and other toilet articles, a cascade, a dress-shield, a biscuit, an article of hardware, and other articles of manufacture, and so on indefinitely, having due regard for the necessary size of the transparency, so as not in any way to interfere with the clear showing up of the addressee’s name inside. The essential feature in this connection is a window which in general outline is characteristic of a symbol of trade. By ‘symbol of trade’ is meant any design such as mentioned above or trade-mark characteristic of certain goods or the product of a certain manufactory.

“When the window-opening is formed by the application of a grease or equivalent compound to the envelop-blank, the colored or stained window is essential to the production of a window of properly-defined outline.

“I thus produce a most unique and at the same time inexpensive and effective advertising medium. Every one needs envelops. These advertising-envelops can be made at small expense. They can be made of any shape or size and made to fit the stationery rather than the stationery made to fit the envelop. They can be used not only for mailing, but for sending out circulars and the like by messenger. The characteristically-shaped window and the associated letters and colored background constitute a most striking advertisement to attract public attention, the object of all advertising. I do not wish, however, to limit myself in the application of this idea of an envelop having a window which in outline is characteristic of a symbol of trade to envelops made originally from non-transparent stock, as above described, for I may employ a transparent stock and form the window-opening by printing with or otherwise applying opaque coloring-matter to a portion of the envelop.

“Generally the window-opening by itself alone and unassociated with any descriptive matter or words forming an essential feature of the trade-mark would have very little significance as referring to a particular manufacturer. For instance, a window in the outline of a bolt might refer to many bolt manufacturers, or a window in the shape of a cigar unassociated with a trade-name would be meaningless; but when there is associated with the window-opening of characteristic or peculiar design a trade-name

or some word or words usually associated with or relating to the pictorial feature every one seeing the envelop is confronted with a striking advertisement of a particular brand of goods of a particular merchant or firm. At the same time the envelop not only performs its ordinary function as a closure, but the transparent portion of the envelop allows the name and address on the inclosure to show through, protects the writing thereon, and obviates the necessity for an address on the exterior of the envelop."

As showing the possibilities of this invention as an advertising novelty, Mr. Cohn states that he had in his possession at the time of the fire in 1906, "some four or five completed envelop specimens of different designs and some *200 sketches*."

Also, that in 1905 he sent Mr. Regenstein specimen envelops, actually made up complete, showing the "Pickle" and "Cigar" design similar to the drawings of the Second Cohn Patent and like the "Cremo Cigar Envelop," Complainant's Exhibit "FF," and also a "Cascaret" design envelop.

Claim 1 of this patent is as follows:

An advertising device comprising an envelop,

1—having a window through which the addressee's name on an enclosure may show through;

2—said window being in outline characteristic of some symbol of trade;

3—a tinted or colored border surrounding and giving definition to said window;

4—and permanent advertising matter forming no part of the address appearing on said tinted border and related to and in juxtaposition with the outline of said window.

In Fig. 1 the outline of the window is characteristic of the “Pickle” trade-mark, or symbol of trade of the respondents, the H. J. Heinz Co. (See bottle and label, Exhibit “D.”)

In Fig. 2 the window is an outline of a cigar. The tinted or colored border which surrounds and gives definition to the window is represented by the *pickle-shaped border* “3” of Fig. 1, and in Fig. 2 it is shown as applied solid over the face of the envelop. The permanent advertising matter consists of the words, “John Doe, 57 Varieties,” in Fig. 1, and of the words “Blanco Cigar,” Fig. 2, which “form no part of the address and are related to and in juxtaposition with the outline of the window.”

Claim 2 of the Second Cohn Patent, is as follows:

As an advertising device, an envelop,

1—having a generally opaque face, except for a transparent window portion on which an addressee’s name on an enclosure may show through;

2—said window being in general outline characteristic of a symbol of trade;

3—and permanent printed matter on the face of the envelop related to and in juxtaposition with the

outline of the window, and co-operating with said outline to indicate a particular brand of goods.

Since the value of all advertising is its effect upon the public, so here with the envelop represented by the above claims, the value and efficacy of the patented envelop is indicated and measured by its effect upon the observer, and this effect is manifested to the observer by what he apparently *sees*. If by an *optical illusion* (as is apparently attempted by the defendant in this case by mere *change in location and form* of some of the elements) whereby that which is printed inside the envelop *appears nevertheless on the face* of the envelop—or whereby the necessary configuration or simulating a trade symbol is represented in a little different manner in one case than in another, but in both cases through the medium of the relationship primarily existing between the transparent area and border, *which together, represent the window*—we have a concrete embodiment of the combination of these two claims. This matter will be again referred to when we come to consider the question of infringement.

It is a singular coincidence in this case, that the defendant, The H. J. Heinz Co. with its well-known trade-mark, was the motive and inspiration of Figure 1 of the Second Patent in suit; and it is a still more remarkable coincidence that the only two advertising envelops which the Transo Paper Co. and Regenstein have made, are the Heinz envelop and the Stickney Cigar envelop, Exhibit “E,” both pic-

tured in the Cohn patents. A greater tribute to the genius and teachings of Mr. Cohn and an index to the lack of originality in Regenstein can scarcely be imagined. *It is manifest that the designer of the Heinz envelop had before him the Cohn patents when he laid out the Heinz envelop.* (Also compare the cigar envelop, Exhibit E—"Stick to Stickney's" of defendant, with the Cohn drawings and also with the Cohn "Cremo" specimen cigar envelop.)

THE QUESTION OF INVENTION AND MECHANICAL EQUIVALENCY IS OFTEN DETERMINED BY CONSIDERING WHETHER THE INFRINGING DEVICE IS MORE LIKE THAT OF THE PATENT IN SUIT THAN THOSE DEVICES CLAIMED TO ANTICIPATE THE PATENT.

The National Hollow B. B. Co. v. Interchange B. B. Co., 106 F. R. 699;

Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, C. C. A.

In the present instance, the evidence shows that *the only envelops ever in use embodying the patented combinations are the devices of the appellant and the appellee.*

In *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 118 Fed. 136, it is said at page 141:

"This question of mechanical equivalents is often well determined by considering whether the infringement is nearer to the patent in suit in its construction and means than those devices

which are claimed to anticipate the patent. When this test is applied, it is perfectly plain that the new structure of the defendants more closely imitates the means used by Hoyt to accomplish the desired purpose, than anything found in the art prior to the patent to Hoyt. There is nothing in the prior art that comes anywhere near so close to an imitation of the complainant's combination. Indeed, it is very plain that defendants' new structure would never have existed, if Hoyt had not taught how to make it. It not only operates the principle in the same way that Hoyt did, but it uses plain mechanical equivalents for every essential element of Hoyt's combination."

THE HISTORY OF THE INVENTIONS COVERED BY THE PATENTS IN SUIT.

THE TRADE—ONLY TWO KINDS OF "WINDOW" ENVELOPS KNOWN TO THE TRADE AND THEY DID NOT ANTICIPATE COHN.

At the time of Mr. Cohn's advent into the field in 1903, there were only two kinds of *mailable* envelopes known to the trade or in use which did not require the addressee's name to be written on the envelop.

In one the envelop blank was punctured in its face portion to form a window opening for an address and name on an enclosure to show through.

This style of envelop gave so much trouble to the Post Office authorities by reason of the unprotected edges of the uncovered opening catching in and clog-

ging the cancelling machine that its use to a considerable extent at least, was suppressed. (R. 112.) It does not now appear to be on the market.

The other kind of envelop was that known as the "Outlook" or Callahan 1902 patent envelop, in which the blank is punctured to form a window opening and from a separate sheet of transparent paper there is cut a blank of the shape of said window opening which blank is subsequently pasted to the inner face of the envelop over the opening. Such a construction is open to several serious objections, such as the extra cost in "puncturing" the face of the envelop; the cutting of the transparent blank, and the pasting of said blank to the inner face of the envelop; but more especially is there the objection of imperfect pasting and the consequent presence of raw edges to be caught and torn by cancelling machines or in the other handling of the mail.

There is also the liability of the paste becoming soft and "sticky" in the presence of moisture and the possibility of the inner or enclosed sheet adhering to the pasted envelop.

It is practically conceded that neither of these old types of envelops anticipate or show lack of invention in the patents here in suit. They are referred to now, simply to show that they represent the sum total of every practical effort in the direction of securing an envelop which could be sent through the mails and have the capacity of securely enclosing and

sealing the contents of the envelop and of revealing that portion only, of the enclosure, bearing the sendee's name and address, thus doing away with the necessity of writing the addressing directions on the envelop itself. These two types of envelops appear to be the only ones that ever succeeded in getting into use and one of those has proven a flat failure.

Everything else in the so-called prior art is purely a matter of theory and speculation; or the borrowing from widely different arts, a bit here and a bit there, and reconstructing under the exigencies of desperate defense and in the light of the teaching of the patents in suit, the Cohn inventions.

But, as is well known to your Honors, "anticipation by reconstruction," is not favored under the law.

THE WANT SUPPLIED BY THE COHN INVENTION.

The testimony of both Cohn and Regenstein, who may be considered experts in the manufacture of envelops having a transparent window, throws new light on the problem and novelty of envelops of the type here in suit.

The history and development of the inventions in suit by Mr. Cohn, the patentee, appears at pages 111 and following of the record.

In brief, it shows that prior to 1902 Mr. Cohn had been using in business an uncovered window envelop

of the first type described and was reluctant to give its use up after objections made by the Post Office. He set about to get up an envelop which would be acceptable to the postal authorities and, as he says:

“I finally concluded that there were two ways of accomplishing this result. One, by taking sheet of transparent paper and rendering it opaque with the exception of the space reserved for the address, and the other by taking a sheet of opaque paper and rendering it transparent in the portion reserved for the addressing space. Shortly after coming to this conclusion, I began a series of experiments. I encountered *very little difficulty in taking a transparent sheet and rendering it opaque* in that portion not reserved for the address, but I found *a great deal of difficulty in taking an opaque sheet and rendering it transparent in a certain portion.*

“I tried a great many different kinds of paper and a great many different kinds of preparations, but was not satisfied with any of the results obtained. The principal difficulty being that whenever I applied the preparation which in every instance was of an oily nature, I discovered that the preparation had a tendency to spread beyond the limits of space where it was originally applied. After much thought I finally struck the idea of printing a border around the transparent portion, and after that all my experiments included this border, and I have always considered it a very essential feature of my invention.”

This is practically the same difficulty experienced by Regenstein.

This discovery took place prior to October 15, 1903, while Mr. Cohn was still with the Illinois Pacific Glass Co., a large business firm of this city. On that date he went to work for the Zellerbach Paper Co.

The glass company had a large printing and label department, which Mr. Cohn made use of in his early experiments. In these early experiments he applied the oil with a brush, but later with a block of wood and pieces of rubber. Finding how the oil would in all instances creep beyond proper limits, he says he consulted Mr. Epting, an artist employed in the lithographic department of the glass company, who made drawings from which a zinco was made. Cohn says:

“Among others was a design showing an oblong space surrounded by a cloud effect. I have in my possession an envelop which was made from the original zincograph. This envelop shows that the ink is applied solidly around the space, which is understood to be the space reserved for showing the address, which I will call the window space, and is gradually shaded off.”

The envelops later made by Mr. Cohn from this zinco are illustrated by the “Cloud-effect” envelops in evidence. (Exhibits N and O.) Concerning this early work, Mr. Cohn says:

“The first ink that I used did not answer the purpose, and *I was obliged to experiment with*

a great many different kinds of ink before securing one that would answer the purpose."

This is another difficulty Regenstein says he encountered.

Mr. Cohn, prior to October 15, 1903, disclosed his invention to Mr. Bean, an expert accountant, and several others who testify in his behalf.

Mr. Cohn says:

"Summing up what I did up to the time of leaving the Glass Company on October 15, 1903, is as follows:

"I conceived the idea of making an unpunctured envelop with a window addressing space.

"I succeeded in making an opaque sheet, transparent by the use of an oily preparation.

"I discovered and applied a printed border around the window addressing space.

"I disclosed my invention to a disinterested party."

All this it is to be understood was prior to the earliest date claimed by Regenstein. It stands uncontradicted on the record and, therefore, is admitted to be true.

Continuing, p. 117 R., Mr. Cohn states that following October 15, 1903, he carried on his work continu-

ously and uninterruptedly for nearly a year, at the printing shop of F. H. Abbott & Co., assisted by their foreman, Mr. Tooker. Mr. Cohn says:

“I found in some instances where I succeeded in getting a preparation that made an excellent transparency, that it would fade out and become almost useless, said preparations would keep the paper transparent for about a month and then for some reason or other, the paper would become opaque again, and in some instances this would occur within a very few hours after the preparation had been applied. I kept persistently at work from the time of my conception until about August or September of 1904, when I brought my invention to a state of perfection. It was at this time that I placed an order for the Zellerbach Company with F. H. Abbott & Company for 10,000 envelop blanks, such as described above, and I still have in my possession a sample, which I here produce.” (Exhibit L.)

These difficulties encountered by Mr. Cohn foreshadowed the same difficulties which Mr. Regenstein says he met with in trying to bring the Transo envelop to a state of perfection, although it was not until 1905, many months *subsequent* to the issue of the 10,000 envelops by Mr. Cohn, that Regenstein or the Transo Paper Co. ever made any *use* whatsoever of a Transo envelop, or an envelop such as Regenstein claims the honor of originating.

Mr. Cohn even introduces an actual specimen of one of his old envelops which is post marked “San Francisco, November 27th, 1 P. M.,” and which was

sent to Manila, P. I., and bears the Manila postmark of December 28, 1904, 3 P. M. (Exhibit M.)

CONTEMPORANEOUS WITH THIS WORK OF MR. COHN IN PERFECTING THE ENVELOP OF THE FIRST COHN PATENT, HE DEVELOPED, TRIED OUT AND ABANDONED AS IMPRACTICABLE THE ENVELOP EXHIBIT R (COHN & SHIPP BRITISH PATENT), MADE FROM "TRANSPARENT" STOCK.

Mr. Cohn (R. 126) says he made up some hand-made envelopes using *transparent paper* and printing the same with opaque ink over the entire surface with the exception of the addressing space, and applied for a patent, said application being filed in the Patent Office on May 9, 1904, Serial No. 207,082. He also applied for a patent in Great Britain, jointly with one J. C. Shipp, June 27, 1904. The application of the United States patent was disallowed. The British patent was granted, and is numbered 14,478, A. D. 1904.

Cohn discovered, however, that the envelopes made by this method were not satisfactory or merchantable, firstly, on account of the transparent paper he was compelled to use was of a very brittle character, and had a tendency to crack; secondly, it was very difficult to seal envelopes of this character, the gum used in the ordinary envelop not adhering to the smooth surface of the transparent paper; thirdly, stamps would not adhere with sufficient strength to

the smooth surface of the paper. The envelopes produced by this method had the similar appearance to the imitation Busch envelop, introduced by the defendant, opposite page 400 in the defendant's testimony.

Cohn says:

“Considering all the objectionable features I abandoned the idea of manufacturing envelopes of this character.” (Exhibit R.)

The drawing of the Cohn & Shipp British Patent is shown on the opposite page. It was held by the Patent Office not to anticipate or limit the claims in suit.

THE GENESIS OF THE SECOND COHN PATENT.

Mr. Cohn says that while working on various styles of envelop blanks he discovered that a good use could be made of the necessary border for the purpose of advertising, and made many specimens of envelop blanks embodying this idea, which was conceived, he says, by him “in the summer of 1904” (R. 120). His application for patent was filed November 8th, 1904, and prior to that date he had handed his attorney and solicitor perfected specimens embodying the “cigar” and “pickle” outlines. After filing his application work on this “advertising” envelop was conducted in the shop of Barnhart

Fig.1.

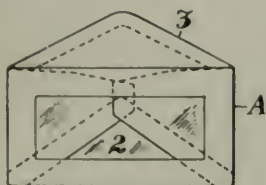


Fig.2.



Fig.3.

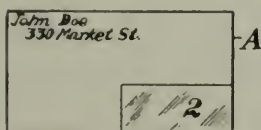


Fig.4.

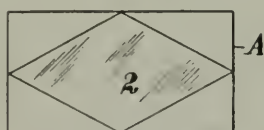
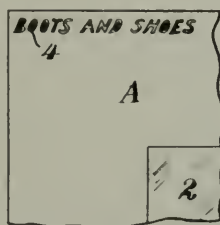


Fig.5.



[This drawing is a production of the Original on a reduced scale]

& Swasey, art printers (See Exhibit R), also "Cremo Cigar" envelop.

"Due diligence" on the part of Mr. Cohn is clearly shown. He says (R. 208):

"I worked continuously and persistently for over a year, beginning some time in 1903 and ending with the production of these 10,000 envelops in 1904, putting in many nights, many Sundays and several holidays. I never at any time desisted from my efforts, but kept on patiently sticking to the object I had in mind, never quitting until I accomplished the object that I sought. During this period I expended some \$3000.00 which may not appear to be a great sum to some people but meant a vast amount to a man of my means. This money I used for various purposes, such as the purchase of different chemicals and oils used in making my preparation; also for ink and paper of numerous nature and consistency. Part of this money was also used in paying for labor which was generally at a high rate on account of the work being done on what is termed as 'over-time.' I also paid to chemists various amounts for work done at my request. I frequently found that after spending much time and money on a certain preparation that the same was useless for my purpose and it was necessary for me to start over again. During this period I did a little work on the envelop described in my abandoned application dated May 9, 1904, but the expenditure of time and money on this particular feature was very trivial."

CORROBORATION OF COHN'S TESTIMONY.

Mr. Cohn is corroborated with respect to his early operations both by a number of witnesses and by documentary evidence, including early specimens of work, Exhibits L-M-N-O-P-Q-R; Collection Statement of April, 1904, Ex. "V" and patent Ex. "W"; Register Receipt Exhibit "X"; Cremo Cigar Envelop Exhibit "FF."

MR. BEAN, a system man, testifies that when he was experting the books of Dunham, Carrigan & Hayden, in the fall of 1903, and on his first trip to California, that he met Mr. Cohn, who was then with the Glass Co., only a few doors away, and went over the plans of their bookkeeping system and general office work with Mr. Cohn (R. 207). At that time Mr. Cohn showed him some window envelopes with a border. Mr. Bean says:

"It was after the style of an Outlook envelop except that the opening was prepared by some process making it transparent. I remember that I told him that I had never seen anything like it before and that I thought it was a splendid thing, and I further thought that in my judgment there would be a good sale for that sort of an envelop. * * * As I remember the samples he showed me they were of rather rough construction and looked as if they had been made up by hand. Some of the samples were flat, just blanks, treated with this preparation. The transparent part was surrounded by a sort of a border or cloud effect. I don't remember much about the samples in detail. * * * In

talking about the matter I told him that I was surprised somebody had not thought about it before and I figured it was merely some sort of oil that was put on the paper to make it transparent, and he said that it was an oily preparation and that that was one of the secrets and that the border was to keep this oil from spreading."

Mr. Bean substantiated his recollection by reference to the books of the Baker-Vawter Co., of Chicago, by whom he was employed in 1903, and the same shows that the contract for Dunham, Carrigan & Hayden was dated August 14, 1903, and that the bill rendered Dunham, Carrigan & Hayden was for fourteen days' service between August 14, 1903, and October 31, 1903 (R. 223).

MR. SELLING, a salesman with the Illinois-Pacific Glass Co., testifies to the disclosure to him by Mr. Cohn in 1903 and before Mr. Cohn left the Glass Co. of the subject matter of the invention in issue including the envelop of opaque stock with a transparent window with a cloud effect border (R. 213-9).

MR. EDWIN EPTING, an artist in the Label Department of the Glass Co., at the time Mr. Cohn was employed there testifies (R. 247) and following, that Mr. Cohn disclosed to him his invention for an envelop of opaque stock with a transparent window portion and surrounding border and asked Mr. Epting to get him up some designs, including the "cloud effect." Also that they had zincos made (Q.

12) before Cohn left the Glass Co. (X. Q. 19, R. D. Q. 22).

WILLIAM DOLGE testifies that he succeeded Mr. Cohn at the Glass Co., as bookkeeper and chief accountant, on Oct. 13, 1903 (R. 251), and that he first met Mr. Cohn the first two weeks of October, 1903 (R. 252).

JOHN C. TOOKER, a pressman, and foreman of the press room of F. H. Abbott, where all of Mr. Cohn's work on his envelopes was done, testified (R. 234-47) fully and unequivocally as to the operations of Mr. Cohn in the latter part of 1903, and up to September, 1904, when the 10,000 envelopes subsequently used by the Zellerbach Co. were completed as a perfect, commercial product.

As to these operations Mr. Tooker says:

"The envelop was to be used in mailing matters. The feature of it was that it would be an opaque envelop with a transparent space through which it would be possible to see the writing of a portion of the matter enclosed therein. It was printed from a zinc block with a hole to allow for the preparation which would be applied that would make the paper transparent in the vacant space in the zinc. The metal was so etched out that it left a border which would cover around the place where this application for transparency was to be applied. We experimented in this matter for nearly a year. * * * It was no easy task to get the desired result. First, we had trouble in getting

the desired inks and the preparations; I mixing some of the inks and Mr. Cohn supplying me with that he got outside. All of the mixture for transparency was supplied by Mr. Cohn. There was quite a bit of trouble in getting the printing press to handle these different preparations, which required a good deal of time and thought. We had a great many difficulties to overcome, the main one being to get the desired transparency which he finally succeeded in getting. In getting this preparation we met with an obstacle which caused us a good deal of hard labor. That was to keep the preparation from spreading all over the sheet, or running, as the printer terms it. We put on the preparation on the paper first from a wood block, then we used rubber and different kinds of straw-board and card-board; also pulp wood, but they seemed to carry too much of the preparation which spread out on the outside of the printing space, giving it a tendency to flow further over the sheet. We finally tried felt, which seemed to work more satisfactorily with a little help in 'make-ready.' There was a tendency to spread from this preparation, which would have to be overcome by what printing pressmen call 'make-ready,' which I managed to overcome by cutting a piece of pulp board and gluing to the cylinder to press the sheet tightly on the felt, which would make the preparation sink into the paper and still permit you to carry less of the preparation thereby having that much less pushed on the outside of the felt, so that it would not spread. This piece of pulp-board was cut smaller than the felt, which made the impression on the paper a little away from the border, thereby allowing a little spread so that the preparation would not flow beyond the border, and thereby make the paper transparent, further than Mr. Cohn had

figured in working out this proposition; his idea being as I understood, to have the envelop entirely opaque, with the exception of the transparent space in between the border. We finally got to the place where we could turn out these envelops with the preparation covering the desired space and not spreading too far. He then gave an order for 10,000 of these envelops to be printed, which I printed about September, 1904. I base the date of the time of printing on the fact that I took my vacation at that time and some of the money which he paid me for my services went toward paying for my vacation. I do not remember of having done anything for him after that time. The envelops were printed and delivered to him and as far as I know all used up."

Mr. Tooker in explaining the manner of getting around the difficulties of impressing the oil on the paper and trying to reduce the creeping effect, introduces the drawing, Exhibit GG, illustrating the piece of pulp board, cut smaller than the felt. *This illustrates that the ordinary presses were not suitable for doing this sort of work and had to be specially rearranged, as pointed out in the quotation above.* This is the same difficulty met by Regenstein.

On page 244, Printed Record, Mr. Tooker testifies as to the difficulty in getting and keeping the presses clean and using heat under the presses. He says:

"We found another difficulty in using some of the preparations, and it became necessary in order to make the preparation flow as freely as

was necessary to use gas stoves under the press; heating the plate and making the preparation run out smoothly. We finally got these things so that the preparation run perfectly. The transparency that we reached in the earlier stages was inclined to be more dirty and mottled, not smooth. I am sure that around the Holidays of 1903 was the time when we first used the stoves; it being the winter time, and the preparation not having inclination at that time to flow freely."

This is the testimony of an "old printer" and an expert and shows clearer than most anything else in the record how difficult the problem involved was. *It is conclusive proof of invention.*

Mr. Tooker identified Exhibit L as one of the batch of envelops made (Q. 9) by the *scratch on the original zinco* and the *effect of which shows on said Exhibit L.*

Mr. Tooker says that it was during the summer of 1904 that the "advertising" feature was developed, including the "Heinz Pickle" and the "Cremo Cigar" envelops (Q. 22). He says, by way of identification of the latter:

"Looking at the envelop I see the outline of the piece of pulp board which I used on the cylinder of the press to smash in the preparation on the paper, making it transparent. This envelop has the words 'Cremo Cigar' in white letters on its face. You will notice in looking

at the envelop a ragged edge appears where the impression of the preparation was applied to the envelop, and not covered by the green border. That was done by me to press the preparation into the paper.”

Tooker (Q. 25) also identifies the “Cloud effect” envelops, Exhibits N and Q, by the streak on the left hand side of the envelops, which was done accidentally at the time of printing by a sheet of paper being caught and smashed down on the plate.

MR. VANDERSWIEP, R. 231-4, testifies that as mailing clerk for Zellerbach Paper Co. he used the 10,000 Cohn envelops (per Exhibit L), in the latter part of 1904.

JUST AS IN THE COURT BELOW, DEFENDANT’S ARGUMENT
IS MAINLY BASED ON HYPOTHESIS AND INUENDO.

On pages 110-111 of his Brief, appellant advances the frequently repeated hypothesis that “presumably” Cohn’s earliest samples were not produced until subsequent to May 9, 1904. As rebutting this *supposition* of defendant we have the *actually testimony* of Cohn and his witnesses as to his work while with the Glass Co., using a brush to apply the oily preparation; the manufacture of the zincos with the cloud effect, and the use of stoves in the winter of 1903-4 under the printing presses around the Christmas holidays of 1903, all of which would have been

unnecessary to produce envelops of transparent paper.

The appellant's contention (pages 110-111 of his Brief) that the transparent envelops Exhibit "R" *presumably* represent the sum total of Mr. Cohn's operations prior to filing his subsequent abandoned application, May 9th, 1904, is not only at variance with the testimony of Mr. Cohn, Mr. Epting, Mr. Tooker and Mr. Bean, but is inconsistent with the "cloud effect" zinco and with the early 1903 specimen envelops made from this zinco.

In order to make an envelop such as Exhibit "R" it is *necessary* to print a heavy body of opaque ink over the *entire* surface. It would be absolutely impossible to make an envelop like Exhibit "R" by means of a zinco showing a "cloud effect" since such an envelop would be worthless as it would leave part of the face and the entire back of the envelop transparent.

Again on pages 112-124, defendant attempts to capitalize his hypothesis by reason that the envelops introduced by Mr. Cohn bear the mark "Patent Pending." *Cohn never said that the words "Patent Pending" or "Patent Applied For" were not on the original cloud effect "Zinco," but were set up in type and printed on the envelopes later.* Mr. Cohn has fully explained how all his early specimens were destroyed by the fire of 1906. It is also note-

worthy that the defendant frankly concedes the possession of the invention and its reduction to practice by Mr. Cohn in the summer of 1904.

This matter of argument by "guess-work" constitutes the main asset of the defense.

When all has been said we submit that even though Cohn were limited to a reduction to practice in the summer of 1904, the specimen envelopes he has introduced are much better evidence in support of his claim to priority than are the Regenstein 1904 envelopes, on Regenstein's behalf, because the *latter show on their face that they could not have been produced outside of an envelop factory*, and the appellant's Counsel in his Brief practically admits, as he must, that they were machine-made. It is also indisputable that Mr. Cohn actually *used* his envelopes in 1904 while Regenstein does not even claim that he ever used a single envelop before 1905.

COHN'S ABANDONED APPLICATION MAY 9, 1904.

On page 111, Appellant's Brief, it is attempted to make capital out of the fact that this application was applied for first. Because Mr. Cohn happened to apply for a patent on the transparent stock envelop cuts no figure one way or another. In the first place this old abandoned application does not nor is it claimed to, constitute any part of the prior art, since it is in no sense a "printed publication." The same

rule applies to this, that does to the Reese abandoned application. (*Interurban Ry. & T. Co. v. Westinghouse Elec. & Mfg. Co.*, 186 Fed. 166, 168, C. C. A.). In the second place the fact that the subject-matter of the first Cohn Patent was invented prior to May 9, 1904, is not inconsistent with the complainant's testimony or that of his witnesses and with his legal rights in the premises; for as was said in *Ide v. Trorlicht, Duncker & Renard Carpet Co.*, 115 Fed. 137, 144:

"Concede that the applications of February 20, 1888, prove that Ide had invented the improvement here under consideration before those applications were filed. *There was no law which required him to apply for a patent upon his invention as soon as he made it.* The acts of Congress gave him the right to apply for and to obtain a patent upon his combination at any time after he conceived it, provided only that his invention had not been 'in public use or on sale for more than two years prior to his application,' and that it was not 'proved to have been abandoned.' Rev. St. Sec. 4886. There was no evidence of any prior use or sale of this improvement. *Clear evidence of an intention to dedicate an improvement to the public is indispensable to establish an abandonment.* There was no evidence of an abandonment at the hearing of this case, and the patent in suit and the application upon which it is based are persuasive proof that Ide never intended to dedicate, and never did dedicate the improvement they secure to the public. *Mast, Foos & Co. v. Dempster Mill Mfg. Co.*, 27 C. C. A. 191, 195, 82 Fed.

327, 331; *Woolen Co. v. Jordan*, 7 Wall. 583, 607, 19 L. Ed. 177; *Adams v. Jones*, 1 Fed. Cas. 126, 127 (No. 57); *Babcock v. Defener*, 2 Fed. Cas. 293, 297 (No. 698); *Jones v. Sewall*, 13 Fed. Cas. 1017, 1027 (No. 7,495); *McMillin v. Barclay*, 16 Fed. Cas. 302, 326 (No. 8,902); *Pitts v. Edmonds*, 19 Fed. Cas. 751, 757 (No. 11,191).''

THE DEFENSES

THE DEFENSE.

The Defenses are:—

First: That Cohn was not the original and first inventor or discoverer of the things patented, but that the honor belongs to Regenstein, or to one Reese, now dead.

Second: That the patents are void for anticipation or lack of invention, or else are so limited in scope that the claims cannot be construed to cover the Defendant's structure.

Third: That the Cohn inventions did not represent patentable subject matter.

The First and Second Defenses will be considered in the order stated.

The Third is more properly considered under the head of Invention.

I.

The earliest date that Regenstein lays any claim to the invention in suit is January, 1904, as against Cohn's established date of October, 1903.

Regenstein approached the subject matter of the present controversy originally along lines which he himself considered to be wholly independent from anything theretofore existing, and that a one-piece

envelop of opaque stock with a window portion for the address to show through and omitting a ring or border was an entirely novel proposition, and constituted patentable subject matter.

Regenstein states that his attention was first called to the envelop business by a man named Reese, of the American Can Co., who later took out a patent, No. 766,902, dated August 9, 1904, introduced in evidence, which patent date appears on all the Transo envelops. This Reese patent is simply on a sheet of paper having a number of transparent window portions, without borders, scattered over its surface, and the so-called invention is in so placing these windows that a maximum number of envelop blanks can be cut out of the sheet with a minimum of waste. The drawing of this patent appears on the opposite page.

The Reese application was filed January 15, 1904. It is not claimed that this Reese patent anticipates or discloses the Cohn inventions here involved.

Immediately prior to this application, Regenstein and Reese had submitted to Mr. Banning, their attorney, at the same time they took up with him the subject matter of this Reese patent, the idea of the *single envelop* itself as cut out of the sheet (R. 268). This *single envelop* was simply a piece of paper with a "grease spot" on it for forming the transparency and *did not show any border* around the transparent portion (Q. 49, R. 270). Mr. Banning (who is counsel for the defendant) gave his opinion that *both*

No. 766,902.

PATENTED AUG. 9, 1904.

G. REESE.
PAPER FOR MAKING ENVELOPS.
APPLICATION FILED JAN. 16, 1904

10 MODEL

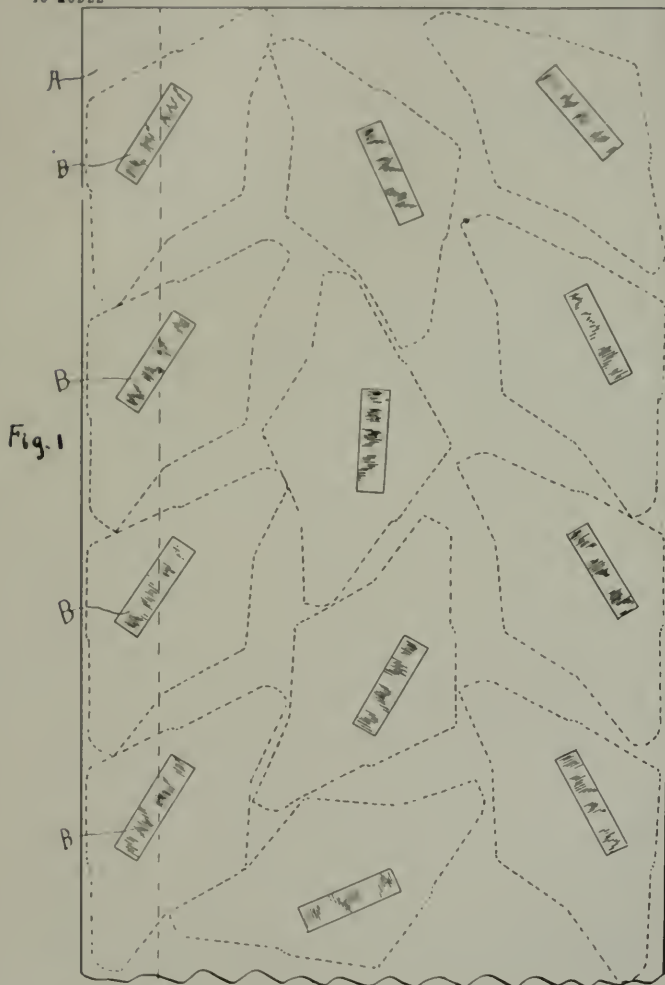


Fig. 1

Fig. 2

Witnesses:
William H. Wood
Walker Banning

Inventor.
George Reese
By *Balmain Banning*
Attys.

these inventions of Reese and Regenstein were patentable; Mr. Banning's letter of December 16, 1903, to that effect appearing in the Record at R. 268, and is as follows:

“December 16, 1903.

“Mr. Julius Regenstein,
 “135 Adams Street,
 “Chicago, Ill.

“Dear Sir:

“We have looked up the patent on the ‘Outlook’ Envelop, of June 10, 1902, and find that it was issued to Americus F. Callahan, of Chicago. The patent has one claim and it is limited to ‘an envelop having a comparatively opaque face and a display opening therein having a transparent covering,’ etc. From this you will see that there must be an ‘opening’ in the envelop and that it must have a ‘covering’ which is separate and distinct from the body of the envelop. It would appear, therefore, that the envelop shown by yourself and Mr. Reese *will not infringe the Callahan patent*. It has no ‘opening’ and no ‘covering’ for such opening.

“*We consider that the envelop which you showed us is patentable over the envelop claimed in the Callahan patent*. We further consider that the paper manufactured with opaque portions and transparent portions properly spaced and arranged to permit the envelop blanks to be cut out *is also patentable*. These two patents, however, will have to be applied for and taken out separately, *inasmuch as envelops form one class in the Patent Office and paper another*. Two patents will have to be taken if it is desired

to cover both the envelop and the paper from which it is made.

“Yours very respectfully,

“BANNING & BANNING.”

BY THIS LETTER DEFENDANT-APPELLANT IS ESTOPPED TO DENY THAT THE COHN INVENTIONS DO NOT PRESENT PATENTABLE SUBJECT-MATTER.

The Callahan Patent referred to is No. 701,839, June 10, 1902, introduced in evidence and covers the two-piece “Outlook” envelop which is also in evidence as “Defendant’s Exhibit Callahan Patented Envelop.” The drawing of this patent appears on the opposite page.

Immediate action was taken by Regenstein and Reese on the advice of Messrs. Banning & Banning and accordingly on January 15th, 1904, two applications for U. S. Letters Patent were filed: one which resulted in the Reese patent aforesaid and the other on the single envelop of opaque stock with a transparent portion without a border, which latter application was finally rejected by the Patent Office examiners and became abandoned.

(The file of this abandoned Reese application is in evidence as Complainant’s Exhibit H.)

If we turn to the Reese patent of Aug. 9, 1904, and to the Reese abandoned application, it is immediately manifest how different the inventions therein de-

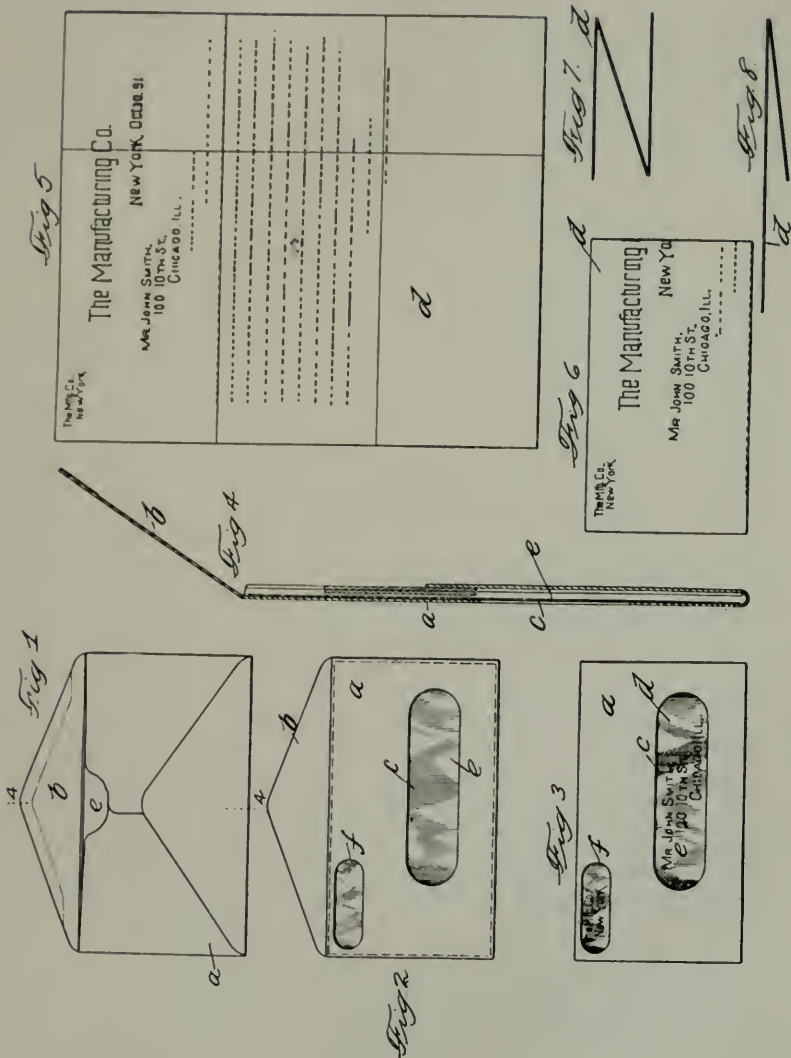
No. 701,839

Patented June 10, 1902.

A. F. CALLAHAN.
ENVELOP

(Application filed Dec. 9, 1901.)

(No Model.)



scribed are from the Cohn inventions, and from the defendant's infringing envelop and also from Regenstein's so-called Jan. 1904 envelop.

In the Reese abandoned application, Reese says, after stating that the object of his invention is to provide an envelop having means for displaying the address written on the enclosure to be legible through the envelop (which of course was the object of the old Callahan "Outlook" envelop):

"The body and flaps of the envelop, as shown, are formed of opaque paper of any suitable composition, and within the opaque body of the envelop is located a transparent portion F which is formed integral with the substance of the rest of the blank, and *said transparent space may be formed either by making the portion of the envelop constituting the transparent space of less thickness than the rest of the blank or by applying an opaquing substance such as ink, paint, or similar material to the rest of the blank, or by applying a substance, such as oil, to the space desired to be rendered transparent. It is preferred, however, to employ the first method and to make the transparent portion of less density or thickness. By making the blank in this manner the completed envelop will be much stronger and more durable than an envelop from which a portion has been cut away, or than an envelop having a transparent paper pasted over an aperture therein.*"

The paragraph above quoted is paraphrased in the Reese patent No. 766,902, of August 9, 1904, in the following language:

“The body of the completed sheet of paper will be opaque, and the spaces, which are formed integral with the body of the paper, will be transparent or semitransparent in one of the following ways: *first*, by reason of the *less density or thickness* of the paper at the positions indicated due to a greater pressure or to other means being provided in the manufacture of the paper to obtain this result; *second*, by the application of paint, ink, or similar opaqueing substance to all portions of a *transparent paper* with the exception of the intended spaces, which in this case also will likewise be of less density than the remaining portions of the sheet, since the opaqueing substance when applied forms a portion of the substance of the completed sheet, and, *third*, by the application of *oil* or similar substance to an opaque paper at those points which it is intended to render transparent. It is *preferred, however, to employ the first method and form the sheet of paper with a series of spaces therein of less density* than the surrounding material, but integral therewith.”

In the above quotation it will be noted that the method of producing the transparency is expressed in the *future* tense; that is, a sheet of paper “*will be* transparent, or *semi-transparent* in one of the following ways,” etc., thus conjecturally stating how the thing *might* be done, rather than expressing how and what *has* been done; although *Regenstein testified that before these applications were filed on January 15, 1904, he had already produced envelopes from transparent stock, having a transparent window portion made by the application of oil, which window portion was surrounded by a border to*

obliterate the tendency of the oil to creep into the surrounding stock. Nevertheless, in the face of these alleged activities, Regenstein not only neglected ever to file any application for a patent on this alleged "early in January, 1904," concrete embodiment, but in the two applications which he was instrumental in having Reese file at that time, he only incidentally and as an alternative method mentioned the use of the application of oil for forming the transparency, but emphasizes his *preference* of the employment of his first method of forming a transparent portion "by reason of the *less density or thickness* of the paper—due to a greater *pressure* or to other means, being provided *in the manufacture of the paper.*" He is evidently undecided as to the choice between *pressure* or "other means" for making the window portion "of less density or thickness." Whatever method he adopted to produce the area of lesser density he expected to accomplish that result "in the manufacture of the paper." It seems sufficient to state that neither Regenstein, nor the Transo Paper Co. had, as far as the evidence shows, ever made any envelops in which the window portions were formed according to his so-called "preferred method" of the first patent. He has offered nothing in evidence showing anything conformable with any of the disclosures in these early Reese applications.

THE REESE PATENT OF AUG., 1904, CANNOT UNDER ANY CIRCUMSTANCES BE CONSIDERED AS PART OF THE PRIOR ART AS IT WAS NOT PUBLISHED (IN FACT NOT

APPLIED FOR) TILL AFTER COHN'S INVENTIVE ACT WAS COMPLETED.

“A patent, to constitute a part of the prior art is judged by its date of issuance; not by its date of filing, nor by the date of its patentee's inventive act. Again, a patent, to be part of the prior art, must bear date of issuance prior to the date, of the inventive act, as proven by the testimony of the patentee of the patent in suit.”

Bates v. Coe, 98 U. S. 31;

St. Paul Plow Works v. Starling, 140 U. S. 184;

Diamond Drill and Machine Company v. Kelly Bros., 120 Fed. 282;

Anderson v. Collins, 122 Fed. 451;

Consolidated Ry. Co. v. Adams & Westlake Co., 161 Fed. 343.

Neither is the Reese rejected application sufficient to establish priority of invention under the Statutes.

An abandoned application adds nothing to the sum of human knowledge; is not a publication; and is not an anticipation.

Automatic Weighing Machine Co. v. Pneumatic Scale Corp., 166 Fed. 288, 297, C. C. A.

The Corn Planter Patent, 23 Wall. 181;

Lyman Ventilating & Refrigerating Co. v. Lalor Co., 1 Ban. & Ard., 403 Fed. Cas. 8632;

Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., 1 Ban. & Ard., 177 Fed. Cas. 10,337.

THIS REESE PATENT AND THE REESE ABANDONED APPLICATION, ASIDE FROM THE BANNING & BANNING LETTER OF DEC. 16, 1903, REPRESENT THE SUM TOTAL OF REGENSTEIN'S DOCUMENTARY EVIDENCE, AND THEY ARE ALL CONTRADICTORY OF REGENSTEIN'S CONTENTIONS.

It is conceded that neither of these Reese-Regenstein concepts anticipate the Cohn inventions. They are interesting merely as showing that the genesis of the perfected Transo envelop was *not* in these earlier conceptions and experiments of Reese and Regenstein.

Turning now to the evidence given by Regenstein: he explains (R. 270) that the envelop showed Messrs. Banning in December, 1903, and referred to in this letter, while made transparent by the use of oil or grease *had no* border and he could not remember the shape of the window, whether it was oval or square.

However, Regenstein attempts to prove that he or Mr. Reese was the first inventor, which one is not

clear from the testimony, of the subject matter of the First Cohn Patent, and has introduced in evidence two envelopes identified as the defendants' "1904 envelopes." They bear a general resemblance to the regular Transo Stock envelop, except that the ring of the so-called "1904 envelopes" is only about *one-half the width* of the regular Transo ring, and about one-half the width that Regenstein says is necessary in order to insure a covering of the creeping tendencies of the oil (R. 277). "The ring should be at least one-quarter of an inch wide to be safe."

Also this so-called "1904 envelop" has the oil printed on the *same side of the sheet with the ring*, while the regular Transo envelop and the defendant's infringing envelop has the ring and oil applied to opposite sides of the sheet, as called for by the Cohn patent. We are frank to say that the testimony relating to the origin and history of these so-called defendant's "1904 envelopes" is not satisfactory nor convincing, and in many parts is contradictory and is to be received with caution.

Regenstein called several witnesses, former and present employees to corroborate his date of January, 1904; but their testimony as to dates is wholly unsatisfactory, and with one accord they decide that they saw the '04 envelopes prior to the date of a certain strike which took place in the shop of the American Colortype Co.

When witnesses try to remember what took place 7 or 8 years back, concerning *that which Regenstein*

would have us believe was an incident of most trivial and fleeting importance, it is certainly a strain on one's credulity. Of course for Regenstein to magnify the event would be to confess a new discovery. But to most of Regenstein's witnesses a Transo envelop impressed them at the time as something decidedly novel. The idea no doubt did strike them as novel as it unquestionably struck Regenstein, but they no doubt have been mysteriously inspired with one accord to fix the date of the miracle as January, 1904, "before the strike."

Our opinion is, and we wish to impress it most strongly on the Court, that in all probability these so-called "January, 1904, envelops" of defendant, were at the very earliest made in January or February, 1905, and probably about the time that Regenstein left the American Colortype Co. and organized the Transo Paper Co. Not only is this view the most consistent with the facts of the various applications and patents filed by Regenstein and Reese during 1904 in this and foreign countries, and with the fact of the beginning of operations of the Transo Paper Co., but is also consonant with the various occupations followed by Regenstein.

Regenstein says (R. 295):

"For four years my business was the business of a photo-engraver, making all kinds of printing plates. In addition to this business, I, in 1894, went into the business of making and printing three-color plates. Three gentlemen

and myself started this art of three-color printing in this country in 1894. I supervised and criticised the work and was considered one of the foremost critics and experts on fine plate printing. *Since 1905*, I am actively engaged in the printing and manufacturing of envelopes, and late in 1903 and 1904, in connection with my business as a color-printer, I manufactured and *experimented* in the matter of Transo envelopes."

Mr. Regenstein by a series of grossly leading questions, states that during the "first part of January, 1904," he made envelop blanks transparent by the use of oils (R. 271). That *after* the blanks were made transparent *he discovered* "that no matter what oils we used the oil would bleed or be out of register" (R. 271); that "as soon as we found out early in January that the oil was found to bleed some, as old printers, we decided that we had to go back to our old trick and print a border which was intended to cover such bleeding of the oil which could not be prevented" (R. 271).

It is to be observed that prior to this date evidently *he did not know oil would creep or bleed*.

He also states that he spent some time *experimenting* with various *sizes* and *colors* of blocks.

In other words, in December, 1903, when he submitted the envelopes to his Patent Attorneys as indicated by the above quoted letter, and when they filed their applications for patent January 15, 1904,

neither he nor Mr. Reese realized the necessity, nor had the conception of the patented *combination* of Mr. Cohn.

CREDIBILITY.

In an attempt to corroborate him as to his claims to inventorship and priority, Regenstein calls as witnesses Ernest Sauerman, a pressman in the employ of the Transo Paper Co.; Joseph Wien, an employee of the Regenstein Colortype Co.; Gustaf Olson, an engraver; Max Lau, secretary of the American Colortype Co., of which Regenstein was formerly manager; Adolph G. Voss, cashier of the American Colortype Co.; Behrens, a salesman for the American Colortype Co. Of these, Sauerman is vacillating, and knowing the date to be established in aid of his friend, and that it must be "before the strike" is of course a willing witness. Wien is evidently not telling the truth; and if he is, it is impossible to tell which statements constitute the truth. Olson is shown the sample envelopes of 1904 *face up* with the words written across their face "Defendant's January, 1904, envelopes" and is then asked to remember when those envelopes were made! Lau and Voss both in so far as they *contradict* Regenstein as to the nature of the sheet they saw, prove the year 1905 as the real date, for the so-called January, 1904, envelopes. Behrens, who says he left the employ of the American Colortype Co. the latter part of May, 1904, and returned to them in February, 1906, fixes

no definite time when he first saw the old 1904 envelops, except he says in answer to leading questions that it was before he left his position in the latter part of May, 1904. Under the circumstances and the nature of the giving of all the testimony it is equally believable that he could have seen Regenstein's operations in 1905.

EVIDENCE OF DOUBTFUL PROBATIVE FORCE WILL NOT OVERTHROW THE PRESUMPTION OF NOVELTY AND ORIGINALITY ARISING FROM THE GRANT OF LETTERS PATENT FOR AN INVENTION.

Parker v. Stebler, 177 Fed. 210, C. C. A. 9th Cir.

The testimony of Regenstein and his witnesses comes far from measuring up to the standard of proving priority of invention or prior use beyond a *reasonable doubt*. In spite of the schooling that Regenstein evidently gave all of his witnesses and kindled the spark of recollection by the ever-memorable strike of the pressmen in 1904, which strike by a strange inspiration of unanimity, is referred to by all the witnesses, it is strange to observe how the witnesses fail to agree among themselves on all important particulars except the date, "the early part of January, 1904."

Regenstein says in answer to X. Q. 65, in referring to the old "January, 1904, envelop" Exhibits, "the

envelops I hold in my hand are some of the very first envelops we made in January, 1904."

Sauerman answered when asked Q. 26 (R. 350) if he could tell when he first saw envelops made out of paper that he had printed with oil and rings around the transparency. He answered:

"I can't remember the exact date."

He says (R. 350) that *he cut out some envelops by hand and folded them himself*, and later on he identifies the defendant's old "January, 1904, exhibit envelops" as two of those which *he had printed, cut out and folded himself*.

We would direct the Court's attention to the fact that these so-called "January, 1904, envelops" of the defendant are *die cut* and not hand cut; that they are cut with a steel die and *folded either by machinery or by an expert envelop maker*, as pointed out by Mr. Cohn (R. 159):

"The envelops referred to, defendant's exhibit No. 1 and No. 2, known as January, 1904 envelops, *were cut with a regular envelop die*. Dies of this character are quite expensive and are only kept at envelop factories. The envelops no doubt were folded and pasted by hand; the gum on the sealing flap also being applied by hand. The work, however, was done by an expert envelop maker, as no amateur could have made as perfect an envelop, and when I say a perfect envelop I only refer to the construction of the envelop, and not to the transparent portion,

which I do not consider perfect. It is a very difficult matter for an inexperienced person to fold and paste an envelop by hand, so as to give same a neat and finished appearance. It is still more difficult for an inexperienced person to apply the gum on the flap. The envelopes in the exhibits referred to, were prepared in the manner that is customary with experienced hand-made envelop makers, and is accomplished by taking a series of envelopes with the flaps turned up or opened out, one on top of the other, spacing same apart so as to leave sufficient width exposed along the edge of the flap to take the gum. A brush previously dipped in the gum is then run over the exposed edges by hand, applying the gum to each one successively, with the brush always moving in the direction of the opened up flaps. Any one familiar with the envelop business can immediately recognize envelopes prepared in this manner, because the extreme ends generally show an abrupt square appearance, parallel with the ends of the envelopes. They are further identified on account of the inner edge of the gummed area being parallel with the outer edge of the flap."

Consequently these envelopes now before the Court as "exact specimens" of the "very earliest work" done by Regenstein on his behalf and which he says were "hand made," *are not what they purport to be, but belong to some later date.* Our theory as already expressed is, that these so-called "1904 envelopes" were made probably in the spring of 1905, when the Transo Paper Co. began business, and were probably some of the first envelopes that they turned out. They have not introduced into evidence any *December*,

1903, envelops without the ring, nor any 1905 envelops; but it is manifest that they were doing a good deal of experimenting in 1905, with opaque ink, and narrow and wide borders, and it is to this period of 1905 experimentation that these so-called "January 1904 envelops" undoubtedly belong.

We are told by the witness Wien (R. 368, X. Q. 111) that there were no envelop machines in the factory of the American Colortype Co. The Company had no one connected with it, nor were any of its employees in the envelop business, nor had any of their employees ever been in the envelop business, and none of its witnesses were shown to have been skilled in the art of cutting or folding envelops.

We are constrained to advance the opinion that these so-called "January 1904 envelops" were cut and folded by an expert envelop maker in the factory of the Transo Paper Co. some time *subsequent to January, 1905*, or one year later than claimed by Regenstein. This theory is borne out by the testimony of Max Lau (R. 391 and following) that the envelop he saw Regenstein working on was a blank in *sheet form* (X. Q. 34), and that this sheet was "laid out in such a way to make envelops out of it" (X. Q. 37); "with *several window transparencies* on the one sheet with a border around each transparency" (X. Q. 40); "so that several envelops could be cut out of the printed sheet" (X. Q. 41); "*similar to Complainant's Exhibit 'G'.*"

Regenstein testifies that in 1904 he only made *one envelop blank at a time* on a Universal Press, and that it was not until 1905 when he organized the Transo Paper Co. and purchased *special presses* whereby he was able to print a number of transparencies on a single sheet in one operation (R. 573).

Regenstein says (R. 313, X. Q. 226) "a stock envelop today is printed on a cylinder press; at the time the No. 2 envelop was made we prepared only one envelop in one operation, now in one operation we print twenty-four."

Therefore Lau's testimony is effective only to prove the date of 1905 for these "early" Regenstein operations.

The witness Voss, who after stating that he was attracted to the early work of Regenstein by the unusualness of the work, and the peculiar shape of the ring plate, Q. 19 (R. 408) says also that his recollection is that the sheet was printed with a *group of three or four transparent portions* (R. 413).

Wien, sworn and examined on behalf of the defendant, testifies that he was working in the shop of the American Colortype Co. at the time Regenstein got up these envelopes in 1904. *First* he testifies in answer to Q. 13 (R. 355) that *Sauerman* put on the oil on the envelopes, and *later* in answer to Q. 23, he says:

"I printed the oil on the paper and *later in the afternoon* I printed the border around the window."

In answer to X. Q. 50 he declines to answer whether he had ever seen before this suit was brought, the two precise envelops before him. He also declined to answer X. Q. 63-64 when asked to state when he joined the Franklin Union, and when he made application therefor. He also declined to answer X. Q. 84, when asked "what was the general comment around the shop when this old envelop No. 1 and No. 2 was produced?"

He also declined to answer X. Q. 75:

"X. Q. 85. You said that one of the difficulties you had in getting up that old envelop, or printing it, rather, was to find a proper opaque-
ing. Please give us a detailed statement of just the steps you took, or the experiments you made before you arrived at what you thought was a satisfactory result?"

"A. I decline to answer."

Mr. Bann-
ing's Note
See Rec.
372.

Wien having testified that Sauerman printed the oil and then that *he* Wien had printed the oil, again reverses himself, X. Q. 101, when he says that Sauerman printed the two envelops before him, Defendant's Exhibit "1" and "2," and finally in answer to X. Q. 117 he admits he had nothing to do with them.

Certainly such evidence as this does not convince "beyond a reasonable doubt" that Regenstein was the first inventor of the subject matter here in issue.

Olson, the lithographer who is alleged to have made the very first ring plates for Regenstein, and was called to substantiate Regenstein's testimony, is shown the two "1904 envelops" *face up* with the legend printed on them "Defendant's Exhibits January, 1904, No. 1 and 2," and then of course is able to state that it was in January, 1904, that he made the ring and saw these envelops. On behalf of Complainant there was forthwith entered the objection to Q. 45 (R. 381) that it was leading, "in that the witness has just had before him and has carefully examined the two envelops referred to, and has attempted to identify them, or certain work that he did on them, and that on the face of each envelop there is printed, on a typewriting machine the date which it is evidently desired shall be given by the witness in his question."

Of course the effect and mode of asking such a question was to tell the witness the desired date which the witness forthwith proceeded to give.

Therefore, we submit to this Honorable Court that all of this witness's testimony, as far as it relates to this matter of dates, must go out as having been improperly educed.

Giving Regenstein the benefit of the doubt and overlooking the potency of the "strike" as a memory intensifier we have only Sauerman and Behrens to support him whilst Lau and Voss flatly contradict him.

From Regenstein's testimony, it appears he did nothing whatever in the envelop line between January 15, 1904, when he filed the Reese application, and February, 1905, when he organized the Transo Paper Co.

The undisputed evidence shows that it was subsequent by several months to November 8, 1904, (the date of filing of the Cohn application) that Regenstein and the Transo Paper Co. began the manufacture of envelops.

Although Regenstein claims to have had the idea of an envelop made transparent by the use of oils and using a border "early in January," 1904, as represented by his January, 1904, exhibits, *yet long subsequent to Aug. 9, 1904*, (the date of the Reese U. S. patent) they filed other patents in England, France and Canada on the Reese invention, and *never mentioned that they preferred to use oil, nor did they make any mention of the use of a border around the window for any purpose.*

The Reese British patent was filed *December 28th, 1904*, No. 28,592, accepted February 16, 1905. (Complainant's Exhibit "K.")

The Canadian patent was filed *December 16, 1904*, issued March 28th, 1905, No. 92,373.

The French patent is dated *April 5, '05*, if we are to believe Regenstein's imprint. A French, like a British patent, bears the date of its *application* and

not the date of publication or issuance as in the United States.

THE ESTABLISHMENT OF THE EXISTENCE OF THE ALLEGED PRIOR USE OF REGENSTEIN BEYOND A REASONABLE DOUBT IS ON THE DEFENDANT AND MUST BE SUSTAINED WITHOUT REFERENCE TO ANY PROOFS OFFERED BY THE COMPLAINANT IN REBUTTAL.

Cantrell v. Wallick, 117 U. S. 695 (29:1019);

Coffin v. Ogden, 85 U. S. 18 Wall 120, 124 (21:821) 823;

Parker v. Stebler, 177 Fed. 210 (opinion by Judge Gilbert), quoting *Cantrell v. Wallick*:

“The burden of proof is upon the defendants to establish this defense. For the grant of letters patent is prima facie evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty.”

In the “Barbed Wire Patent” case, 143 U. S. 275, also cited by your Honors, the Supreme Court says:

“Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that *almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented*

his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which the testimony is tortured or fabricated outright to build up the defense of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

DISCLOSURE OF THE INVENTIONS IN SUIT TO REGENSTEIN
BY COHN IN 1905.

In the Summer of 1905, shortly after the Transo Paper Co. commenced business, Mr. Cohn wrote to Mr. Regenstein and warned him in regard to his (Cohn) inventions (R. 140) and in September, 1905, sent Mr. Regenstein actual specimen envelops illustrating and embodying the inventions of both patents (R. 143). The defendant, after *denying* the receipt of these envelops, stating they were only "sketches" and not envelops, produces an old "Cremo Cigar" Envelop to impeach their own witness Regenstein (Exhibit FF) and confirm Mr. Cohn. When Mr. Cohn wrote in 1905, Mr. Regenstein characteristically turned Mr. Cohn's proposition down with the excuse that he had just quit the three-color business (The American Colortype Co.) and was tired of "satisfying cranks" (R. 143) and that he doubted Mr. Cohn's ability to get a patent anyhow.

On the issuance of his patents, Mr. Cohn wrote Regenstein as follows:

"12-4-06.

"Mr. Julius Regenstein,
"Chicago, Ill.

"Dear Sir:—

"I beg leave to refer you to U. S. Patent No. 835,850, Nov. 13, 1906, issued to me and to invite you to resume with me the negotiations heretofore suspended by reason of your doubts concerning the patentability of my invention.

"It is important that this matter be given your earnest attention at once, for, now that the delays of the Patent Office are over, I propose marketing my envelopes, and must soon know whether arrangements with you are to be made.

"Of more importance still is the fact that the envelopes you are now manufacturing, a sample of which I enclose, is an infringement of my patent as you will see by reference thereto.

"As matters of this kind can be gone into much more satisfactorily in personal interviews, I believe it would be to your interest to come to San Francisco immediately, so that we may go over the matter thoroughly.

"Please advise me at once whether I may expect you in connection with the above matter.

"Sincerely yours,

(Signed)

"MAX M. COHN."

To this Mr. Cohn received the following letter from Regenstein:

“Chicago, Dec. 10, 1906.

“Max W. Cohn,
“416 Jackson St.,
“San Francisco, Cal.

“Dear Sir:

“I have your favor of Dec. 4th and in reply wish to state that we have made envelops with a ring to cover the spreading of the oil, at least one year before you handed in your application. The idea, therefore, was not at all novel and was very old as far as we were concerned.

“It is very true that you have a patent which I could have obtained if I cared for it. This feature of a ring is very immaterial and we never considered it of very much consequence. We have made very successful experiments in making envelops without a ring, and expect to have nothing else in the future, on the market, but such envelops as mentioned. We take pleasure in enclosing you a very good envelop which has no ring. If you have anything to offer which is new, and of advantage to us, we would like to hear from you.

“Yours very truly,

(Signed)

“JULIUS REGENSTEIN.”

This was the first time Regenstein ever claimed to Cohn as having been the first or an original inventor of the matter in issue.

Although in 1906 Mr. Regenstein promised soon to have a “ringless” one-piece window envelop on the market, yet six years have gone by and the Transo Paper Co. has never to this day been able to dispense

with a ring (X. Q. 265). The envelop which Mr. Regenstein sent Mr. Cohn in 1906 was a *foreign made envelop and not a Transo Envelop at all* (Mr. Cohn, R. 148).

Premeditated infringement and defiance of the patent is shown by the following letter written since the filing of the suit:

“Transo Paper Company,
“Chicago, Illinois, Sept. 22, 1910.

“Gabriel Meyerfeld Co.,
“311 Battery St.,
“San Francisco, Calif.

“Dear Sirs:

“We have your favor of the 14th inst., referring to notice received from Max M. Cohn with reference to suit pending against H. J. Heinz Co., as users of Transo Envelops.

“This party holds a worthless patent, which he has tried to compel us to buy, but for which we have no use. We are fighting the case for H. J. Heinz Co., and there is no doubt but what we will be able to prove our contention in the matter. In the meantime, you are perfectly safe in continuing to use our envelop, as we will protect you against any possible action on the part of Cohn.

“We are sending you a further letter to this effect today from our patent attorneys, Messrs. Banning & Banning.

“Yours very truly,

(Signed)
“HA.ER

“TRANSO PAPER Co.,
Per Horace Anderton.”

THE LETTER OF MESSRS. BANNING & BANNING OF DECEMBER 16, 1903, AND THE REESE 1904 APPLICATIONS ARE THE ONLY DOCUMENTARY PROOFS OFFERED BY REGENSTEIN TO SUBSTANTIATE HIS CLAIM TO PRIORITY, AND THEY ARE AT VARIANCE WITH HIS ORAL TESTIMONY. THE CONCLUSION IS THAT AS BETWEEN COHN AND REGENSTEIN THE LATTER HAS FAILED TO OVERCOME EVEN THE FILING DATE OF THE COHN PATENTS, AND THAT INDEPENDENT OF ANY REBUTTAL PROOFS OF COHN, THE FILING DATES OF THE COHN PATENTS ESTABLISH COHN AS THE FIRST SOLE AND ORIGINAL INVENTOR OF THE PATENTED ARTICLES AS AGAINST REGENSTEIN.

THE "EXPERIMENTAL" WORK OF REGENSTEIN.

Even if Regenstein did actually develop the invention in January, 1904, to a point represented by his old "1904 envelopes," nevertheless, his work was experimental; was not persisted in and was entirely laid aside until a considerable time after Mr. Cohn had put his envelopes commercially on the market, and had filed his applications for the patents here in suit.

Regenstein never sent an envelop such as he claims to have got up in 1904 through the mails, nor tried it to see what the public would think of it.

IN OTHER WORDS, HE NEVER PUT HIS INVENTION TO USE UNTIL LONG AFTER COHN HAD DONE SO AND HAD APPLIED FOR PATENTS.

Regenstein's 1904 efforts, whatever they may have been, were not according to Regenstein's own testimony, sufficient under the law to give them any effect as an anticipation of the Cohn inventions.

Regenstein's testimony, as to his 1904 activities is most potent evidence of invention, and also of the fact that the problem, which he was seeking to solve, and which Mr. Cohn had *already* solved, was by no means an obvious one, and that success came to him, as it did to Mr. Cohn, only after months of experimenting.

Regenstein says (R. 573) :

"Q. 7. From January, 1904, when you begun until the present time, has there ever been a period when you discontinued or gave up the work, of making one-piece transparent window envelopes?

"A. We *experimented* during the early months of 1904, and did not *experiment* very much during the latter part of 1904, since we intended and did go actually into business early in 1905, and from *that time on* we *experimented* in various ways to this present day."

It is to be observed that Regenstein side-steps his counsel's query as to "diligence" and thus shows the equivalent of abandonment of the invention, until

after Cohn's envelops were on the market and the Cohn applications filed.

Previously, at R. 295, Regenstein says in answer to Q. 142:

"Since 1905 I am actually engaged in the printing and manufacturing of envelops and late in 1903 and in 1904 in connection with my business as a color-printer, I manufactured and experimented in the matter of Transo envelops."

Again, at R. 341, Regenstein says in answer to R. D. Q. 341:

"Our 1904 experiments stood for an envelop where the ink representing the border was printed on the same side where the oil was put."

Of course such operations and "experiments" have no relation to the subject matter of the second Cohn Patent because Regenstein admits that he did nothing with the advertising feature of the Cohn inventions until 1908 or 1909, X. Q. 149.

The purely *experimental nature* of the early operations of Regenstein is vouched for by his own witnesses who repeatedly speak of the operations as "experiments."

THE LAW AS TO EXPERIMENTAL WORK OR USE.

The rule governing this case, as far as Regenstein is concerned, is expressed by the Supreme Court in

the *American Wood Paper Co. v. Fiber Disintegrating Co.* (known as the Wood Paper patent), 23 Wall. 566; 23 Law Ed. 31, as following:

“The patent of an originator of a complete and successful invention cannot be avoided by proof of any number of incomplete and imperfect experiments made by others at an earlier date. This is true, though the experimenters may have had the idea of the invention, and may have made partially successful efforts to embody it in a practical form.”

See *Gaylor v. Wilder*, 10 How. 477, 13 Law Ed. 504;

Barbed Wire Patent, 143 U. S. 275, 36 Law Ed. 154;

Coffin v. Ogden, 85 U. S. 120;

Cantrell v. Wallack, 117 U. S. 689;

Bell v. People's Telephone Co., 22 Fed. 309,
The Telephone Cases.

Deering v. Winona, 155 U. S. 286, 39 Law Ed. 153;

Brown v. Guild (The Corn Planter Patent),
23 Wall. 181, 23 Law Ed. 161;

Lincoln Iron Works v. McWhirter Co., 142
Fed 967, C. C. A.;

Gamewell Fire Alarm Co. v. Municipal Signal Co., 61 Fed. 948, 952.

Christie v. Seybold, 55 Fed. 69, C. C. A.

Regenstein's experiments by reason of their laying dormant for fourteen months after he says he made them, and before he began business as the Transo Paper Co., were nothing more than "abandoned experiments" during all that period, and they were revived and perfected only after Mr. Cohn had filed his application for patent and made known his invention to the world by using 10,000 of his envelops.

In the *Lincoln Iron Works v. McWhirter Co.*, 142 Fed. 967, C. C. A., the Court said:

"It is not enough to defeat the patent that some one other than Gilmour had conceived the invention before he did, or had even perfected it, *so long as it had not been in public use or described in some patent or publication.* If Gilmour was an original inventor, though a subsequent one, it was his right to obtain a patent unless he 'surreptitiously and unjustly obtained the patent for that which was invented by another who was using reasonable diligence in adapting and perfecting the same.' "

There is nothing in the evidence to show that Cohn ever gained any knowledge of Regenstein's work along these lines until long after he, Cohn, had perfected his invention, put it on the market and filed his applications for patent here in suit. Aside from

that Cohn was the earlier *user*, as well as the first to conceive and disclose to others.

Judge Putnam, speaking of a claim to prior invention, Circuit Court of Appeals, First Circuit, in *Dececo v. Gilchrist Co.*, 125 Fed. 293-296, is interesting:

“Perhaps the matter has never been put more clearly than in the conclusion of a discussion as to the well-worn topic of who was entitled to the credit of the practical discovery or invention of the use of anaesthetics, found in Park’s History of Medicine (2d Ed.) p. 312, as follows:

“ ‘Sir James Paget has summed up the respective claims of our four contestants in an article entitled “Escape from Pain” published in the Nineteenth Century for December, 1879. He says: “While Long waited, and Wells turned back, and Jackson was thinking, and those to whom they had talked were neither acting nor thinking, Morton, the practical man, went to work, and worked resolutely. He gave ether successfully in severe surgical operations, he loudly proclaimed his deeds, and he compelled mankind to hear him.”’

“ ‘As Dr. Morton’s son, Dr. J. W. Morton, of New York, says, when writing of his father’s claim: ‘Men used steam to propel boats before Fulton, electricity to convey messages before Morse, vaccine virus to avert smallpox before Jenner, and ether to annul pain before Morton.’ ”

“This contains a line of observation which is ordinarily just and practical, and which, if applied to the present case, would probably enable

us to dispose of the alleged anticipation by Mann without further consideration. It is not now necessary, however, to go into this difficult topic."

In *Coffin v. Ogden*, 18 Wall. 120, 21 L. Ed. 821, the Supreme Court said:

"If the thing was embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon discovery or invention which was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view. The law required not conjecture but certainty. Until his work is done, the inventor has given nothing to the public."

This is an attempt to defeat a meritorious patented invention by proof that something similar had been previously known, though it had never been perfected, and had never been any useful contribution to human knowledge or convenience.

His Honor Judge Van Fleet has succinctly and correctly stated his conclusions on this branch of the controversy in accord with what has been said herein.

II.

THE SO-CALLED PRIOR ART.

This is the second defense. In the answer the defendant set up between seventy and eighty British

and American patents of which are actually introduced in evidence about fifteen or sixteen covering and including in their scope everything from an "imitation stained-glass window" through a gamut of "book covers," "coin bags," "devices for packing hooks and eyes," "needle wrappers," "tobacco cases," and "tablets," to "dressmaking charts," together with a miscellaneous sprinkling of experimental and impracticable types of envelops and wrappers; none of which, however, embody or anticipate the combinations of the claims sued on, or are constructed or operate according to the fundamental idea of the Cohn inventions.

"The citation of a large number of patents as anticipation, tends to strengthen rather than weaken the patent sued upon, by showing that the trade had long and persistently been seeking in vain what the complainants finally accomplished."

Forsyth v. Garlock, 142 Fed. 461-463.

"Forty-odd reference patents were not needed to prove that Dean was not a pioneer in the telephonic art, that he did not originate the granular-carbon type of transmitter, and that he was not the first to provide a means for preventing the packing of the granules. * * * The novelty of none of the claims is gainsaid by *any single prior patent or structure*; but *collectively* the references establish that all of the elements broadly considered, which Dean used in making up his combination, *were old and were commonly used* in transmitter construction. * * * but the concept of such a unitary structure was not

obviously taught nor foreshadowed by anything in the prior art."

International Tel. Co. v. Kellogg Switchboard Co., 171 Fed. 651 (C. C. A.).

Gandy v. Main Belting Co., 143 U. S. 556.

DuBois v. Kirk, 158 U. S. 58.

Hancock v. Boyd, 170 Fed. 600.

Novelty Glass Co. v. Brookfield, 170 Fed. 946.

The defendant has stated that the *Brown patent of 1862* is the nearest approach to the *First Cohn Patent* and the *Bolda British Patent of 1897* is the nearest approach to the *Second Cohn Patent*. (R. 536-8.)

On page 537, Mr. Bond, the defendant's expert, says in referring to this so-called prior art of the defendant: "*There is no one patent which meets the requirements and conditions in all respects of both of the Cohn patents.*"

THE PATENTS TO TUDOR, ET AL.

On page 48 and following, appellant in his Brief refers to the patents to Tudor, Hole, Leigh and to Smith and Browne. It seemed incredible that the appellant would disclose the hopelessness of his case by relying on these patents, which are so remote from the art to which the Cohn invention and the Heinz envelops belong, and in regard to which pat-

ents the defendant's own expert, Mr. Bond has testified so unfavorably. (See Record, pages 519-537, inclusive.)

Mr. Bond devotes *over 20 pages solidly typewritten*, to show the *differences* between the patents relied on by defendant and the Cohn Patent; (practically the same amount of space he devoted on direct examination to show *similarities*).

At R. 519-520, Mr. Bond says:

“THE TUDOR 1878 PATENT.

“The primary object of the Tudor patent is treating a blank sheet of paper so as to produce the appearance of a stained glass window, differing in this respect from treating a blank sheet of paper for the purpose of making an envelop having a transparent window.

“*One difference* between the process employed by Tudor and that employed by Cohn is that Tudor employs a plurality of opaque lines or borders to define a plurality of transparent sections or spaces, while Cohn employs an opaque border to define one transparent section or space in the paper.

“*Another difference* is the lack in Tudor of any permanent printed matter or advertising matter around the border of the transparent section or window, which is specifically required in the Second Cohn Patent.

“*Another difference* is that while Tudor defines various shapes for the transparencies, such

shapes are not characteristic of any symbol of trade, as required in the Second Cohn Patent.

“Another difference is that Tudor uses his prepared paper with its different colored transparent sections as an adjunct to a pane of plain glass, while Cohn uses his prepared paper as an envelop.

“Another difference or dissimilarity is that the paper is treated by Tudor for the production of ornamental window glasses and not for the production of an envelop, as intended by Cohn in treating the sheets of paper.

“Undoubtedly the invention of Tudor would be merchantable for the purpose intended, *but not for use as an envelop*, and likewise the invention of Cohn would be merchantable as an envelop, but not as an ornamental window glass.

“There are other minor differences, such as the shape or outline of the transparent sections of windows, of Tudor, as compared with the transparent section or window of the Cohn Patent; also in the shape of the complete product; also in the laying on of the opaque lines to define the transparent sections of the two articles, namely, the window glass and the envelop.

“These differences are apparent between the article produced by using the Tudor invention and the article produced by using the inventions of the two Cohn Patents.

“These differences result in the production of articles for different purposes and for different conditions of use.”

Aside from the “two best references” the Tudor patent is a fair sample of defendant’s anticipating patents.

The "prior art" has been arbitrarily divided by appellant in its brief into several "divisions"—no doubt according to the degree of remoteness each "division" has to the art of merchantable mailable envelops of the Transo quality.

The appellant occupies several pages of his Brief (pp. 27-44) in an attempt to show the analogy existing between the art of three-color work and the envelop art. The Counsel for appellant frequently refers to the use of borders in three-color work and in printing generally, "to cover or conceal the *running or spreading* of the inks or colors." Such a statement is unwarranted by the evidence, because the only time that any of the witnesses ever referred to "running or bleeding" of the inks was in answer to leading questions by defendant's Counsel in which he attempted to put these words into the mouths of the witnesses.

A glance at the Osborne Art Calendar, or at the *printing* in appellant's brief, or at this printed page, will show that there is absolutely no evidence of "creeping," or "spreading," or "bleeding," although the paper used generally, especially in printing these briefs, is a *soft, absorbent* paper, wholly unadapted to take a *pen*.

The function of the border in the printing art is entirely different from the function of the border in the art of making envelops. Mr. Regenstein's testimony is intended to mislead those not familiar with

the printing art, inasmuch as he attempted to show that a border is resorted to whenever a printed picture shows an irregular or uneven outline. It does not take an expert to prove the fallacy of this contention.

Firstly—It is possible to produce any picture or cut without a border as perfectly *and at less expense* than with a border. This is proven by defendant's own exhibit which shows pictures of the same character and produced by the same process both with and without a border. Defendant's witness (see answer X. Q. 68) testified that a border adds to the expense of a printed job.

Secondly—It would be optional with the purchaser if he would accept a picture with a border when he placed an order with his printer for a picture without a border. It is safe to assume that in the majority of instances such a job would not be accepted. For instance: If a concern that used a label, showing a picture of its trade mark, for many years, placed an order with a printer for a lot of labels to be *exactly the same as a sample submitted*, and this sample label did *not* show a border around the picture of the trade mark, is it reasonable to suppose that the printer would arbitrarily take it upon himself to print a border around the picture of the trade mark? And if he did, would it not be a certainty that the concern ordering the label would reject same on account of it being different from the sample submitted? The facts are, as shown by defendant's own

witnesses and Art Calendar Exhibit, that invariably it is decided *before* any picture is printed, whether or not it is to have a border and the plates are made accordingly.

The testimony submitted to show that borders are used in the printing art in the same manner as in the production of a transparent window envelop is not convincing, nor is it borne out by actual facts. Mr. Regenstein himself admitted that making paper transparent has nothing to do with the printing art. (See answer to X. Q. 253.)

We agree with Mr. Regenstein that there is no similarity in the two arts, envelop making and the manufacture of three-color work. As a matter of fact they are very dissimilar. *In printing*, great care must be taken that the ink does not penetrate the surface of the paper, because in many instances both sides of the paper are printed: but even if only one side is printed, it is essential that the reverse side is kept clean and unmarked.

In rendering paper transparent as practiced by Mr. Cohn and the defendant, an entirely opposite result is sought—it is *absolutely necessary to penetrate beneath the surface of the paper*. Both sides of the paper must be affected as no transparency would exist if only one side were affected.

“Printing” does not in any way change the character or consistency of the paper, the impression merely appearing on the surface of same, while ren-

dering paper "transparent" changes the character of the paper, as it is absolutely necessary to penetrate every fibre of the paper.

In printing a border around a picture, as the evidence shows and the Court knows, it is invariably printed on the *same* side of the paper as the picture itself, because it is obvious that printing a border on the reverse side would be useless. Mr. Regenstein and his witnesses testified that in making envelopes in 1904 they printed the border on the same side of the paper that the oily preparation was applied. (R. D. Q. 341.) Regenstein says: "Our 1904 experiments stood for an envelop where the ink representing the border was printed on the same side where the oil was put."

It was therefore not until 1905 when Regenstein started to manufacture envelopes commercially that he *abandoned* all of his own experiments and adopted the Cohn method of printing the border on the *reverse* side in this connection. Meanwhile Cohn had his application filed describing this method in November, 1904, and had already scattered broadcast ten thousand envelopes all over the United States, so that in accordance with Regenstein's own evidence Cohn was the first one to print a border on the *reverse* side and on *top* of the irregularities, and the Transo and Heinz envelopes are evidence of the fact that *this is the only way to make envelopes of this sort.*

THE "BEST REFERENCE" ARGUMENT OF DEFENDANT.

By having the defendant single out the Brown and the Boldt patents as being the most in point for the respective Cohn patents, our work, and the work of the Court, is very much simplified.

The case at bar is thus brought squarely within the doctrine of the case of *Waterbury Buckle Co. v. Aston*, 183 Fed. 120, C. C. A., Second Circuit, Judge Coxe speaking for the Court:

"That the patent is not anticipated is conceded by the defendant's expert. He says:

" 'If you wish me to find a single illustration in any single reference which exactly agrees in all particulars with the device of the patent in suit I am free to state that I do not find it and I do not think there can be anything found in my previous testimony to the effect that I have claimed to find it.

" 'X. Q. I understand you to admit that no patent and no exhibit discloses the particular thing set forth by claim 1 of the patent in suit. What I wish you to do now is to state for the information of the court and to simplify the consideration of the case by the court what one patent or exhibit comes the closest on the whole, taking everything into consideration, to meeting claim 1 as you find it? A. The first part of your question is correct, and in reply to the latter part of your question I would again refer to the U. S. patent to La Chappelle, No. 485,104, as coming the nearest, all things considered, to the device of the patent in suit.

“ ‘X. Q. Now, to save time, I will ask the same question as to claims 2, 4, 5, and 6, of the patent in suit? A. On the basis of your question and in my opinion the same reference applies to the other claims.

“ ‘X. Q. Then in your opinion the La Chappelle patent No. 485,104 comes the closest on the whole taking everything into consideration in your opinion to meeting the invention of the patent in suit and the terms of claims 1, 2, 4, 5, and 6 of the patent in suit, out of all the exhibits in the case? A. It does.’

“ *It seems necessary, therefore, to examine only the La Chappelle patent.* A diagram of the device of this patent will be found in the opinion of the Circuit Court. La Chappelle states that his object is—‘to produce an improved form of buckle that is especially adapted for use in suspenders; and it consists, mainly, in improved means of holding the web of the suspender securely without cutting or tearing it and of a secure and simple means for uniting the button-holed ends of the buckle.’

“ Evidently the patentee did not have the Peller *concept*. His was not a rustless buckle and was not designed to be such. A person skilled in the art, familiar with the complainant’s buckle might, by removing the hooked part, reconstruct the La Chappelle device so that it would accomplish in an awkward manner the same result as Peller, but this is not enough. *A patent cannot be invalidated by a structure which can only be altered into an anticipation by the use of inventive skill.* There is nothing in the La Chappelle device to suggest the Peller device to the mechanic. It does not operate and was not intended to operate, in the same way,

and, without radical changes, it is incapable of producing the same result."

As stated by Judge Coxe, it would seem, therefore, necessary only for this Court to examine the Brown patent with respect to the First Cohn Patent and the Boldt patent for the Second Cohn Patent. But evidently, as we will see, neither Brown nor Boldt had the Cohn *concept*. It is true that Mr. Bond, who is manifestly unfamiliar with this line of work, has endeavored to reconstruct and alter the Brown and Boldt patents in an attempt to meet *his* concept of the Cohn patents; but, as was said in *McMichael & Wildman Manufacturing Co. v. Ruth et al.*, 128 Fed. 706, 63, C. C. A. 304:

"The fact that an expert, with a patent before him, might be able to build up the structure covered thereby, by selecting and adapting appliances theretofore known, does not overcome the presumption of invention arising from the granting of the patent, where neither the same combination in its entirety nor the same mode of operation had previously been described or known."

THE BROWN 1862 PATENT.

The drawings of this patent appear on the opposite page.

With regard to the differences between Brown and the Second Cohn Patent, Mr. Bond says (R. 518):

"The envelop of this Brown 1862 patent differs from the envelop of the Cohn Second Pat-

J.S. Brown. Addressing Letters.

No. 393

Patented Sept. 9, 1862.

Fig. 1,

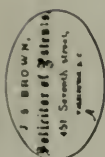


Fig. 3,

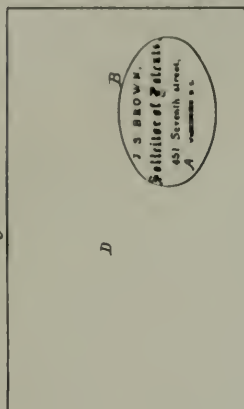


Fig. 4,

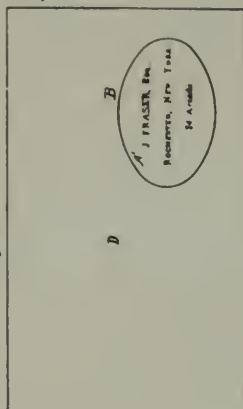


Fig. 2,

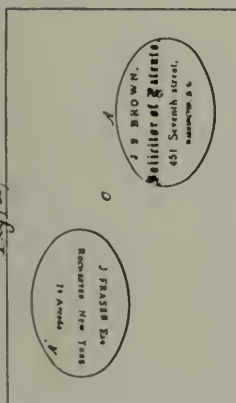


Fig. 5,

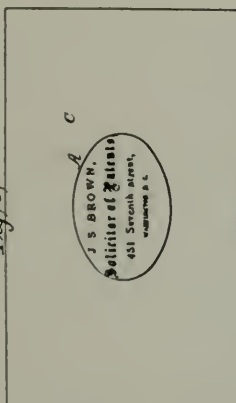
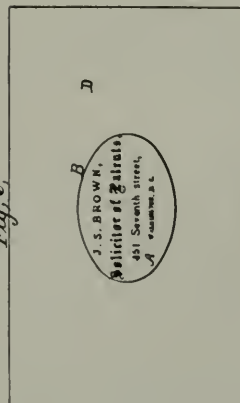


Fig. 6,



ent, in *not having the transparent section or window in outline characteristic of some symbol of trade*, and in *not having an opaque border surrounding this specific type of window*.

“A further difference is that the Cohn Second Patent makes provision for *permanent printed matter* or advertising matter on the opaque border around the transparent section or window, and of a character to co-operate with the outline of the window to indicate a particular brand of goods.

“The difference between what Brown intended and what Cohn intended in the use of printed matter or advertising matter is the difference between placing such matter on the card used by Brown independent of the envelop proper, and placing such permanent printing matter on the face of the envelop outside of the transparent section or window. In the one case, that of Brown, the printed matter, whatever its nature, was not a permanent part of the envelop, while in Cohn such printed matter, whatever its nature, formed a permanent part of the envelop.”

This last statement that Brown “intended” or designed his envelop as an envelop with the printed matter on the enclosure, if it meant any more than the *address on the enclosure*, is entirely misleading. Brown has no suggestion of *advertisement*.

As to the *merchantableness* of the two envelops, Brown and the Second Cohn, Mr. Bond ventures the following (R. 519):

“This same difference, as to merchantableness (i. e., in favor of the First Cohn Patent) is

also applicable to the envelop of the Cohn Second Patent, and in addition to the border, probably having the advertising matter or printed matter a permanent part of the envelop would in some cases make the envelop more merchantable than where such printed matter or advertising matter was on a separate card. This would be the case where the party using the envelop wanted to make prominent the business."

Thus the defense is forced to patentably 'distinguish between the Brown patent and the Cohn patents! As was said in Gormully-Jeffrey Mfg. Co. v. Stanley Cycle Mfg. Co., 90 Fed. 280:

"The English patent shows a clumsy device which apparently never went into successful operation. It seems to be conceded that the English structure can not be used as the Jeffrey structure is used without first making several important changes. The proof leaves no doubt on that subject. It is argued that these changes might have occurred to the skilled artisan. That they did not occur to any one until Jeffrey made the invention is evident. They seem simple enough now, but invention depended upon their being successfully wrought out. *In short, in these changes lies the difference between the commercial failure of the English patent and the widely recognized success of the patent at bar.*"

In the case of *General Electric Co. v. Wise*, 119 Fed. 926, it is said:

"However close the resemblance between some prior alleged invention, even when put into actual use, and the patented invention, if such

alleged prior invention was not operative, and failed to produce the beneficial results sought and produced by the patent, it could not constitute prior invention. In such case the patented invention can not be regarded as old."

Or as epitomized in *The Barbed Wire Patent* case, 143 U. S. 282: "It is the last step that wins"; and that is the step Courts will protect.

BROWN'S IDEA IMPRACTICAL IF NOT IMPOSSIBLE OF REALIZATION.

Turning to the testimony on behalf of complainant as to the differences between Brown and the Cohn inventions, we have a very clear statement and understanding of the same presented by Mr. Cohn (R. 205):

"I find that the only method described intelligently by Brown, is that of taking a piece of envelop, of the proper size and shape and cutting same out of the envelop covering the aperture thus made with transparent paper, or other equivalent transparent covering. This is the only method that is expressed intelligently enough to allow any one to make an envelop; all other description being either too vague in its character or impossible in its execution. To exemplify, Brown states: 'There may be only a transparent portion B large enough to exhibit the "direction" through it, and this may be made either by rendering a portion of the envelop or wrapper itself transparent by the same means or substances as employed for making tracing paper.' As explained before in my testi-

mony, if Brown undertook to do what he says *might* be done in his patent, he would render the *entire envelop transparent*. The only other method described by Brown aside from the two just mentioned, is, as follows:

“ ‘Instead of making only a small portion of the envelop or wrapper transparent the whole envelop, or at least the whole face of it may be made transparent.’ ”

“I can see no method whatever in this last statement of Brown as the specifications contain nothing in reference to this, aside from what I have just quoted, and it is impossible for me to imagine what method he had in his mind.

“As to the means employed by Brown in his patent, the only two means he expresses are that of making paper transparent, ‘by the same means or substances as employed for making tracing paper or any other in the process of manufacturing paper’; the other being the means of cutting out a portion of the envelop and covering same with transparent paper.

“The only *qualities* of paper to be used, expressed by Brown, are as follows: tracing paper, transparent paper, and an opaque wrapper. The transparent paper is to be used in covering a hole in the opaque paper.”

And R. 152:

“It is very evident that Mr. Brown had absolutely no knowledge of the paper business, nor had he tried to manufacture envelopes in accordance with his own specifications. *It is impossible to make paper transparent in spots by the same means as making tracing paper.* It is also

foreign to the art of *paper making* to make a sheet of paper which will be partly opaque and partly transparent. Any one familiar with the *manufacture of paper* knows that a sheet must be uniform from end to end, and cannot be produced with transparent space as Brown evidently thought could be done. The same is true of tracing paper: it being impossible to treat a sheet so that it would be transparent only in certain predetermined places. Mr. Brown further shows his ignorance of the paper business by stating, 'the cost of manufacturing the improved envelops will scarcely, if any, exceed that of ordinary envelops now in use.' For while the additional cost of rendering the envelops and wrappers transparent, will be but little, a cheaper quality of paper may be employed, not requiring to be finished so highly as for receiving the pen.' Had Mr. Brown been familiar with the paper business he would not have made a blunder of this kind, because instead of requiring a cheaper paper, it requires a paper costing four or five times as much as ordinary envelop paper in order to render it transparent by 'the same means or substances as employed for making tracing paper.' Summing up, I might state that it would be entirely impractical to make a suitable commercial envelop in the manner described in the Brown patent. This statement is substantiated by the fact that no commercial envelops were ever produced under the Brown patent."

BROWN, THEREFORE, DOES NOT EMBODY EITHER THE TRANSO OR THE COHN CONCEPT.

Mr. Cohn shows, in answer to Q. 76-77, that the samples of Brown proffered by the defense are bogus. In referring to these exhibits Mr. Cohn said:

“As stated by defendant’s counsel on page 374, of the defendant’s testimony, the envelop referred to ‘was made by the Transo Company on the same kind of paper used for their stock envelops and the same printing plates for applying the oil used in making it that is used for the stock envelop, but with the tinted matter omitted from the inner side of the paper, and the ring or border omitted around the window on the outside.’ This statement made by Mr. Banning probably explains, better than I can, the existing differences. *Mr. Brown’s patent is entirely silent as to the use of oil*, he makes no mention in his specifications of using printing plates and I am sure would never accomplish the result here produced in this Exhibit if he followed his own specifications.”

As said in *Kimball v. Waters Co.*, 117 Fed. 239:

“If the questions of identity of operation and results of a patented device and an alleged anticipating device were to be decided upon the contradictory testimony of experts, *preference should be given to the testimony of complainant’s experts who had been engaged in the business to which the patented device pertained as against defendant’s expert who had had no practical experience.*”

THEORETICAL MODIFICATIONS OF THE PRIOR ART ARE NOT PERMISSIBLE UNDER THE LAW TO MAKE OUT ANTICIPATION.

As your Honors said in the case of *Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280:

“It is not sufficient to constitute anticipation that the devices relied upon might by a process

of modification, reorganization, or combination with each other, be made to accomplish the function performed by the device of the patent sued on."

In speaking of this rule of law, the Court, in the case of *Western Electric Co. v. Howe Tel. Co.*, 85 Fed. 656, said:

"The force of this ruling and the similar ruling in *Clough v. Barker*, 106 U. S. 175, is made manifest in its practical application to the rights of parties, by the reflection that all earlier patents set up in defense against a later patent sued upon are but the record of evidence of the status the art has reached. The rights under such later patent are subject to what this record evidence actually shows. *To change this record by permitting theoretical modifications of these earlier patents, would be the same in principle, as to change, by interpolation or modification any other evidence between the parties.*"

"A patent cannot, as an anticipation of a later patent, have implied into it from necessity more than it fairly shows to make it represent an operative structure. What is required and not so shown is left for later inventors."

Wirt v. Farley, 84 Fed. 891.

At pages 15-16 of Appellant's Brief, appears the following:

"The Brown Patent says: 'By rendering a portion of the envelop' not the whole of it but a *portion*—'transparent by the same means or substances as employed for making tracing paper or any other' transparent. What 'means

or substances' are used for making tracing paper transparent? Oil or oily substances, as everybody knows. The tracing paper in children's picture tracing books used for forty years or more is, as its very appearance shows, rendered transparent by oils or oily preparations. The Century Dictionary, 1890, under the heading of Oils says: 'Oiled paper, paper saturated with oil either to render it transparent and thus *fit for tracing purposes*, or to make it waterproof.' Brown speaks to those skilled in the art of making paper and who knew that oily preparations were used in making 'tracing' paper, and so he tells them that a portion of the envelop, 'large enough to exhibit the "direction"' through it' was to be made transparent by using the appropriate 'means or substances'—any suitable oily preparation.'

This identical statement of Counsel was made in the Court below. We make now the same answer we did then:

One fallacy in defendant's line of reasoning lies in the fact that the Brown patent was issued in 1862 and the defendant's Counsel refers to a publication 30 years later to define something which was "fit for tracing purposes" but which later publication does not of itself even describe how "tracing paper" is or was made.

Neither the Brown patent shows, nor is there any publication contemporaneous with or prior to Brown before the Court to show, even how tracing paper *at the time of the Brown invention* was made. Even if

there was such contemporary information, it is manifest that the Brown patent could only be explained by extraneous evidence; and still with nothing whatsoever to communicate to those skilled in the art what was in the mind of Brown or what his *intention* was.

Brown's patent does not teach anyone how to make an envelop such as either the defendant or the complainant produces. As far as disclosing anything to the public is concerned Brown might just as well have said: "by the same means and substances as employed for making glass or celluloid," for producing the window leaving the remainder of the envelop opaque. As pointed out in the testimony, it is just as impossible to render a "portion" of an envelop transparent "by the same means or substances as are employed in making tracing paper" as it would be to render it transparent by the same means or substances as employed for making glass or celluloid.

"A PATENT IS GRANTED FOR SOLVING A PROBLEM, NOT FOR STATING ONE."—COLUMBIA MOTOR CAR CO. V. DUERER & CO., 184 FED. 893, C. C. A. (SELDEN AUTOMOBILE PATENT).

AS SAID BY YOUR HONORS IN ONE OF THE RAISIN SEEDER CASES, 182 FED. 59:

"IT IS ONE THING TO INVENT THE THEORY OF A MACHINE. IT IS QUITE ANOTHER THING TO INVENT A SUCCESSFULLY OPERATING MACHINE."

IF BROWN DESCRIBES A PRACTICAL METHOD SO CLEARLY, WHY HAS REGENSTEIN SPENT \$100,000.00 IN TRYING TO PERFECT HIS TRANSPARENCY?

Why didn't he follow the method which he says Brown so clearly taught. He certainly had the benefit of all Brown's teachings because he learned soon after the filing of the Reese abandoned application in January, 1904, of the existence of Brown. These are strange inconsistencies not satisfactorily explained by the Appellant.

In conclusion, we invite the Court's attention to Judge Van Fleet's careful analysis of Brown as a defense.

BUSCH BRITISH PATENT.

The drawings of the patent are shown on the opposite page.

The Busch patent may be considered in two aspects:

1st—as to what it actually is and shows, and

2nd—as to what the defendant's expert *thinks it shows*.

The Busch envelop is made from transparent paper and not from opaque paper and is substantially like the Cohn & Shipp British patent already referred to and Exhibit R.

(2nd Edition)

Fig:1.

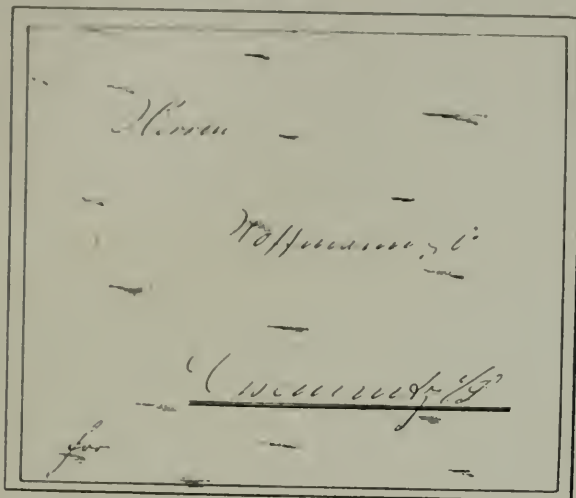


Fig:2.

Fig:3 A-B.



[This Drawing is a reproduction of the Original on a reduced scale.]

The *defense has imagined* that this transparent envelop of Busch showed a *border*. If the Court will but casually examine the drawings of Busch they will see that it does *not* show a border. *As far as the drawings teach, the Busch envelop is a plain, uncolored, unprinted common ordinary transparent envelop.* The fallacy of the defense appearing just as in the Court below, repeatedly in its brief, carries its own refutation.

Mr. Cohn, at R. 155, points out that *Mr. Bond mistook the outline of the enclosure shown in the drawings, Figs. 1 and 2 of Busch, for a border.* A careful inspection however of the drawings in question prove conclusively that there is no border shown. Both Figs. 1 and 2 show the enclosure as is natural in such instances, to rest toward the bottom of the envelop. Fig. 2 shows a broken section of the envelop with the enclosure still remaining in place. Had there been a border on the envelop face it would not have shown in the place that is torn away to show the enclosure.

In Busch *the entire face of the envelop is transparent.*

BUSCH A FAILURE.

“Q. 83. Referring to these envelops, defendant’s Exhibit, Busch, 1896, Nos. 1, 2 and 3, appearing opposite page 400, D. R., are those envelops, or either of them, commercial, practical envelops suitable for the uses to which your en-

velops and the Transo envelops have, or are put, that is, as a mailable commodity?"

Mr. Cohn:

"No. None of the envelops mentioned are practical or salable. In my previous testimony I have explained the undesirable features of an envelop made from transparent stock. All of these objectionable features are present in the Exhibits referred to. *Briefly summarized the objections are as follows: They are brittle and flimsy. They do not seal readily. They do not hold the stamp with sufficient strength. It would be impossible to post mark Busch specimens 2 or 3, owing to the dark background made necessary to kill the transparent nature of the paper. Busch specimen No. 1, when used in connection with a white enclosure, would have all the characteristics and appearance of a 'mourning' envelop. They would not serve as safe closures and would be torn and disfigured in the mail. They would find no sale on the market.*"

Concerning the manufacture of transparent paper and refuting the proposition put forward by the defense that *paraffine* or *oil* were used in making the Busch envelops, Mr. Cohn says (R. 158):

"The paper used in the manufacture of this envelop was never an opaque paper. It comes from the paper machines in transparent form just as it now appears, and has never been treated with *paraffine* or *oil* of any description, since it left the paper machine. The process of making this paper transparent has long been confined to some special mills in Germany, and it has only been but very recently, say within

the last two years, that two mills have started manufacturing this character of paper in the United States; the duty having been recently raised on this commodity to such an extent that it has been an inducement for some of the foreign paper makers to undertake the manufacture of this character of paper in the United States. The resultant transparency of this paper is occasioned by the various ingredients that are put in the beaters during the process of its manufacture. The firm of the Zellerbach Paper Company, with whom I am connected, is one of the largest, if not the largest importers of this character of paper in the United States. This paper is used very extensively by the dried fruit packers. Therefore, there is a large sale of this paper in California. There is nothing of an oily or greasy preparation used in the manufacture of this transparent paper. It is known to the trade as a *grease-proof* paper, and, as stated before, is principally used to pack around food stuffs of various kinds; delicatessen stores using it to wrap packages of slices of ham and bacon. It is also used for packing sandwiches, etc. The various ingredients that go to make up a finished paper are mixed with the pulp at the time of manufacturing same and the sheet is then drawn through calendars or rolls, which give it the highly glazed appearance that it has, but no chemical or oil of any kind is applied to the paper from the time it leaves the paper machine. To explain the calendars or rolls in paper making a little more fully, I would state that calendars are pressure rolls, some times run hot and at other times cold and the function of these calendars is to put a surface or glaze on the paper. I spoke of but two mills making this character of paper in the United

States. One of these has been in operation for about eight or nine years in Hartford City, Indiana, operating only in a small way. It has only been within the past two years that they have come into such prominence."

By comparing the foregoing with the "prophetical suggestions" in Busch we will see how far Busch was from foreshadowing the Cohn inventions.

As showing another uncommercial aspect of the Busch envelop, Mr. Cohn further testifies that this envelop could not be made by machinery, because this paper will not take gum or adhesive owing to its glaze (Q. 88).

Cohn says, referring to the Busch samples:

"There is no gum on the sealing flaps. This first became apparent to me when I consulted some envelop makers in reference to making an envelop of this character by machinery. I was informed that it was practically impossible to make envelops of this character by machinery; one reason being that on account of the character of the paper the plungers had a tendency to pick up more than one sheet at a time, but the main objection was that no suitable gum could be found that would work successfully in a machine for making envelops of this character, that is, for gluing the body and gumming the sealing flap."

The objections to and disadvantages of an envelop made from transparent paper have already been pointed out in connection with Mr. Cohn's efforts and experiments with Exhibit R.

As to the suggestion of "tracing paper" for making envelops, Cohn says:

"The only other form of transparent paper, aside from tissue paper, which would be entirely useless in the manufacture of envelops, is tracing paper. Tracing paper is also rather brittle, but the main objectionable feature in the use of tracing paper is the cost of the same. Tracing paper is one of the most expensive papers on the market. The cost of tracing paper would prohibit its use, in the manufacture of commercial envelops.

"To be more exact, the cost of the paper alone, if tracing paper were used, in making envelops, would be from \$5.00 to \$10.00 per thousand. This price does not include printing or manufacturing the envelops, and as good commercial envelops can be sold for less than \$1.00 a thousand, it is very evident that no successful envelops can be made from tracing paper. One of the reasons that tracing paper is so expensive it has to be made so that a draftsman in using it can apply ink on its surface by the use of a pen, or other drawing instruments. Therefore, *tracing paper cannot be made out of an oily preparation*. One other objectionable feature to tracing paper is that it lacks sufficient transparency to make an address very clearly legible through same. (See Exhibit S.)

The Commissioner of Patents, in upholding the First Cohn Patent disposed of the Cohn & Shipp and Busch patents in the following words:

"The British patents are not regarded as anticipations, as they require, so far as can be understood, that the envelop blank be made from a

transparent sheet of paper, while appellant's start with an opaque sheet of paper."

This excerpt alone is sufficient to show the fundamental difference between the structures of the Cohn patents in suit, and that of the British references.

Independent of the fact that the complainant's British patent is *not identical* with the patents in suit and *are not for the same invention*, the Cohn & Shipp Patent can in no wise be considered as a part of the prior art, *because Cohn had already conceived and developed the inventions of the patents in suit before filing his British application.*

"But in order that the foreign patent may invalidate the patent in suit, it is not sufficient that it ante-dates that patent. If in withstanding such ante-dating, the patentee invented his device prior to the date of the foreign patent, then his patent is not invalidated thereby."

Columbus v. Standard, 148 Fed. 662, C. C. A.

Seymour v. Osborne, 11 Wall. 555.

The Busch Patent is also carefully considered in the opinion of the lower Court and the conclusions therein stated are manifestly correct.

Thus the so-called "best references" of the defendant for the First Cohn Patent are fully answered and disposed of.

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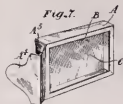
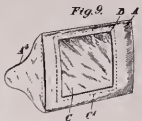
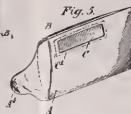
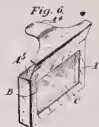
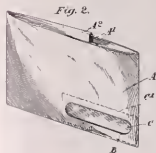
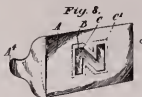
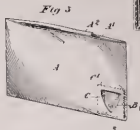
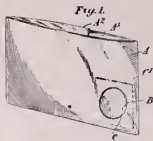
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Thus the so-called "best references" of the defendant for the First Cohn Patent are fully answered and disposed of.

(2nd Edn. 1907)



BOLDT BRITISH PATENT OF 1897.

The drawings of this patent appear on the opposite page. Specimen envelopes of Boldt according to Figs. 8 and 9 of the Boldt patent are in evidence as Complainant's Exhibits "DD" and "EE."

This is the so-called "best reference" of the Second Cohn Patent.

In answer to X. Q. 77, Mr. Bond in summing up the difference between Boldt and Cohn as they appear to him from the standpoint of the defendant says (R. 533):

"The primary object or purpose of this Boldt British patent is the making of a packet, wrapper, or envelop, or whatever it may be termed, in such manner as to enable the nature of the contents to be observed, and at the same time have the transparent material employed for inclosing or covering the observation opening represent the initials of the firm, or be otherwise utilized for advertising purposes.

"A difference between the wrapper or envelop of the Boldt British patent and the wrapper or envelop of the two Cohn patents is the difference between a wrapper or envelop in which the transparent window is made by the use of an independent piece of transparent material, as in Boldt, and the window made integral with the paper of the envelop, or, so to speak, the difference between a two-piece transparent window envelop, as designed by Boldt, and a one-piece transparent window envelop, as designed by Cohn.

“Another difference is the lack, in the wrapper or envelop of the Boldt patent, of an opaque border surrounding the transparent window, as set forth in the two Cohn patents.

“Another difference is the lack of any permanent printed or advertising matter on the wrapper or envelop of the Boldt patent, outside of or anywhere on the face of the wrapper or envelop, which permanent printed or advertising matter is a requisite of the Cohn Second Patent.

“Another difference is the lack, in the wrapper or envelop of the Boldt British patent, of an outline characteristic of a symbol of trade, in co-relation with permanent printed or advertising matter, by which a particular brand of goods is indicated.

“Other minor differences can also be found, but the above differences are the most prominent and pronounced ones.

“Minor differences appear in the form and shape of the wrappers or envelops; between the location of the transparent sections or windows; and between the general design for which the transparent windows are employed—Boldt using the transparent window to observe the contents, and Cohn using the transparent window to observe the address of the inclosed letter.

“As a merchantable device for the purpose intended, the Boldt wrapper or envelop is as merchantable as the device of the two Cohn patents, for the purpose intended in either patent, but as a mailable commodity possibly the device of the two Cohn patents would have more value than the device of the Boldt patent, though it would be possible to utilize the wrapper or envelop of the Boldt patent for mailing purposes if so desired, subject, however, to any defect that might

pertain to the use of a transparent window of elastic material as compared with the use of a transparent window integral with the body of the envelop."

Manifestly two things cannot be the equivalent which fundamentally differ not only in essentials of construction but do not produce the same result.

In regard to Boldt it may be said as was in *American Graphophone Co. v. Leeds & Catlin Co.*, 170 Fed. 327 (C. C. A.):

"Is not the fact that the patent was never heard of until it was resurrected for the purpose of this litigation, persuasive evidence that it contained nothing of value to the art? * * *

"In short, we are unable to see that Adams-Randall's contribution to the art advanced it a single step. His patents abound in tentative, indeterminate and infeasible suggestions too nebulous to anticipate a patent which has actually shown the art how to make the thing needed. In contemplation of law an invention does not exist until the inventor's ideas have been reduced to practical form. As was said in *Standard Cartridge Co. v. Peters Co.*, 77 Fed. 630, 645, 23 C. C. A. 367, 381: 'The mere existence of an intellectual notion that a certain thing could be done, and, if done, might be a practical utility, does not furnish a basis for a patent, or estop others from developing practically the same idea.' The burden of proving anticipation by clear and convincing evidence rests heavily upon the defendants."

It is rather strange that the defense should put forward the Boldt two-piece envelop as an anticipa-

tion of Cohn, when it admits that the Callahan two-piece envelop does not anticipate a one-piece envelop, omitting the border.

Of course they are estopped by Mr. Banning's letter of December 16, 1903, to claim anticipation by Callahan. Manifestly, the Boldt concept of an advertising envelop is no closer to the Cohn concept of an advertising envelop than was the Callahan envelop to the original Reese-Regenstein concept.

BOLDT NOT PRACTICAL; NEITHER DOES IT EMBODY THE

COHN CONCEPT.

Mr. Cohn says in regard to Boldt (R. 164):

“The main objection in trying to use a wrapper of this kind for a commercial envelop would be the cost of making same. Boldt in his patent explaining that a covering such as mica, gelatine or celluloid could be used as a covering over an opening in an envelop or wrapper. Any one of the substances named are too high in price to be put to practical use in a commercial envelop, and this particular feature has been brought to a much more practical state by A. F. Callahan in his patented two-piece envelop, known as the ‘Outlook Envelop’ Callahan 1902 patent, now in evidence.”

As to the defendant's claim to Boldt delineating a *trade-mark or name*, or other symbol, or any design or symbol *for the purpose of advertising*, Mr. Cohn says:

“I can point out no such feature as the drawings in question do not disclose any. The only drawing shown outside of an ordinary opening intended for the display of merchandise, is Figure 8, which shows a letter N. *This drawing, however, is absolutely meaningless, and does not convey to the mind an advertising feature of any sort, as there is no printed matter in conjunction with same, and the letter used might stand for needles, noodles, necklaces, or any articles which would begin or end with the letter N. It is plain to be seen that an envelop with this shaped opening could not be practically used for an addressing space, owing to the peculiar construction of said opening. I notice in Boldt’s specification that he says, ‘the same purpose may be effected by painting or embossing or otherwise delineating a trade-mark or a name, or other symbol, or device upon the transparent covering as indicated in Figure 9.’ Inspection however of Figure 9 does not disclose any such matter described by Boldt, and if it did it would entirely defeat the object of my second patent and the Heinz envelop referred to, in making the address on an enclosure unreadable. * * **

“It would defeat one of the objects of my second patent, which object is to have a transparent addressing space, unobstructed by any printing, painting or embossing upon said transparent addressing space, as probably indicated by Boldt in his specifications but not shown in any manner in the drawing Boldt referred to. Boldt’s entire object, as disclosed by his specifications was the displaying of various articles of merchandise, and it is very evident from his specifications and description that he had absolutely no other object in mind. While a wrapper such as described by Boldt might be practical to cover

articles of merchandise that retail as low as 5c or 10c a piece, it would never be practical for a commercial envelop, because as explained before, the cost of manufacturing would be entirely too great, nor could a package or wrapper, as described by Boldt, be commercially produced in an envelop machine."

Mr. Regenstein says as to printing anything on the transparency itself (R. 299):

"The trade-mark of the Heinz Company represents a pickle; which shows the word 'Heinz' on the pickle. The only way Heinz would accept the envelop was to show the word 'Heinz' the same as appears on the trade-mark. *It is impractical to print the word Heinz on the transparency, as it would interfere with the clearness of the window, and the only way to bring it out is to print it on the inside of the bottom flap.*

THIS TESTIMONY IS CONVINCING PROOF TO SHOW:

1ST, THAT BOLDT DOES NOT ANTICIPATE COHN;

2ND, THAT COHN'S STRUCTURE INVOLVES INVENTION;

3RD, THAT THE HEINZ ENVELOP IS THE MECHANICAL EQUIVALENT IN ALL ITS DETAILS OF THE COHN ENVELOP, AND IS AN INFRINGEMENT OF THE SECOND COHN PATENT.

THE RULE REGARDING ANTICIPATION BY A FOREIGN PUBLICATION OR FOREIGN PATENTS IS STRICTER THAN IN THE CASE OF ALLEGED ANTICIPATING AMERICAN PATENTS AND IS MORE FAVORABLE TO A PATENTEE.

As was said in *Hanifen v. Godlshalk Co.*, 84 Fed. 649:

“It is a well settled and familiar doctrine that an invention *patented here* is not to be defeated by a *prior foreign patent* unless its descriptions or drawings contain or exhibit a substantial representation of the patented invention in such *full, clear and exact terms* as to enable any person skilled in the art or science to which it appertains, *without the necessity of making experiments* to practice the invention.”

In *Consolidated Car Heating Co.*, 85 Fed., at page 665:

“Great stress is laid upon the English patent to Rose as embodying anticipatory features, but the Rose device did not do the thing that this device does. It did not undertake to do it, and, so far as appears, no one ever thought of its being applied to such a situation, and doing the work in the manner in which the device in question does it. Quite likely the Rose patent had some of the ideas involved in the patent in question, as, for instance, the idea of radiating heat by means of coils of wire, but it did not describe, or even suggest the distribution of heat, either in detail or in substance, in the manner and by the means employed in the complainant's device. As was said by the Circuit Court, *under the rules applying to foreign patents* it cannot be viewed as anticipating the McElroy invention.”

The Circuit Court of Appeals of the Second Circuit, in *Westinghouse Co. v. Great Northern Ry. Co.*, 88 Fed. 263, said:

“The *prophetical suggestions* in English patents of what can be done, when no one has ever tested by actual and hard experience and under the stress of competition the truth of these suggestions, or the practical difficulties in the way of their accomplishment, or even whether the suggestions are feasible, do not carry conviction of the truth of these frequent and vague statements, and are insufficient to render a patent void for want of invention.”

That the Brown and British publications were known for many years without leading to the use of the Cohn or Transo envelops, where such an envelop was so much wanted that the public took it at once the instant Cohn and the Transo Paper Co. offered them, is a proof from experience that the publications were not sufficient under the rule of law.

Judge Van Fleet's opinion contains also a careful and correct estimate of the Boldt British patent.

INVENTION

INVENTION.

Concerning invention and validity and the presumptions favorable thereto attaching to every patent your Honors recently said, in *S. F. Cornice Co. v. Beyerle*, 195 Fed. 516:

“The grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device, or the discoverer of the art or process, described in the letters patent and of its novelty. *Smith v. Goodyear Denial Vulcanite Co.*, 93 U. S. 486, 489, 23 L. Ed. 952; *Lehnbeuter v. Holthaus*, 105 U. S. 94, 96, 26 L. Ed. 939. Not only is the burden of proof to make this defense upon the party setting it up, but it has been held that every reasonable doubt should be resolved against him. *Cantrell v. Wallick*, 117 U. S. 689, 695, 6 Sup. Ct. 970, 29 L. Ed. 1017.”

The claims in issue are what are known in law as “combination” claims: i. e., made up of a number of correlated elements.

It is an elementary rule that in combination claims the invention, if any, lies in the *combination*, and not in the novelty of any individual element.

Imhaeuser v. Buerk, 101 U. S. 660;

Griswold v. Harker, 62 Fed. 389.

The United States Supreme Court on this point said in *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 53 L. Ed. 805:

“A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or noncomposite instrument. Whoever uses it without permission is an infringer of it.”

No one of all the patents relied on by the defense discloses a *combination* containing elements the same or equivalent to the combinations of the patents in suit or either of them, co-operating upon the same principle, performing the same function in substantially the same manner and producing substantially the same results. In judging of “results,” “principles,” “mode of operation,” etc., we are to consider the *combination* as a *whole* and not the individual elements. The combination is for an *envelop*. That envelop constitutes the claimed combination; and the end sought is a novel *merchantable one-piece transparent window envelop*. Nowhere in the prior art do we find such a combination. We do not find any one who has produced such a combination, much less have we any evidence of any such thing ever having been on the market prior to Mr. Cohn. We have Mr. Regenstein’s word that the Transo envelop, as manufactured by the Transo Paper Co., today occupies the field alone and that he believed himself to be the first manufacturer in the United States; and that he has what is “*now considered the most perfect transparent envelop in existence and has a sale in this country as well as in foreign countries.*”

IT IS SHOWN BY THE EVIDENCE THAT THE TRANSO ENVELOPS EMBODYING COHN'S INVENTIONS HAVE GONE INTO MOST EXTENSIVE USE.

This is sufficient evidence of invention to be decisive in a doubtful case.

“When although the patent was not a pioneer and the prior art discloses various apparatuses which employ from one to three of the elements of the combination claimed, though not in one combination, and where the elements as formerly known were modified so materially as that they would co-operate together as a whole in one combination to produce a new character of device in its class, held to be invention.”

Lamson Consol. Store Service Co. v. Hillman,
123 F. 416, 59 C. C. A. 510.

As said by your Honors in *Morton v. Llewellyn et al.*, 164 Fed. 693:

“Apart from the presumption of novelty that always attends the grant of a patent, the law is that when it is shown that a patented device has gone into general use and has superseded prior devices having the same purpose, it is sufficient evidence of invention in a doubtful case. The Barbed Wire Patent, 143 U. S. 275, 292, 12 Sup. Ct. 443, 36 L. Ed. 154; *Keystone Manufacturing Company v. Adams*, 151 U. S. 139, 143, 14 Sup. Ct. 295, 38 L. Ed. 103; *Irvine v. Hasselman*, 97 Fed. 964, 38 C. C. A. 587; *Wilkins Shoe Button Co. v. Webb* (C. C.), 89 Fed. 982; *National Hollow B. B. Co. v. Interchangeable B. B. Co.*, 106 Fed. 693, 707, 45 C. C. A. 544.”

See also

Kitchen v. Levison, 188 Fed. 658.

CONDUCT OF DEFENDANT IN ADOPTING THE PATENTED
DEVICE IS PROOF OF INVENTION.

The presumption of novelty arising from the grant of the patent and the fact *that the defendants think so well of the device that they use it themselves*, has frequently been assigned by the Courts as the principal reasons for holding an invention patentable.

“The fact that a patentee, by his device, produced results which intelligent and ingenious inventors in the same art had sought for years without avail, and that such device went into immediate and extensive public use, *and was furthermore used by the defendant*, tends strongly to show that it was the result of inventive faculties.” *Dowagiac Mfg. Co. v. Superior Drill Co.*; *P. P. Mast & Co., v. Same*, 115 F. 88, 53 C. C. A. 36 (6th Cir.).

“Where, upon suit for infringement, alleged anticipating constructions are set up by the defendant, the fact that he *appropriated the complainant’s production as to the foundation of his own business and had been very successful*, is *persuasive evidence* of the advantages of the complainant’s structure over the alleged anticipatory constructions.”

A. R. Milner Seating Co. v. Yesbera, 133 F. 916 (6th Cir.).

All these topics of “extent of use,” “appropriation of the patented structure by defendant,” and

“combination patents” are excellently illustrated and applied in the recent decision of the Supreme Court in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 55 L. Ed. 527:

“The utility of the Grant patent, therefore, was not attained in the Willoughby patent. *The rubber company’s conduct is confirmation of this.* It uses the Grant tire, as we shall presently see, not the Willoughby tires. Let it be granted that they afforded suggestions to Grant, and that he has gone one step beyond them. It is conceded, as we have said, that this invention is a narrow one,—a step beyond the prior art,—built upon it, it may be, and only an improvement upon it. Its legal evasion may be the easier (*Chicago & N. W. R. Co. v. Sayles*, 97 U. S. 554, 556, 24 L. Ed. 1053, 1054), and hence we see the strength of the concession to its advance beyond the prior art and of its novelty and utility by the rubber company’s imitation of it.

“*The prior art was open to the rubber company.* That ‘art was crowded,’ it says, ‘with numerous prototypes and predecessors’ of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. *And yet the rubber company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation, as others have done.* And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business interests urged to it as much as to infringement. *We can find no answer except that given by the tire company: ‘The patented organization must be one that is essential. Its use in the precise form*

described and shown in the patent must be inevitably necessary.'

"That the tire is an invention is fortified by all of the presumptions,—the presumption of the patent by that arising from the utility of the tire. And we have said that the *utility of a device may be attested by the litigation over it, as litigation 'shows and measures the existence of the public demand for its use.'* *Eames v. Andrews*, 122 U. S. 40, 55, 30 L. Ed. 1064, 1069, 7 Sup. Ct. Rep. 1073. We have shown the litigation to which the Grant tire has been subjected. * * *

"* * * *the extensive use which it attained, and more certainly the exclusive use which it attained, could only have been the result of its essential excellence, indeed, its pronounced superiority over all other forms.* Here, again, in our discussion, a comparison is suggested between it and other tires, and *the inquiry occurs why capital has selected it to invest in and advertise, and not one of the tires of the prior art, if it be not better than they?* But the effect of advertising is mere speculation; to the utility and use of an article the law assigns a definite presumption of its character, as we have seen, and which we are impelled by the facts of this record to follow.

"To what quality the utility of the tire may be due will bear further consideration, if for no other reason than the earnest contentions of counsel. Aside from those contentions and the ability by which they are supported, *we might point to what it does as a demonstration of its difference from all that preceded it, that there is something in it, attribute or force, which did not exist before,—something which is the law.*

of its organization and function, and raises it above a mere aggregation of elements to a patentable combination. And we may say, in passing, the elements of a combination may be all old. In making a combination the inventor has the whole field of mechanics to draw from. *Leeds & C. Co. v. Victor Talking Co.*, 213 U. S. at page 318, 53 L. Ed. 812, 29 Sup. Ct. Rep. 495."

PATENTABILITY OF THE COHN INVENTION AS SHOWN BY THE DIRECT TESTIMONY OF REGENSTEIN.

First—There is the letter of Messrs. Banning & Banning of Dec. 16, 1903, expressing their opinion that an envelop with opaque stock made transparent with grease and *omitting* a border was clearly patentable over the Callahan patent of 1902 for the two-part "Outlook" envelop. This eliminates Boldt as well as Callahan.

Second—An application was filed by Reese and Regenstein for an envelop embodying this idea.

Third—That a "border" was necessary was *not* obvious from the mere knowledge of the fact that oil would render paper transparent. Like Cohn, Regenstein thought first to get a transparent envelop by the use of a suitable oily preparation alone, but as Regenstein says: "After the blanks were made transparent, it showed that *no matter what oils* we used, the oil would bleed or be out of register."

Regenstein thus made *what was to him a new discovery*.

That to overcome this defect of bleed, he even as an "old printer" *experimented* with various sizes and colors of blocks; different sizes of rings; different inks and different transparency forming preparations. This "experimenting" shows that the problem was not a simple or obvious one. If "old skilled printers" like Regenstein and his associates had to consume days "experimenting" to determine that a border was necessary and to find what pigment or ink was best to use, and that it took over a year to find that the border and oil must be applied on *opposite sides of the sheet*, the problem manifestly did involve thought and study; and that is really what *invention* involves, and what *mechanical skill* does not involve.

"A patent is granted for solving a problem, not for stating one."

Colombia Co. v. Duerer, 184 Fed. 893.

Regenstein himself has shown by the *nature of the problems involved*, that it required an exercise of the inventive faculties to successfully evolve the patented combination. He has also shown that the problems were such that he *could not lay claim to possession of the invention until long after Mr. Cohn had filed his applications*.

Fourth—Aside from these "problems" which Regenstein admits he had a hard time in solving and

is thereby corroborated by Mr. Cohn, we have Regenstein's voluntary statements made with pardonable pride:

"THE RING ON A TRANSO ENVELOP ADDS IN EVERY WAY TO THE PERFECT AND CLEAN APPEARANCE OF THE ENVELOP." (REGENSTEIN, R. 320.)

"I AM THE ONLY MANUFACTURER (OF TRANSPARENT ENVELOPS LIKE THE ONES IN CONTROVERSY IN THIS CASE) AND HAVE NEVER SEEN ANY ONE-PIECE TRANSPARENT ENVELOPS MADE BY ANY ONE ELSE IN THIS COUNTRY." (REGENSTEIN, R. 279.)

"OUR ENVELOP IS NOW CONSIDERED THE MOST PERFECT TRANSPARENT ENVELOP IN EXISTENCE AND HAS A SALE IN THIS AS WELL AS FOREIGN COUNTRIES." (REGENSTEIN, R. 279.)

"I HAVE NEVER PUT OUT ANY ENVELOPS WITHOUT A RING." (R. 321.)

To quote from Mr. Regenstein's testimony:

"X. Q. 265. Do you put out any envelopes without the ring or border?

"A. We do not.

"X. Q. 287. Have you ever put out any Transo envelopes commercially without a ring or border?

"A. I have not.

"X. Q. 288. Have you ceased manufacturing Transo envelopes with a transparent window or ring or border, since the beginning of this suit?

"A. I have not.

“X. Q. 289. You are still actively seeking new business for these envelops?”

“A. I am.”

Earlier Regenstein had testified on direct examination:

“Q. 81. Without going into details as to the preparation of the oil or whatever it is that you use, you may state what difficulties you found in that matter, if any.

“A. The difficulties in preparing the windows properly were found on account of atmospheric conditions, nonelastic oils, and various other causes.

“Q. 82. You may state what the fact may be as to losses of envelops through the sticking of the sides together, where the transparent windows were formed, or matters of that kind?”

“A. We have found and experienced in 1906 that the transparent window would stick to the back of the envelop, and have spoiled at least forty to fifty million envelops in that manner.

“Q. 83. You may state whether your company has much money invested in the business of manufacturing the transparent window envelops, or has spent much money for that purpose, from first to last?”

“A. The loss to our company in perfecting envelops is over \$100,000.00.

“Q. 84. How far do you consider that your company has brought the manufacture of these transparent envelops to a condition where they are practical and satisfactory to the public?”

“A. Our envelop is now considered the most perfect transparent envelop in existence, and has a sale in this country as well as in foreign countries.

“Q. 85. To whom, in your opinion and from your knowledge of the facts, is due the credit of bringing the manufacture of transparent window envelops, like those in controversy, to a condition where they are practical, useful, and satisfactory to the public?

“A. The credit is due to Mr. Ernest Sauerman and myself.

“Q. 86. Mr. Sauerman is one of your co-laborers or associates, is he?

“A. Yes.

“Q. 87. Did you ever know of any envelops like those in question being on the market, that were manufactured by complainant in this case?

“A. I do not.

“Q. 88. Do you know of any other concern in the country, outside of your company, that is manufacturing the transparent window envelops, like the ones in controversy in this case?

“A. To my knowledge, I am the only manufacturer, and have never seen any one-piece transparent envelops made by any one else in this country.”

This sounds like the testimony of a patentee.

Fifth—In regard to the advertising envelops of Heinz and Stickney, Regenstein testifies, R. 301: “They are very much admired.” Although in 1905

Regenstein, "told Mr. Cohn that his idea (in regard to an advertising envelop) was *absolutely impossible and impractical*" (in answer to X. Q. 176). This statement of Regenstein's in 1905 followed later by the disproof of its truthfulness by Regenstein himself is *pertinent to show invention* and the absence of obviousness.

Sixth—Regenstein says in effect, (X. Q. 253 and following): that he "never saw paper made transparent by the use of an oily preparation for any *practical or commercial purpose* until Mr. Reese made his first tests in December, 1903, with the ringless specimen."

That bespeaks novelty as it is the opinion of an expert.

Seventh—Mr. Regenstein, who has had many years' experience in the printing business, in an unguarded moment frankly admits in answer to X. Q. 253:

"I do not think that the making of paper transparent has anything to do with the printing art."

Considering Regenstein's manifest bias and his vital interest in defeating the patents, the foregoing admissions mean in effect, that *the manufacture of these envelops* with their transparent portion formed by the use of an oily preparation, *has nothing to do with the printing art*, and thereby sweeps from the

consideration of the Court the mass of immaterial matter introduced by the defendant relating to pictures with gold frames, three-color work, etc.

Eighth—Further evidence of invention is that it required *special machinery*, as Mr. Regenstein found out when he came to go into the business of putting these envelops commercially on the market. Regenstein testifies (R. 573):

“Q. 9. Was there any necessity of preparing or equipping special machinery or presses to enable you to print twenty-four windows at a single operation?”

“A. We were obliged to buy presses for this purpose which in a sense were not special, but a *great many changes were made to adjust* such presses for our purposes.”

This corroborates Mr. Tooker, who testified that in his experimental work for Mr. Cohn he had to rearrange his presses to apply the oil.

THE WITNESSES OF REGENSTEIN RECOGNIZED HIS SO-CALLED “1904 EXPERIMENTS” AS “SOMETHING ENTIRELY NEW”—BEHRENS (R. 423); THAT “THERE WAS MUCH COMMENT AROUND THE SHOP,” AND THAT REGENSTEIN SAID “IF HE COULD MAKE AN ENVELOP WHICH WOULD BE CHEAPER THAN THE ONION SKIN PATENT, IT WOULD BE A GREAT THING,” MAX LAU (R. 394-5); (THE “ONION SKIN PATENT” REFERRED TO THE CALLAHAN “OUTLOOK” TWO-PIECE ENVELOP); THE WITNESS VOSS (R. 409) WAS ATTRACTED BY THE FACT THAT THE RING PRINT-

ING PLATES WERE "PECULIAR" AND "AN ENTIRELY DIFFERENT MAKE-UP TO THE PLATES BEING USED FOR OUR REGULAR PRODUCTS"; OLSON THE LITHOGRAPHER WHO IS ALLEGED TO HAVE MADE THE FIRST BORDER RINGS FOR REGENSTEIN (R. 383): "THAT WAS THE FIRST TIME I HAD MADE ANY PLATES TO COVER ANYTHING EXACTLY LIKE THIS ENVELOP REFERRED TO." WIEN (R. 364), THAT HE HAD NEVER BEFORE SEEN A BORDER PRINTED AROUND ENVELOPS.

And Mr. Cohn says (R. 150) in corroboration of Regenstein's statement, "The ring on a Transo envelop adds in every way to the perfect and clean appearance of the envelop," that:

"I consider the ring of utmost importance, for the reason that it was this feature that made the one-piece, unpunctured, window envelop a commercial success; no one-piece envelop having been used commercially before I put out my envelops with a ring or border in November, 1904. Ever since that date the envelop seems to be gaining in popularity and * * *.

"I wish to state that although Mr. Regenstein has solved the problem of making a proper border he has not solved the problem of making a window envelop without the border, as stated in his letter of December 10th, 1906, and although over four years have passed since I received this letter Mr. Regenstein still adheres to the border. Unquestionably, *Mr. Regenstein has discovered the same as I have, that printing the border entails considerable expense, and if it were possible to produce a salable, commer-*

cial window envelop without this border, Mr. Regenstein would do so. The operation of applying this border requires the utmost care and skill, as the ink used must be just of the proper consistency and applied with utmost care. It is therefore, self-evident that no one would resort to the border if they could accomplish the same result without it, especially as envelops are sold on an extremely close margin of profit and any saving of expense would be gladly embraced by a manufacturer."

As to Regenstein it may be said, as in *Loom Co. v. Higgins*, 105 U. S. 580:

"If the infringer claims to have known of the combination and to have perfected it, why did he not put into general use, and *why did he not apply for a patent upon it?* He was already a patentee of a difficult and inferior apparatus. He knew all about the method of going about to get a patent. He belonged to a profession which is generally alive to the advantages of a patent right. On the hypothesis of his being the real inventor his conduct is inexplicable."

His excuse for not applying for a patent that he was afraid of being "laughed at" is not convincing.

THE FILE WRAPPERS.

The history of these applications in their course through the Patent Office is interesting and shows with what persistence Mr. Cohn held out for his rights and insisted on the protection being given him which he proved he was rightly entitled to. The

evidence in the case taken after several years of actual practical test of the inventions on the market, show how correct the higher tribunals were, to which Mr. Cohn was obliged to appeal, and which ultimately decided in favor of the patentable novelty of the inventions. Mr. Cohn in order to establish the justness and patentability of his claim in the first or original application was obliged to appeal first from the Primary Examiner to the Examiners in Chief, who manifestly misconceived the references; then by later appeal to the Commissioner the claim of the First Cohn Patent was sustained. The Commissioner said concerning the claim in suit:

“While the final result is to enhance the appearance by concealing the irregular outline, *the result is brought about by mechanical features*, namely, the application of the printed border to a portion of the paper to which the oily preparation has been applied. The British patents are not regarded as anticipations as they require, so far as can be understood, that the envelop blank be made from a transparent sheet of paper, while appellant starts with an opaque sheet of paper.”

Mr. E. B. Moore, the Acting Commissioner of Patents who rendered the decision is the present Commissioner.

The testimony shows how much more there is to the First Cohn Patent that was appreciated by or apparent to either the Commissioner or even Mr. Cohn's attorneys at that time.

Mr. Cohn was also obliged to fight his way with his second or divisional application, but the novelty of the invention seemed to have forcibly impressed itself on the Examiners in Chief who held the invention patentable on appeal. In their decision which appears as an exhibit in the case they said:

“The references are:

“*British Cohn & Shipp, No. 14,478, June 27, 1904;*

“*Busch, No. 11,876, June 1, 1896.*

“Of these two patents British No. 14,478 is the more pertinent. That patent describes an envelop having a window through which the addressee's name on an enclosure may show, said window being ‘oval, rectangular, diamond-shaped, or fancifully bordered’ in outline and having a tinted or colored border surrounding and giving distinction to said window, or, as the specification of the patent puts it (p. 2, lines 10, 11), ‘the finished envelop gives the effect of a transparent, light colored area on an opaque, darker colored background.’ The patent also suggests having transparent letters as in figure 5 and lettering ‘Boots and Shoes,’ thus referring to the business of the sender.

“The applicant in the case before us has carried the idea of this patent a little further by making the fanciful shaped opening in the shape of a pickle, cigar or other symbol of trade and instead of merely referring to the business has used some other advertising matter associated with the article whose form has been given to the window or opening. This idea appears to us to be inventive in character and the claims may accordingly be allowed.”

The fact that this Second Patent was granted without further appeal accounts for its issuance first.

Thus by reference to the file wrappers it is seen that the Brown, Busch and Cohn & Shipp patents were among the references cited by the examiner against the First Cohn Patent, application No. 231,886, filed November 8, 1904. The Commissioner, after fully considering all the references cited, including the *Brown*, the *Busch British Patent* and the *Cohn & Shipp British Patent*, decided that the invention of the First Cohn Patent was patentable over Brown, Busch, Cohn and Shipp, and everything else in the prior art. The file wrappers show that this whole subject was carefully considered by the Patent Office, and that these prior patents neither anticipated or limited the claim of the patent here in suit.

It has uniformly been held by the courts that the presumption of validity which attaches to every patent, is *strengthened* by the consideration given the case in the Patent Office before the patent is granted.

“It is evident that the patent in suit, as finally granted, had a long, hard row to travel, as is disclosed by the proceedings in the Patent Office and the length of time that elapsed between the filing of the application and the granting of the patent. The patent is presumed to be valid, and to my mind this *presumption is strengthened by the consideration given the case in the Patent Office before the patent was granted.*

United Shirt & Collar Co. v. Beatie, 138 Fed., 136-137. (Affirmed C. C. A., 149 Fed. 736).

The learned Counsel for Appellant, in his efforts to discredit the Cohn Patents, and to show that they were improperly issued, was led into an unfortunate inconsistency in his brief in the lower Court, in first giving praise to the Honorable Commissioner of Patents, Mr. E. B. Moore, "as a trained expert of over 26 years practical experience in the Patent Office," and as having "risen from the position of a third or fourth Assistant Examiner to the position of Commissioner. * * * His statement is of great weight and should be given consideration in determining the validity of the Cohn Patents," (p. 60, Defendant's Brief below), and then academically stating that the Commissioner was a political appointee lacking "competent legal knowledge and scientific ability."

Appellant's Counsel has in his present brief avoided his former inconsistency by omitting the *facts* concerning the qualifications of Mr. Commissioner Moore and leaving in the more subtle but unsound inuendo of "inexperience," "incompetency" and "politics."

It is most ungenerous of Appellant's Counsel to say at page 81 of his brief that the attorneys for Cohn "evidently succeeded in this case in persuading the Commissioner to pass the question on to the Courts to determine should litigation ever arise under the patent;" or to say at page 156 of his Brief that the Commissioner was "teased" into granting the Cohn Patent and that he was "ignorant" of the

art relating to the subject matter of the Cohn invention.

All we have to say is that defendant's "hypothesis" is again unsupported by the evidence, and the Commissioner, skilled lawyer, judge, technical and scientific man, as he is (conceded in appellant's own previous admission) unqualifiedly stated that the device of the First Cohn Patent involved invention over anything and everything in the prior art.

It is not necessary to consider here whether or not the Cohn claims are or were narrowed in construction by the references cited; first, because the patentee stuck up for his rights and got the claim that he originally asked for, without amendment. In other words, the claims of the patent were allowed as drawn, *after careful consideration by the Patent Office*. It is, therefore, entitled to a liberal construction, independent of the fact that the respondent's structure, as shown by Exhibit C, and which respondent admits having used, exactly fits the invention described in the patent. For, as was said in *Armstrong v. Betting Bros. & Co.*, 172 Fed. 234, 236:

"They (defendant's specifications) appear to fit the invention described by Schroeder with exactness, and I can see no reason for searching into a controversy between Armstrong and the patent examiner to learn what meaning should be attached to the claims when fitted upon the Schroeder disclosures. No such right inheres to an invader of the Schroeder as it was finally ticketed, labeled and issued from the Patent

Office. The claims which appear in the Schroeder patent are, as I have said, perfect fits for the Schroeder disclosure, and that ought to be the claims and what they mean."

As to the suggestion on page 82 of Appellant's Brief, that the Patent Office Officials were not "furnished with exhibits or illustrations of" three-color pictures and lithograph labels "showing the use of borders," it is only to be said that the Patent Office experts were just as much charged with the knowledge of these methods and processes, and were required to take judicial notice of the same, as was the complainant. In the desperate efforts of the primary Examiner to deny these applications it is not to be presumed that he overlooked anything that the printing art would afford.

It is to be presumed that the law was complied with by both the applicant and the Patent Office Officials and the proceedings can only be impeached for fraud.

Seymour v. Osborne, 11 Wall 516, 542.

As said in *Victor Talking Machine Co. v. Leeds & Catlin*, 165 Fed. 931:

"It would seem that if an inventor applies for a patent in the United States and it is granted it is presumed that the Patent Office has inquired into all the facts prerequisite to the granting of the same, and has found that the applicant is entitled thereto."

THE SIMPLICITY OF THE INVENTION IS NO GROUNDS
FOR DENYING ITS PATENTABILITY.

Kitchen v. Levison, 188 Fed. 658 (C. C. A.,
9th Cir.) ;

S. F. Cornice Co. v. Beyerle, 181 Fed. 692,
affirmed by your Honors, 195 Fed. 516 ;

Pelton Water Wheel Co. v. Doble, 186 Fed.
526, affirmed by your Honors, 190 Fed.
761 ;

Expanded Metal Co. v. Bradford, 214 U. S.
366, 53 L. Ed. 1034.

The question of Invention by Cohn was also carefully considered by Judge Van Fleet (notwithstanding the bold statement of Appellant to the contrary) and your Honors' attention is most respectfully directed to the opinion of the Court below.

INFRINGEMENT

INFRINGEMENT.

. ADMISSIONS ON THE RECORD.

1. THAT DEFENDANT HAS USED THE HEINZ ENVELOP (EX. C.) WITHIN SIX YEARS LAST PAST IN THE NORTHERN DISTRICT OF CALIFORNIA, AND BEFORE THE BRINGING OF THE SUIT. (STIPULATION R. 44.)

2. THAT THE HEINZ ENVELOP INFRINGES THE FIRST COHN PATENT (X. Q. 109, R. 551.)

3. THAT THE FIRST CLAIM OF THE SECOND COHN PATENT IS INFRINGED (R. 82).

This admission by Mr. Sullivan was subsequently withdrawn by Mr. Banning, but the admission is entitled to weight as being consistent with common sense and the evidence and as the opinion presumably of an expert.

4. DEFENDANT ADMITS THAT THE HEINZ ENVELOP IS NEARER TO COHN THAN IT IS TO ANY OTHER PATENT BEFORE THE COURT (R. 546).

THE QUESTION OF INVENTION AND MECHANICAL EQUIVALENTS IS OFTEN DETERMINED BY CONSIDERING WHETHER THE INFRINGING DEVICE IS MORE LIKE THE PATENT IN SUIT THAN THOSE DEVICES CLAIMED TO ANTICIPATE THE PATENT.

Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 118 Fed. 136, *supra*;

National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 Fed. 199.

It is not disputed that Regenstein employs precisely the same method in preparing his Transo and Heinz envelops that is shown and described by Mr. Cohn. That is to say Regenstein like Cohn starts with an opaque stock; he uses an "oily preparation" which "has a tendency to creep or bleed beyond the borders of the space embraced by the stamp or die by which it is applied;" (X. Q. 196, R. 306). "That the effect of such creeping and bleeding is to stain or discolor the rest of the envelop or leave a ragged appearance to the window opening," (X. Q. 197); "that the border or ring is to obliterate such appearance of creep and give definition to the window opening," (X. Q. 198); and "that the ring or border is applied on one side of the sheet, to-wit: on the outside and that the oily preparation is applied on the opposite or inside of the sheet," (X. Q. 202, R. 307)

"In the sense of the patent law the substantial equivalent of a thing is the same as the thing itself."

Winans v. Denmead, 15 How. 330, 342;

Machine Co. v. Murphy, 97 U. S. 120.

"The changes which the appellants have made are immaterial and indeed are but a subterfuge made evidently for the purpose of evading the wording of the claim, they are unavailing."

Hoyt v. Horne, 145 U. S. 302, 308.

As was said by your Honors in *Jensen v. Norton*, 67 Fed. 236:

“Two devices are equivalent when one can be adapted to perform the functions of the other. Rarely can one element be removed bodily from one machine to the other without any change whatever. *Where that can be done, in such cases there can be no doubt of equivalency and infringement.*”

See also—

Alaska Packers Ass’n v. Letson, 119 Fed. 599.

DOCTRINE OF EQUIVALENTS.

Walker on Patents, Sec. 358, says:

“It is safe to define an equivalent as a thing which performs the *same function in substantially the same manner*, as the thing of which it is alleged to be an equivalent.”

At page 146 of Appellant’s Brief, counsel quotes Judge Morrow on the question of infringement and mechanical equivalents as follows:

“To sustain a claim of infringement three things must be found: First, *identity* of result; second, *identity* of means; third, *identity* of operation.”

We have only to say that this case was *reversed* on appeal, see 142 Fed. 141, your Honors holding

that, "the Eldridge device performs the same function as that of the Jordan device, and we are of the opinion that it performs it in *substantially the same way*, that the defense is not sufficient to avoid infringement, and that under the doctrine of equivalency, applicable to this case, the Eldridge device is the equivalent of the bumper or squeezer of the Jordan patent. * * * It is the whole purpose of the doctrine of equivalents to protect the inventor against piracy and to secure to him the benefit of that which he has invented."

EQUIVALENCY OF PARTS AS SHOWN BY THE FACTS.

FIRST COHN PATENT.

As it is admitted by the defendant that the Heinz envelop Exhibit "C" embodies the construction and combination of the claim of the First Cohn Patent, (X. Q. 109, R. 551), further consideration of this claim is therefore unnecessary.

SECOND COHN PATENT.

For convenience these two claims are again here set out and are as follows:

"1. An advertising device comprising an envelop having a window through which the addressee's name on an inclosure may show through said window being in outline characteristic of some symbol of trade, a tinted or colored border

surrounding and giving definition to said window and permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.

“2. As an advertising device, an envelop having a generally opaque face except for a transparent window portion through which an addressee's name on an inclosure may show through, said window being in general outline characteristic of a symbol of trade, and permanent printed matter on the face of the envelop related to and in juxtaposition with the outline of the window and co-operating with said outline to indicate a particular brand of goods.”

MR. SULLIVAN'S ADMISSION AS EVIDENCE OF THE OBVIOUS.

At the time of the introduction of Complainant's *prima facie* evidence Mr. Sullivan, representing the respondent, and an attorney of intelligence, integrity and recognized standing, and a member of the bar of this Court, *voluntarily admitted that claim 1 of this Second Cohn Patent* was found in its entirety in the Heinz envelop (R. 82):

“MR. SULLIVAN: We admit that Exhibit C does contain those features; that is, that it has a ‘window through which the addressee's name on the enclosure may show, said window being in outline characteristic of some symbol of trade, a tinted or colored border surrounding and giving definition to said window, and permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.’ Is that what you want?”

“MR. TOWNSEND: *You concede that the entire combination of claim 1 is shown in Exhibit C?*”

“MR. SULLIVAN: *We concede that the exhibit does show that.*”

In making this statement Mr. Sullivan interrupted the Complainant's witness Mr. Maynard, who was explaining the patents and was offering proofs of infringement of this claim in the usual manner.

While Mr. Sullivan's interruption and admission was unnecessary as far as Complainant was concerned and is claimed to have been unauthorized by the Defendant, nevertheless, his admission of infringement was in good faith and consistent with the justice and common sense view of the case.

Counsel for defendant would have the Court believe that we are relying entirely on the admission of Mr. Sullivan to prove infringement of the Second Cohn Patent.

Unfortunate as Mr. Sullivan's admission was no doubt to the defendant, nevertheless, it is entitled to weight as a voluntary admission of the defendant's own counsel, and it therefore may be taken as the opinion of an expert. In any event the case of *Jones v. Morehead*, 1 Wall. 164, relied on by defendant at page 150 and following of his Brief, is sufficient to fasten on defendant infringement by the use of the one particular envelop introduced in evidence as the Heinz envelop, as Exhibit “C.” As that was

the only infringing envelop before the Court, and all the other infringing envelops are made like it, it is not seen why that one instance would not be sufficient to sustain the prayer of the Bill.

However, as there is no intention or desire to take an unfair or technical advantage of the Defendant, the proofs, independent of the foregoing admission amply substantiate the claim of infringement.

Mr. Bond in trying to show the variation practised by the defendant admits that the combined function of the Heinz window and border is "to present to the eye the outline of a cucumber," which of course is what is done by Mr. Cohn. But he argues that in Heinz the figure of the cucumber lies in the border, whilst in Cohn it lies in the outline of the window. Manifestly that is a distinction without a difference.

Mr. Bond also points out that the "permanent advertising or printed matter" is displayed in a different way or in a little different position in the Heinz envelop than is shown in the drawings of the Cohn Patent.

The chief fallacy of this position of the defendant is that it leaves out of consideration the "doctrine of equivalents."

Of course in this case like in nearly every case of patent infringement there are physical differences between structures which are more or less apparent.

However, Mr. Bond *admits equivalency*. Thus on direct examination (R. 493):

“The border, surrounding the transparent window, in the Heinz envelop, has an edge or outline, around its periphery or outer edge, resembling a cucumber, and on the inside of the back of the envelop is printed the word ‘Heinz.’ The purpose of this representation of a cucumber, and the use of the word Heinz showing through the transparent window, as I *understand the same, is to carry into the envelop the trade-mark* of the Heinz Pickle Company, as used in connection with the receptacles containing articles put up by said Heinz Pickle Company.”

Again, (R. 494), Mr. Bond testifies:

“Q. 52. How is the window, shown in Figure 1 of the drawings of this Second Cohn Patent, considered by itself—in the shape of some article or thing sold and dealt in?

“A. It presents the outline of a cucumber.”

“Q. 53. What is employed in the Heinz envelop to *present the outline of a cucumber?*”

“A. The surrounding border, the outer edge of which is made to present the outline of a cucumber.”

THE COURT WILL APPRECIATE WHAT SHALLOW ICE THE DEFENDANT IS ON BY OBSERVING THAT THE SECOND COHN PATENT SHOWS IN FIG. 1 THAT THE OUTER EDGE OF THE BORDER PRESENTS ALSO THE OUTLINE OF A CUCUMBER. CERTAINLY HEINZ WAS NOT THE FIRST TO MAKE A BORDER IN THE OUTLINE OF A CUCUMBER.

On cross examination Mr. Bond testifies as to *equivalency* as follows, (R. 542):

"X. Q. 90. Look at the drawing, Figure 1 of the Second Cohn Patent, and state what the shape of the border therein shown represents?

"A. The periphery or outer edge is in outline representing a cucumber, corresponding to the outline of the edge of the transparent window."

And again:

"X. Q. 93. Looking at the 'Heinz' envelop, which I hold before you, with the face presented to your view, what is there displayed which indicates a particular brand of goods?

"A. The representation of a cucumber formed by the exterior or outside edge of the border surrounding the window; which would be the same, in effect, if the window were omitted.

"X. Q. 94. How about the word 'Heinz'?

"A. Inasmuch as 'Heinz' or the Heinz Company is known as the manufacturer of pickles, including cucumbers, the border, in and of itself, and with the word 'Heinz' imprinted within the border, would indicate the concern just the same if the transparent window was not present. My recollection is that the trade mark of the Heinz Company is the representation of a cucumber, with the word 'Heinz' printed thereon, and usually this is accompanied by the words '57 varieties,' forming, however, as I understand it, no part of the trade mark.

"X. Q. 95. So that, in this Heinz envelop, the representation of the outline of a cucumber, as-

sociated with the word 'Heinz,' immediately conveys to your mind the goods or business of the defendant company? Is that true?

"A. Yes; and it would be precisely the same if I should see a label, presenting in outline a cucumber, and having within the body of the cucumber the word 'Heinz'."

And further:

"X. Q. 98. The position of the word 'Heinz' on the envelop, either appearing where the words 'John Doe' appear in Figure 1 of Cohn, or inside of the border, as in Heinz, makes no material difference, or any difference in fact, does it, as far as the collocation of the word and cucumber are concerned, in indicating the particular brand of goods?"

"A. No, but it would make a difference in pointing out the manufacturer. If the name of the manufacturer were imprinted on the outside face of the envelop, it would be present whether the envelop contained an inclosure or not, while if printed on the inner face of the back of the envelop it would not appear, when there was an inclosed letter in the envelop. In the one case, as contemplated by Cohn with his envelop, the name is in co-relation to the symbol of trade, and permanent on the face of the envelop where it can always be seen. In the other case, as contemplated in the Heinz envelop, the name of the manufacturer would only appear when the envelop was empty.

"X. Q. 99. By my last question, I meant the envelop pure and simple as an envelop, without an inclosure. In that case, does it make any dif-

ference whether the words appear as they do in the Heinz envelop or as shown in Figure 1 of the Cohn; assuming, of course, that the word 'Heinz' is substituted for the words 'John Doe'?

"A. So far as concerns the word 'Heinz' in co-relation with a cucumber, there would be no difference, whether the word 'Heinz' appeared outside of the representation in outline of a cucumber produced by the configuration of the edge of the cut, or whether such name appeared within the space occupied by the representation of the cucumber.

"X. Q. 100. Which envelop, to your mind, is to be preferred—the Cohn envelop or the so-called Heinz envelop?

"A. Personally, the Heinz envelop would be my preference. Other persons might prefer the Cohn envelop, in which the outline characteristic of a symbol of trade was produced by the transparent window instead of by the border."

Again Mr. Bond testifies:

"X. Q. 104. The word 'Heinz' on the Heinz envelop, which appears inside of the cucumber shape, is on the opaque stock of the envelop, is it not?

"A. Yes, it is on the inner face of the opaque back of the envelop."

And again:

"X. Q. 108. With the Heinz envelop laying flat on the table before you, face up, the word 'Heinz' appears on the face of the envelop in association with the cucumber outline, does it not?

“A. Yes, such outline being produced by the periphery or outer edge of the opaque border and not by the outline of the transparent window.”

Thus Mr. Bond admits that the word “Heinz” printed on the inside of the envelop “appears” to be printed on the face; that it is “permanent advertising matter;” that it is on the *opaque part* of the envelop; is *associated with the window*, and with the pickle outline; and that *the word “Heinz” with the pickle outline represents the defendant’s trade-mark* as it was designed and intended it should be. Obviously the desired result is accomplished by means “substantially like” the means shown and described and claimed in the patent in suit.

If a device performs the *same function*, the fact that it also performs another function is immaterial to any question of infringement. (Walker, p. 309, Sec. 352).

Appellant’s contention of non-infringement of claim 1 of the Second Cohn Patent is, that by a simple *change in location, or form* of one or two of the elements of the claim, yet keeping all the elements in the sequence called for by the claim, and producing all of the results of a successful advertising envelop designed to be secured by the patent, that such colorable differences are sufficient in themselves to avoid infringement. Such refinements, and especially in an invention possessing

the novelty that this one admittedly does, are not encouraged or supported by the law covering the construction of claims.

MERE CHANGE IN FORM, PROPORTION, OR DEGREE, OR LOCATION OF PARTS; DOING THE SAME THING IN SUBSTANTIALLY THE SAME WAY, DOES NOT AVOID INFRINGEMENT.

Walker on Patents, Sec. 363.

It is also a familiar rule that even where a *change of form* somewhat modifies the construction, the action, or the utility of the patented device, non-infringement will seldom result from such a change.

Walker, Sec. 363;

Risdon Iron & Locomotive Works v. Trent,
92 Fed. 375.

But form, location and sequence of elements are all immaterial, unless form or location or sequence is essential to the result, or indispensable, by reason of the state of the art, to the novelty of the claim.

Norton v. Jensen, 49 Fed. 859 (C. C. A. 9th Cir.);

Winans v. Denmead, 15 How. 330, 14 L. Ed.,
717;

Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co., 10 C. C. A., 194, 61 Fed. 958;

Bundy Mfg. Co. v. Detroit Time Register Co., 36 C. C. A., 375, 94 Fed. 524.

After withdrawal by the defendant of Mr. Sullivan's admission of infringement of claim 1, Mr. Cohn was called and testified as follows for the complainant (R. 200):

"In looking at the first claim of my Second Patent, I find the following:

" 'An advertising device comprising an envelop having a window through which the addressee's name on an enclosure may show through.'

"Referring to the Heinz envelop, I find that it is an advertising device comprising an envelop having a window through which the addressee's name on an enclosure may show through. The claim states:

" 'Said window being in outline characteristic of some symbol of trade.'

"Referring to the Heinz envelop we find that it has a window being in general outline characteristic of some symbol of trade, namely, that of a pickle or cucumber, which is specifically shown in the drawing of my patent, Figure 1, and is especially mentioned in the specifications as being 'a cucumber, the trade-mark of a well-known manufacturer of a great many varieties of goods,' and while the drawing referred to shows the name 'John Doe,' this name is purely ficti-

tious, the general public knowing that the name 'Heinz' was intended, and the only reason that it was not used was on account of the limitations in the Patent Office, which bar the real names of persons or firms. The claim states:

“ ‘A tinted or colored border surrounding and giving definition to said window.’

“Referring to the Heinz envelop we find a tinted or colored border surrounding and giving definition to the window.

“The claim further states:

“ ‘And permanent advertising matter forming no part of the address, appearing on said tinted border, and related to and in juxtaposition with the outline of said window.’

“Referring to the Heinz envelop we find permanent advertising matter forming no part of the address appearing through the window and on the face related to and in juxtaposition with the outline of said window.

“In my claim and also in my specifications, I do not limit myself as to the exact location of the permanent advertising matter, the main feature being the *mechanical combination of the advertising matter with the window*. I state in the beginning of my specifications, as follows:

“ ‘The object of this invention is to so design the window opening and to associate with said window such descriptive matter as will offer novel and unique possibilities for advertising.’

“Referring to the Heinz envelop we find that it accomplishes the desired result referred to, and is accomplished by the association of the

printed matter and the pickle-shaped border. The word 'Heinz' taken by itself and not associated with anything else would be meaningless, a pickle-shaped border not associated with any printing matter would have no value as an advertising device because it might mean any pickle manufacturer, but when we take the mechanical combination of these two, namely, the pickle-shaped border or window and the word 'Heinz,' we have, and I will now use the language of the specification, 'a striking advertisement of a particular brand of goods of a particular merchant or firm.' It is therefore, self-evident that the desired object of my patent and the object of the Heinz are identical and produced by exactly the same means. If the person who drew the specifications for my second patent had a Heinz envelop before him, I cannot possibly see how he could have described it more fully or completely, and it is very probable that whoever designed this Heinz envelop had a copy of my specifications before them at the time. Taking the Heinz envelop, I will paraphrase a portion of the specifications beginning at line 37, of the second page, in order to more clearly illustrate my meaning:

“ ‘When there is associated with a window opening of characteristic or peculiar design,’ as in this Heinz envelop, a window in the shape of a pickle,

“ ‘A trade name, or some word,’ in the Heinz envelop, the word ‘Heinz;’

“ ‘Or words,’ and in the Heinz envelop the words ‘H. J. Heinz Company;’

“ ‘Usually associated with or relating to the pictorial feature,’ in the Heinz envelop the pictorial feature being the pickle;

“ ‘Every one seeing the envelop is confronted with a striking advertisement of a particular brand of goods of a particular merchant or firm.’

“In the Heinz envelop we see this striking advertisement, and immediately associate it with the Heinz pickle concern. Summing up I find that every element expressed in claim 1 of my second patent appears in the Heinz envelop, and I find no elements in the Heinz envelop which are not expressed in this claim. The location of the printed matter is immaterial and the fact that the single word ‘Heinz’ is printed on the inside of the envelop but appearing through the window and in association with same, does not in any way *affect the desired result*. *As a matter of fact, any one holding this envelop a few feet away could not tell if the word ‘Heinz’ was printed on the inside or on the face of the envelop. The fact remains that it is clearly related to, ‘and in juxtaposition with the outline of said window.’*

“R. D. Q. 189. In how far, if at all, would the foregoing statement apply or not apply to the combination of the second claim?

“A. The foregoing explanation would apply in its entirety to claim 2. I would like to add however, that in considering the Heinz envelop with regard to claim 1 that the word ‘Heinz’ *appears* (and I wish you would underline the word ‘appears,’ as I wish to emphasize this word) on the face of the envelop, and that I did not limit myself to the fact that it should be

printed on the face, in claim 1; the claim simply stating that it should appear and I had in mind at the time I applied for this patent a combination of this character, as I am fully aware of the fact that the Heinz trade-mark usually shows a pickle with the words, 'Heinz' appearing within the outline of the pickle. Taking the drawing Figure 1, in my second patent, and the Heinz envelop I find nothing in my claims or specifications which limits me to the location of the permanent advertising matter; the object being as I stated before to show the association between the permanent advertising matter and the window or border."

Mr. Cohn was not cross examined on this matter of infringement and his testimony stands admitted on the record, except in so far as Mr. Bond's previous disingenious explanations represent the defendant's viewpoint; *which explanations as we have seen, studiously avoided as far as possible the "doctrine of equivalents."*

The foregoing showing of infringement of claim 1, proves at the same time infringement of claim 2; the defendant maintaining that claim 2 must be limited to a *window* "in general outline characteristic of a symbol of trade," and that the printed matter must be "on the face of the envelop." Of course there is nothing in the prior art requiring any such over refined limitation of the claim and besides the spirit of the claim, if not the exact letter, is manifestly present in the Heinz envelop; and it needs no

great liberality of construction to read the letter of the claim on to the infringing devices.

Mr. Maynard (R. 83), fully sustains Mr. Cohn. He says:

“The location of the word ‘Heinz’ with relation to the outline, or the pickle outline of the window, simply arrives at the same result, as that is, advertisement. * * * The means for arriving at the result—that is, advertisement—are precisely the same. The patent calls for an opaque envelop having a transparent window and in association with said window suitable words, as the name of a firm, and also states that the outline of the window may be shaped into the symbol of trade of a manufacturer. Whether the word ‘Heinz’ is printed at any certain position on the envelop does not affect the results. The instrumentalities for accomplishing the advertising are the same. The patents call for an opaque envelop. The exhibit marked C is an opaque envelop. The patents call for a transparent window made by the application of a suitable preparation on the inside of the envelop and also call for a suitably-tinted outline around the transparent window to cover the effect of creep of the material producing the transparency, and the patents, taken as a whole, involve an envelop of this structure, having associated with the particularly-shaped window suitable words so that the association of the two will form an advertising of the firm distributing the envelop.”

As to the position of the word "Heinz"" inside the pickle and envelop Mr. Maynard says (R. 90) :

"Of course it is not *on* the face of the envelop, but it *appears* just as plainly as if it were printed on the face of the envelop, no matter if it is printed on the inside, at the back of the envelop * * *"

From the foregoing we see that any changes which the defendant has made in his infringing Heinz envelop are merely in form, proportion or degree, varying slightly the shape of the window and transparency so as to adapt the window perhaps a little better to allow the sendee's name and address to show through, but still indicating the pickle trade-mark of the defendant; and putting the permanent printed advertising matter "Heinz" inside the envelop instead of *outside*, but still so that it *appears* to be on the outside, and is in "juxtaposition with and related to" the outline of the pickle. That constitutes equivalency.

Smith v. Nichols, 21 Wall. 112, 22 L. Ed., 566;

Belding Mfg. Co. v. Corn Planter Co., 152 U. S. 100, 38 L. Ed. 370.

The doctrine of equivalents may be invoked for all patents, and not merely for pioneer ones, but the range of equivalents depends upon and varies with the degree of invention.

Kitchen v. Levison, 188 Fed. 658 (C. C. A. 9th Cir.) ;

Paper Bag Cases, 210 U. S. 405, 52 L. Ed. 1122;

Hickmott v. Canning Co., 142 Fed. 145 (C. C. A. 9th Cir.).

Judge Van Fleet's Conclusion on Infringement of the Cohn patents is a full and clear statement of the facts and the law of the case.

THE EQUITIES OF THE CASE.

At page 151 and following of Appellant's Brief, it is sought, precisely as in the Court below, to enlist the sympathies of this Court on behalf of Mr. Regenstein because he has spent a lot of money in building up the Transo Envelop business. His patience, and the time and money he has expended, and the extent of his present business bespeaks the novelty of the Cohn inventions and their merit.

But if ever the equities were with an inventor and patentee in a patent suit they would seem to be with Mr. Cohn here.

Counsel's argument seems to overlook *Mr. Cohn's* expenditures and experiments during 1903 and 1904,

culminating in the placing of 10,000 of his envelopes in circulation long before Regenstein or the Transo Envelope Co. were ever heard of. The argument on behalf of defendants overlooks the contemptuous letter of Regenstein of December, 1906, in reply to Mr. Cohn's notice of the issuance of his patents and inviting the opening of negotiations. It also overlooks Regenstein's slavish copying of the Second Cohn Patent in 1908 and 1909 when he had an order for advertising envelopes like the Heinz pickle envelope and the Stickney cigar envelope, although in 1905 he told Mr. Cohn that this advertising idea was impractical and impossible.

WARNING NOTICES.

Furthermore, capital is attempted to be made of the "warning notices" sent out by Mr. Cohn after the filing of this suit. We have only to call attention to the recent case of *Virtue, et al., v. Creamery Package Mfg. Co., et al.*, 179 Fed. 115, Cir. Court of Appeal, 8th Circuit, giving the rule and showing it was an act of kindness on Mr. Cohn's part to notify infringers of the pending suit:

"That the owner of a patent may notify infringers of his claims, and warn them that, unless they desist, suits will be brought to protect him in his legal rights, is sustained by numerous decisions. *Kelley v. Ypsilanti Dress Stay Manufacturing Co.* (C. C.) 44 Fed. 19, 10 L. R. A.

686; *Computing Scale Company v. National Computing Scale Company* (C. C.) 79 Fed. 962; *Farquhar Company v. National Harrow Company*, 102 Fed. 714, 42 C. C. A. 600, 49 L. R. A. 755; *Adriance, Platt & Co. v. National Harrow Company*, 121 Fed. 827, 58 C. C. A. 163; *Warren Featherbone Company v. Landauer* (C.C.) 151 Fed. 130; *Mitchell v. International, etc., Company* (C. C.) 169 Fed. 145; 30 Cyc. 1054.

“The only limitation on the right to issue such warnings is the requirement of good faith. There is nothing in the warnings given in this case to show that the letters or notices were false, malicious, offensive, or opprobrious, or that they were used for the willful purpose of inflicting injury. In such a case it was said, in *Kelley v. Ypsilanti*, *supra*:

“‘It would seem to be an act of prudence, if not of kindness, upon the part of a patentee, to notify the public of his invention, and to warn persons dealing in the article of the consequence of purchasing from others. *Chase v. Tuttle* (C. C.), 27 Fed. 110; *Boston Diatite Company v. Florence Manufacturing Company*, 114 Mass. 69 (19 Am. Rep. 310); *Kidd v. Horry*, 28 Fed. 773.’

“There is nothing in this case to indicate that any of the warnings issued by the defendants were made in bad faith, and they were promptly followed by the institution of the infringement suits. In issuing notices and warnings we think the defendants were acting within their legal rights. If they had the right to bring the suits, they had the right to issue the warnings. It may be, and probably is, true that the pendency of

these suits resulted in some damage to the plaintiffs by lessening the sale of the challenged device; but such damage was an incident of the suits, and cannot be made the basis of a recovery."

CONCLUSION

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To summarize: we see that the only methods disclosed by the patents offered by the defense, for the manufacture of envelopes with a transparent panel to disclose the address, are:

(a) to make the envelop of *transparent* paper and to render the face opaque around the transparent panel or window;

(b) the *suggestion* to make the envelop of *opaque* material and to render the panel transparent; and

(c) the *suggestion* to manufacture the *entire envelop of opaque material* and render the panel section transparent by *reducing it in thickness*.

The first method is disclosed, for example, in the English Patent to Busch. The second method is *mentioned* by Brown, U. S., 1862, and the third method is suggested in the patent to Reese, August, 1904. (The latter patent being later than Cohn's inventive act cannot be considered part of the prior art.)

Neither of the above methods, however, contributed to the art, as we have seen, any *practical method* of manufacturing this class of envelopes. The first method is defective, for the reason that the envelop is too light in weight and stiffness and lacks the required stability for the ordinary usage of commercial envelopes and its transmission through the mails, and for the additional reason that any commercial paper,

like tracing paper, for example, which would possibly be used, is too expensive for practical use. The second method, so far as disclosed in the prior art, is merely a *suggestion* that such an envelop could be made from opaque material, with a portion of the face rendered transparent, and Brown suggests that the same method for rendering the panel transparent as now employed in making *tracing paper*, can be used. This suggestion is inoperative for any practical use, for the reasons pointed out that the methods now employed in making tracing paper can only be employed in the manufacture of an *entire sheet* and *cannot be applied to a limited area* of a sheet of opaque paper. To render the panel of the Brown envelop transparent by the application of an oleaginous material would be impracticable from a commercial standpoint according to the testimony of both Cohn and Regenstein, who are in accord that considerable experimenting was required to obliterate the creeping effect of the oleaginous material and to render the outline of the transparent panel sharp and well defined. The third method does not appear ever to have been practiced and it is of very doubtful utility. It is a matter of common knowledge that opaque papers having a pronounced water mark, by which certain portions are rendered thinner, makes the reduced portions of the paper translucent when held up to the light, *but not transparent*.

The first and third methods can therefore be eliminated as making no practical contribution to the art:

The first method because it is too expensive for commercial use, and because the envelop is unfitted by its flimsiness for practical use; the third method for the reason that it is inoperative to produce the desired result and besides is later than the invention of Cohn. *As a matter of fact no window envelops have ever been put commercially on the market manufactured by either the first, second or third method.* The second method, that suggested by Brown, is impracticable and of no commercial value. Brown's idea, so far as disclosed by U. S. Patent 36,393 of September 9, 1862, consists in a mere *suggestion* that a window envelop might be made by using opaque paper and rendering a portion of the face transparent. Brown discloses no method of accomplishing this result, but refers to the *prior art as affording the necessary knowledge*, which, as a matter of fact, the *prior art did not disclose*. The two suggestions made by Brown, namely, that the "tracing paper process" could be used or that an oleaginous substance could be applied, were both impracticable, therefore, Brown, in fact, made no contribution to the art. The mere suggestion that a thing can be done or that the doing would be a benefit to an art, does not involve a patentable invention, nor operate as an anticipation of a practical means for successfully accomplishing the desired result. (Authorities *supra*.).

The production of a perfected window envelop, from opaque material with a panel rendered transparent by the application of an oleaginous material,

was only accomplished by the experiments of Cohn and Regenstein. Both witnesses testify that considerable experimenting was made both in the application of the oleaginous material and in the application of a suitable border to cover the creeping effect and define the outline of the window. All the prior art so far as it relates to envelopes does not bear upon the sufficiency of invention exercised by Cohn and Regenstein. All the prior structures other than envelopes have no bearing upon the invention disclosed in the claim of the Cohn Patent 835,850. They simply show the application of two colors with one forming a border, while the invention of Cohn had to do with two distinct *processes*; first, the application of *some* preparation which would render the opaque stock of the envelop transparent; and second, to overlay a margin of the transparent portion of the window and the surrounding semi-transparent portion of the envelop with an opaque border. Each of these processes required experiment according to the testimony of both Cohn and Regenstein. The defense, therefore, presents the peculiar attitude of offering testimony to show that the application of the border to the Cohn envelop was anticipated by the prior art, but that it did not anticipate the application of the border to the *Transo envelop, inasmuch as the application of a border to the Transo envelop occupied months of continued experimenting*. In other words, the position of the defense is practically that it did not involve invention for *Cohn* to put a border around the transparent window of an envelop, but that it

did require invention for *Regenstein* to do the same thing. This is certainly blowing hot and cold with the same breath, and is only equaled by the Irish woman's defense for the mutilation of the borrowed kettle. First, that she never borrowed it; second, that it was whole when she returned it; and third, that there was a hole in it when she borrowed it.

THE DEFENDANT'S STRUCTURE IS WITHIN THE CLAIMS SUED ON, AND IT MEETS THOSE CLAIMS AS TO FUNCTION, PURPOSE, MODE OF OPERATION, PRACTICABILITY, COMMERCIAL SUCCESS AND RESULTS GENERALLY SOUGHT BY THE PATENTS IN SUIT; IN SHORT THERE IS COMPLETE EQUIVALENCY BETWEEN THE DEFENDANT'S STRUCTURE AND THE COMPLAINANT'S STRUCTURE, AS A WHOLE, AND BETWEEN THE SEVERAL PARTS OF THE RESPECTIVE STRUCTURES.

Defendant's counsel has tried to belittle the importance of the Second Patent, but when it is taken into consideration that almost every one that can write uses envelopes and that many concerns use a great many thousands daily, it is not as unimportant as he would have it appear.

It requires no argument to prove that an envelop that will fill every requirement of an ordinary envelop and which possesses the additional feature of not requiring an address to be written on its face, *is a labor saving device*. In large concerns where thousands of envelopes are used daily it is a large

item of saving besides insuring accurate addressing, not a day goes by but that hundreds of communications are put in wrong envelops, in many instances causing serious delays and incurring heavy damages.

The Second Cohn Patent contains all the elements of *labor saving* and *proper addressing* belonging to the first patent, with the additional feature of *advertising*.

When it is considered that millions of dollars are annually expended in the United States by various firms advertising their products and trade marks, and that we have in this second patent an article that not only gives the person using the same an excellent advertisement, but also saves him time and money in addressing, etc., we have an article that is in a class by itself.

It is the only advertising device known today that does not cost the user anything; in fact saves the user money.

It must be conceded that it is a striking advertisement and is directly brought to the attention of the recipient.

An advertisement in a magazine or on a billboard may easily be overlooked but an advertisement of this kind forces itself on your attention.

It certainly possesses *every* element of NOVELTY and was so conceded by the largest *advertising firm on this Coast* (see Cohn's testimony re Barnhart & Swasey).

The words of Judge Kohlsaatt in the recent case of *Mitchell v. Stevens*, 183 Fed. 782, regarding a patent on a "combined letter sheet and envelop" are extremely apt:

"There are a number of combined letter sheet and envelop devices in evidence. This feature of the claims in suit is therefore old. But in all the wide field of advertising mediums no one had ever, before *Mitchell*, hit upon this feature, which, according to the evidence of a number of skilled and practical advertising men, was a distinctively successful advance in the advertising media. *Anything which will attract the attention of the public in the shape of mail matter is entitled to consideration. Having in mind the pertinacity and ingenuity of those whose life task seems to be the discovery of some way in which to penetrate and quicken the indifference of the public*, it certainly is persuasive that any one should hit upon the device in suit after so many years of aggressive effort in that line, especially in view of the effective commendations of those posted in the advertising line. The record considered, I am of the opinion that the patent should be held valid. * * *

"It is contended that complainant is limited to his one slit in the lower flap. The genius, if it be such, of the *Mitchell* patent, is found in the combination of the letter effect with the ordinary one cent mail matter. The arrangement of defendant's device in no way adds to its effectiveness as

an advertising medium over complainant's. The card could be securely held on the main or middle sheet of the folder by means of incisions in the sheet only in the manner adopted by defendant. It seems entirely likely that complainant should have considered that method, but preferred his own entirely inclosed card; his main purpose being to provide a one cent mailable folder which should, while open at the ends, still retain much of the advantages of an ordinary letter. *This was his invention. Given that idea, the location on the middle section of the folder cannot be said to involve invention.* Infringement seems to be clearly established."

This whole subject, applicable to both the Cohn patents, may well be concluded by the latest expression of our Supreme Court on the question of Invention, Anticipation and Infringement, in the case of Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428:

"The tire has utility, a utility that has secured an almost universal acceptance and employment of it, as will subsequently appear. It was certainly not an exact repetition of the prior art. It attained an end not attained by anything in the prior art, and has been accepted as the termination of the struggle for a completely successful tire. It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, 'in the light of the accomplished result,' it is often a matter of wonder

how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration. And it recognizes degrees of change, dividing inventions into primary and secondary, and as they are, one or the other, gives a proportionate dominion to its patent grant. In other words, the invention may be broadly new, subjecting all that comes after it to tribute (*Chicago & N. W. R. Co. v. Sayles*, 97 U. S. 554, 556, 24 L. Ed. 1053, 1054); it may be the successor, in a sense, of all that went before, a step only in the march of improvement, and limited, therefore, to its precise form and elements, as the patent in suit is conceded to be. In its narrow and humble form it may not excite our wonder as may the broader or pretentious form, but it has as firm a right to protection. Nor does it detract from its merit that it is the result of experiment and not the instant and perfect product of inventive power. A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world's utilities, he is entitled to the rank and protection of an inventor. * * * He must, in-

deed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. He must not put forth a puzzle for invention or experiment to solve, but the description is sufficient if those skilled in the art can understand it. This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the new construction."

It is respectfully submitted that the decree should be affirmed.

Respectfully submitted,

CHAS. E. TOWNSEND,

Solicitor for Appellee.